

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/1. INTRODUCTION/1. Scope of title and historical background.

## **TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))**

### **1. INTRODUCTION**

#### **1. Scope of title and historical background.**

This title deals primarily with registered trade marks<sup>1</sup> and passing off<sup>2</sup>. Registered trade marks can be either United Kingdom registered trade marks, or Community trade marks<sup>3</sup> which are applied for in respect of, and have effect throughout, the territory of the European Community. In addition, protection can be obtained<sup>4</sup> for a protected international trade mark (UK)<sup>5</sup>, and this protection is for almost all purposes equivalent to a United Kingdom registration. This title also deals with statutory marks of various kinds, hallmarking and similar matters.

In early times trade and industry were concentrated in London and other large towns where the merchants and craftsmen organised themselves into guilds. Many guilds were established as corporations either by statute or by charter<sup>6</sup> and the trade and craft of these were supervised under byelaws. Those statutes and byelaws contained provisions for the allocation and use of trade marks<sup>7</sup>. Sometimes the use of trade marks was made compulsory to avoid deceit<sup>8</sup>. With the onset of the industrial revolution the guilds lost control over manufacturers, and as commerce grew, the courts responded to commercial need by developing both the common law tort of passing off and, in equity, a specialised form of property in a trade mark which had been put into public use<sup>9</sup>.

Both because litigation was expensive and because there was a need for greater certainty as to what trade marks were already the property of others, trade mark registration was introduced by the Trade Marks Registration Act 1875. That Act created the register of trade marks<sup>10</sup> and set the basic structure<sup>11</sup> for all successive legislation<sup>12</sup> until the mainly new law embodied in the Trade Marks Act 1994. The Trade Marks Registration Act 1875 provided that registration of a trade mark should be deemed to be equivalent to public use of the mark concerned<sup>13</sup>. That Act also provided that no proceedings for infringement of a trade mark could be brought unless and until the mark had been registered<sup>14</sup>. A general law concerning the use of false trade descriptions was introduced and the common law tort of passing off continued to develop.

In 1994 much of the law of registered trade marks within the United Kingdom was revised in order to bring its substantive provisions into line with a harmonised European Community approach<sup>15</sup>, and subsequently the right to obtain Community trade marks was introduced by EC Regulation<sup>16</sup>. Today the main branches of the law, so far as private rights are concerned, are United Kingdom and Community registered trade marks, and passing off. So far as public rights are concerned, the matters are now covered by the Trade Descriptions Act 1968. This title does not cover the law relating to false trade descriptions, which more properly fits with the general law of consumer protection<sup>17</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 post.

2 As to passing off see PARA 304 et seq post.

3 As to Community trade marks see PARA 176 et seq post.

4     le under the Madrid Protocol via the International Bureau of the World Intellectual Property Organisation at Geneva: see PARA 11 et seq post. As to the Madrid Protocol see PARA 8 post.

5     For the meaning of 'protected international trade mark (UK)' see PARA 13 post.

6     As to the development of guilds see CORPORATIONS vol 9(2) (2006 Reissue) PARA 1305 et seq.

7     However, the legal validity of such provisions was not always upheld by the courts: see *Blanchard v Hill* (1742) 2 Atk 484, 26 ER 692, where the Court of Chancery rejected a claim for an injunction to protect the 'Mogul' mark for playing cards based on the provisions of a charter which the court held to amount to the grant of an illegal monopoly.

8     Eg those relating to gold and silver.

9     The history of this form of property is described in detail in *Berlei (UK) Ltd v Bali Brassiere Co Inc* [1969] 2 All ER 812, [1969] 1 WLR 1306, [1969] RPC 472, HL; and *General Electric Co v General Electric Co Ltd* [1972] 2 All ER 507 at 518-520, [1972] 1 WLR 729 at 742-743, [1973] RPC 297 at 325-327, HL, per Lord Diplock.

10    See the Trade Marks Registration Act 1875 s 1 (repealed).

11    A considerable number of embellishments were, however, added over the years.

12    le the Trade Marks Registration Amendment Act 1876, the Trade Marks Registration Extension Act 1877, the Patents, Designs and Trade Marks Act 1883, the Patents, Designs and Trade Marks Act 1888, the Trade Marks Act 1905, the Trade Marks Act 1919, the Trade Marks (Amendment) Act 1937, the Trade Marks Act 1938 and the Trade Marks (Amendment) Act 1984. All those Acts have been repealed.

13    See the Trade Marks Registration Act 1875 s 2 (repealed).

14    See the Trade Marks Registration Act 1875 s 1 (repealed). This provision has been re-enacted ever since and is now contained in the Trade Marks Act 1994 s 2(2): see PARA 416 post. But for this provision it might be argued that the equitable trade mark could co-exist with registered trade marks. Unregistered marks in use can affect the registrability of later marks: see PARA 77 post.

15    le by the Trade Marks Act 1994, passed principally to give effect to EC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks: see PARA 5 post.

16    le by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trademark: see PARA 176 et seq post.

17    See SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 383 et seq.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(i) Domestic Legislation/2. The Trade Marks Act 1994 and its interpretation.

## **2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM**

### **(1) LEGISLATION AND INTERNATIONAL BACKGROUND**

#### **(i) Domestic Legislation**

##### **2. The Trade Marks Act 1994 and its interpretation.**

Domestic legislation relating to trade marks is mainly contained in the Trade Marks Act 1994. That Act repealed<sup>1</sup> all previous legislation<sup>2</sup> relating to trade marks. Its stated purpose<sup>3</sup> is: (1) to make new provision for registered trade marks<sup>4</sup>, implementing the Trade Marks Directive<sup>5</sup>; (2) to make provision in connection with the Community Trade Mark Regulation<sup>6</sup>; (3) to give effect to the Madrid Protocol<sup>7</sup> and to certain provisions of the Paris Convention<sup>8</sup>; and (4) for connected purposes. In addition it has been amended to give effect to certain provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights ('TRIPs')<sup>9</sup>. The Trade Marks Act 1994 is not stated to be an amending Act. Many of its main provisions are derived from provisions of the Trade Marks Directive, both the mandatory and most of the optional provisions. Where such provisions fall to be implemented by the registrar<sup>10</sup>, the Trade Marks Directive is binding upon him<sup>11</sup>. In any event, the relevant provisions of the Trade Marks Act 1994 must be construed so far as possible in accordance with the Trade Marks Directive<sup>12</sup>. Furthermore, both the Trade Marks Act 1994 and the Trade Marks Directive must so far as possible be construed in accordance with the relevant provisions of TRIPs<sup>13</sup>. Other provisions of the Trade Marks Act 1994 are not derived from that Directive and so will fall to be construed in accordance with the normal rules of statutory interpretation<sup>14</sup>. In appropriate cases concerning domestic provisions it may be legitimate to refer to Hansard<sup>15</sup> or the White Paper<sup>16</sup> which preceded the passing of the Act.

1    Ie except for certain administrative provisions contained in the Patents and Designs Act 1907 relating to arrangements for the setting up of the Patent Office and the appointment of staff: see ss 62-64 (as amended); and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 575, 577, 579. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office': see the UK Intellectual Property Office Name Change Fact Sheet.

2    Ie the Trade Marks Act 1938.

3    See the long title to the Trade Marks Act 1994. As to the status of long titles see STATUTES vol 44(1) (Reissue) PARA 1264.

4    As to the meaning of 'registered trade mark' see PARA 127 post.

5    Ie EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks: see PARA 5 post.

6    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark: see PARA 176 post.

7    Ie the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid, 27 June 1989; Cmnd 1601): see PARA 8 post.

8    Ie the International Convention for the Protection of Industrial Property (Paris, 20 March 1883) (the 'Paris Convention'), as revised (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431). As to the Paris Convention see PARA 6 ante.

9 The Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, Pt IV amended the Trade Marks Act 1994 in order to give effect to certain provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights (OJ L336, 23.12.94, p 214). This Agreement comprises Annex 1C to the Agreement Establishing the World Trade Organisation (Marrakesh, 15 April 1994; Cm 2556-2559; Cm 2561-2569; Cm 2571-2574). It was ratified by the United Kingdom on 15 September 1994 and entered into force on 1 January 1996: see PARA 7 post.

10 As to the registrar see PARA 17 post.

11 *MISTER LONG Trade Mark*[1998] RPC 401, Appointed Person; *Nettec Solutions Ltd's Trade Mark Application*[2003] RPC 308, Appointed Person; *Sensornet Ltd's Trade Mark Application*[2007] RPC 185, Appointed Person; *CITYBOND Trade Mark* [2007] RPC 301, Appointed Person.

12 See PARA 5 note 3 post.

13 Case C-53/96 *Hermès International Société en commandite par actions, Paris v FHT Marketing Choice BV* [1998] ECR I-3603, [1999] RPC 107, [1998] All ER (D) 275, ECJ; Joined Cases C-300/98 and C-392/98 *Parfums Christian Dior SA v TUK Consultancy BV* [2000] ECR I-11307, ECJ; Case C-89/99 *Schieving-Nijstad vof v Groeneveld* [2001] ECR I-5851, [2002] IP & T 353, ECJ; Case C-245/02 *Anheuser-Busch Inc v Budejovicky Budvar NP* [2004] ECR I-10989, [2007] IP & T 348, [2004] All ER (D) 271 (Nov), ECJ. As to TRIPs see PARA 7 post.

14 As to the rules of statutory interpretation see STATUTES vol 44(1) (Reissue) PARA 1369 et seq.

15 Reference to parliamentary materials is allowed where: (1) legislation is ambiguous or obscure or the literal meaning leads to an absurdity; (2) the material relied on consists of statements by a minister or other promoter of the Bill which leads to the enactment of the legislation together, if necessary, with such other parliamentary material as is necessary to understand such statements and their effect; and (3) the statements relied on are clear: *Pepper (Inspector of Taxes) v Hart*[1993] AC 593, [1993] 1 All ER 42, HL; *R v Secretary of State for the Environment, Transport and the Regions, ex p Spath Holme Ltd*[2001] 2 AC 349, [2001] 1 All ER 195, HL; *Wilson v First County Trust (No 2)* [2003] UKHL 40, [2004] 1 AC 816, [2003] 4 All ER 97; and see STATUTES vol 44(1) (Reissue) PARA 1372. It is not, however, appropriate to refer to Hansard or the White Paper to construe a provision of the Trade Marks Act 1994 which derives from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1): *British Sugar plc v James Robertson & Sons Ltd*[1996] RPC 281, [1996-97] ETMR 118.

For proceedings in the House of Lords prior to the passing of the Trade Marks Act 1994 see 550 HL Official Report (5th series), col 749 (2nd Reading, 6 December 1993), Committee Stage (13-20 January 1994); 552 HL Official Report (5th series), col 728 (Report, 24 February 1994); 553 HL Official Report (5th series), col 69 (3rd Reading, 14 March 1994); and 556 HL Official Report (5th series), col 2105 (Commons' amendments, 15 July 1994). For proceedings in the House of Commons prior to the passing of the Trade Marks Act 1994 see 241 HC Official Report (6th series), col 658 (2nd Reading, 18 April 1994); HC Official Report, SC B (Trade Marks Bill) (Committee, 17 May 1994); 245 HC Official Report (6th series), col 78 (remaining stages, 20 June 1994).

16 *Re Reform of Trade Marks Law* (Cm 1203).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(i) Domestic Legislation/3. Territorial scope.

### 3. Territorial scope.

The Trade Marks Act 1994 extends to England and Wales, Scotland and Northern Ireland<sup>1</sup>; and it also extends to the Isle of Man, subject to such exceptions and modifications as Her Majesty may specify by Order in Council<sup>2</sup>.

For the purposes of the Act, the territorial waters of the United Kingdom<sup>3</sup> are treated as part of the United Kingdom<sup>4</sup>; and that Act applies to things done in the United Kingdom sector of the continental shelf<sup>5</sup> on a structure or vessel which is present there for purposes directly connected with the exploration of the sea bed or subsoil or the exploitation of their natural resources as it applies to things done in the United Kingdom<sup>6</sup>.

A trade mark registered in the United Kingdom is property situated there even though it is the mark of a foreign owner<sup>7</sup>.

1 Trade Marks Act 1994 s 108(1).

2 Ibid s 108(2). Under this power, the Trade Marks Act 1994 (Isle of Man) Order 1996, SI 1996/729 (amended by SI 2002/3148; SI 2004/1497) has been made. Subject to that Order in Council, references in the Trade Marks Act 1994 to the United Kingdom are to be construed as including the Isle of Man (s 108(2)); and in the Trade Marks Rules 2000, SI 2000/136, 'United Kingdom' includes the Isle of Man (r 2(1)). 'United Kingdom' means Great Britain and Northern Ireland: Interpretation Act 1978 s 5, Sch 1. 'Great Britain' means England, Scotland and Wales: Union with Scotland Act 1706, preamble art I; Interpretation Act 1978 s 22(1), Sch 2 para 5(a). Neither the Channel Islands nor the Isle of Man are within the United Kingdom. See further CONSTITUTIONAL LAW AND HUMAN RIGHTS vol 8(2) (Reissue) PARA 3.

3 As to the territorial waters of the United Kingdom see the Territorial Sea Act 1987 s 1; and INTERNATIONAL RELATIONS LAW vol 61 (2010) PARA 123 et seq.

4 Trade Marks Act 1994 s 107(1).

5 For these purposes, 'the United Kingdom sector of the continental shelf' means the area designated by Order in Council under the Continental Shelf Act 1964 s 1(7) (as amended) (see FUEL AND ENERGY vol 19(3) (2007 Reissue) PARA 1636): Trade Marks Act 1994 s 107(3).

6 Ibid s 107(2).

7 See eg *RJ Reuter Co Ltd v Mulhens* [1954] Ch 50 at 95-96, [1953] 2 All ER 1160 at 1183, 70 RPC 235 at 257, CA, per Romer LJ; *Adrema Werke Maschinenbau GmbH v Custodian of Enemy Property and Administrator of German Enemy Property* [1957] RPC 49 at 56, CA, per Lord Evershed MR, and at 59 per Jenkins LJ. It is presumed that the same applies to protected international trade marks (UK).

## UPDATE

### 3 Territorial scope

NOTE 2--SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(i) Domestic Legislation/4. Commencement, savings and transitional provisions.

#### **4. Commencement, savings and transitional provisions.**

All the provisions of the Trade Marks Act 1994 came into force on 31 October 1994<sup>1</sup>. Existing trade marks<sup>2</sup> registered under the old law<sup>3</sup> were transferred to the register kept under the Trade Marks Act 1994 and have effect<sup>4</sup> as if registered under that Act<sup>5</sup>. Applications for registration of trade marks which were pending<sup>6</sup> on 31 October 1994 must be dealt with under the old law<sup>7</sup>, unless the applicant opts to convert the pending application into an application under the Act<sup>8</sup>. Marks registered as a series under the Trade Marks Act 1938<sup>9</sup> continue to be so registered in the new register<sup>10</sup>. The former system of association of marks<sup>11</sup> is not continued by the Trade Marks Act 1994<sup>12</sup>. Under that Act there is no system for imposing conditions upon registration so that any conditions imposed upon trade marks already registered on 31 October 1994 ceased to have effect on that date<sup>13</sup>. A disclaimer or limitation in place on the former register in relation to an existing registered mark immediately before 31 October 1994 was transferred to the new register<sup>14</sup>. Activities which were lawful under the Trade Marks Act 1938 are protected under the Trade Marks Act 1994<sup>15</sup>.

1 Trade Marks Act 1994 s 109(1); Trade Marks Act 1994 (Commencement) Order 1994, SI 1994/2550, art 2. Different days might, however, be appointed for different provisions and different purposes: Trade Marks Act 1994 s 109(1). For transitional provisions generally see s 105, Sch 3.

2 For these purposes, 'existing registered mark' means a trade mark, certification trade mark or service mark registered under the Trade Marks Act 1938 immediately before 31 October 1994: Trade Marks Act 1994 Sch 3 para 1(1).

3 For these purposes, 'the old law' means the Trade Marks Act 1938 and any other enactment or rule of law applying to existing registered marks immediately before 31 October 1994: Trade Marks Act 1994 Sch 3 para 1(1).

4 *Ie* subject to the provisions of *ibid* Sch 3.

5 See *ibid* Sch 3 para 2; and *PARA* 19 *post*.

6 For these purposes, an application is to be treated as pending on 31 October 1994 if it was made but not finally determined before that date (Sch 3 para 1(2)(a)); and the date on which it was made is to be taken to be the date of filing under the Trade Marks Act 1938 (Trade Marks Act 1994 Sch 3 para 1(2)(b)).

7 See *ibid* Sch 3 para 10; and *PARA* 363 note 5 *post*.

8 See *ibid* Sch 3 para 11; and *PARA* 363 note 5 *post*.

9 *Ie* under the Trade Marks Act 1938 s 21(2) (repealed).

10 See the Trade Marks Act 1994 Sch 3 para 2(2); and *PARA* 19 note 16 *post*.

11 *Ie* under the Trade Marks Act 1938 s 23 (repealed).

12 See the Trade Marks Act 1994 Sch 3 para 2(3); and *PARA* 19 note 17 *post*.

13 See *ibid* Sch 3 para 3(1); and *PARA* 19 note 14 *post*.

14 See *ibid* Sch 3 para 3(2); and *PARA* 19 note 14 *post*.

15 See *ibid* Sch 3 para 4(2); and *PARA* 97 *post*.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(ii) International Legislation/5. The Trade Marks Directive.

## (ii) International Legislation

### 5. The Trade Marks Directive.

The Trade Marks Act 1994 was passed<sup>1</sup> (inter alia) to implement the Trade Marks Directive<sup>2</sup>. The main provisions of the Act are closely modelled on provisions, both mandatory and optional, of that Directive. Accordingly it is a principle of EC law that the Trade Marks Act 1994 must be construed, so far as possible, to be in accordance with that Directive<sup>3</sup>. That may in turn involve questions of interpretation of that Directive. Such questions can be, and in appropriate cases are, referred to the European Court of Justice<sup>4</sup>. Although the 'Statements for Entry in the Minutes of the Council Meeting at which the Directive is adopted' apparently prepared by the European Council and Commission have been published by the Office for Harmonisation in the Internal Market<sup>5</sup>, it seems clear that those statements cannot be used in construing the Directive<sup>6</sup>, particularly since the adoption of the Directive was, as stated in the recitals, in co-operation with the European Parliament and the Economic and Social Committee, both of which bodies were not parties to the entries in the minutes.

The purposes of the Directive are, as is usual, set out in the recitals. The main purpose is not comprehensive harmonisation of the whole field of trade mark law; it is limited to approximating those national provisions of law which most directly affect the functioning of the internal market<sup>7</sup>. Many procedural matters are left to member states<sup>8</sup>, and the right to protect trade marks acquired through use is preserved to the member states<sup>9</sup>.

The provisions of the Directive correspond closely to the substantive provisions of the Community Trade Mark Regulation<sup>10</sup>.

<sup>1</sup> See the long title to the Trade Marks Act 1994. As to the status of long titles see STATUTES vol 44(1) (Reissue) PARA 1264.

<sup>2</sup> I.e. EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks.

<sup>3</sup> See Case C-106/89 *Marleasing SA v La Comercial Internacional de Alimentación SA* [1990] ECR I-4135, [1992] 1 CMLR 305, ECJ.

<sup>4</sup> Cases in which questions of interpretation of the Directive have been referred to the European Court of Justice by English courts include: *Scandecor Development AB v Scandecor Marketing AB* [2001] UKHL 21, [2001] IP & T 676, [2002] FSR 122 (questions referred to European Court of Justice but case settled prior to ruling); Joined Cases C-414/99 to C-416/99 *Zino Davidoff SA v A & G Imports Ltd* [2002] Ch 109, [2001] ECR I-8691, ECJ; Case C-143/00 *Boehringer Ingelheim KG v Swingward Ltd* [2003] Ch 27, [2002] ECR I-3759, ECJ; Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ; Case C-206/01 *Arsenal Football Club plc v Reed* [2003] Ch 454, [2002] ECR I-10273, ECJ; Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159, ECJ; Case C-404/02 *Nichols plc v Registrar of Trade Marks* [2004] ECR I-8499, [2005] All ER (EC) 1, ECJ; Case C-353/03 *Société des Produits Nestlé SA v Mars UK Ltd* [2005] ECR I-6135, [2006] All ER (EC) 348, ECJ; Case C-259/04 *Emanuel v Continental Shelf 128 Ltd* [2006] IP & T 887, sub nom *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* [2006] ETMR 56, ECJ; *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] EWCA Civ 1656, [2007] RPC 407, [2007] ETMR 19.

<sup>5</sup> OJ OHIM 5/96 p 606. As to the Office for Harmonisation in the Internal Market see PARA 180 et seq post.

<sup>6</sup> Case C-245/02 *Anheuser-Busch Inc v Budejovický Budvar NP* [2004] ECR I-10989, [2007] IP & T 348, [2004] All ER (D) 271 (Nov), ECJ. The true meaning of rules of EC law can be derived only from those rules themselves, having regard to their context; the meaning cannot be affected by a statement by the member states inserted in the minutes of the EC Council meeting relating to the adoption of the act in question: Case 237/84 *Re*



*Business Transfer Directive, EC Commission v Belgium* [1986] ECR 1247 at 1256, [1988] 2 CMLR 865 at 873, ECJ; Case C-292/89 *R v Immigration Appeal Tribunal, ex p Antonissen* [1991] ECR I-745, [1991] 2 CMLR 373, ECJ; Case C-306/89 *Re Transport Workers, EC Commission v Greece* [1991] ECR I-5863, [1994] 1 CMLR 803, ECJ; Joined Cases C-197/94 and C-252/94 *Société Bautiaa v Directeur Service Fiscaux des Landes* [1996] ECR I-505, ECJ. See also *Wagamama Ltd v City Centre Restaurants plc* [1995] FSR 713, [1996] ETMR 23; Case R 46/1992-2 *Giacomelli Sport SpA's Application* [2000] ETMR 277, OHIM Board of Appeal.

7 EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) 3rd recital.

8 Member states remain free to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration; they can eg determine the form of trade mark registration and invalidity procedures, decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both and, if they allow earlier rights to be invoked in the registration procedure, have an opposition procedure or an ex officio examination procedure or both; member states remain free to determine the effects of revocation or invalidity of trade marks: *ibid* 5th recital.

9 *Ibid* 4th recital. In the case of the United Kingdom such unregistered marks are protected under the law of passing off (as to which see PARA 304 et seq post). The Trade Marks Directive takes unregistered marks into account only in regard to the relationship between them and trade marks acquired by registration: 4th recital.

10 *Ie* EC Council Regulation 40/94 (OJ L11, 14.1.94, p. 1) on the Community Trade Mark: see PARA 176 et seq post.

## UPDATE

### 5 The Trade Marks Directive

TEXT AND NOTES--Directive 89/104 replaced: European Parliament and EC Council Directive 2008/95 (OJ L299, 8.11.2008, p 25).

NOTE 4--For European Court of Justice decision in *O2 Holdings*, cited, see Case C-533/06 *O2 Holdings Ltd v Hutchison 3G UK Ltd* [2008] 3 CMLR 397, [2008] All ER (D) 155 (Jun).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(ii) International Legislation/6. The Paris Convention.

## 6. The Paris Convention.

Under the International Convention for the Protection of Industrial Property (the 'Paris Convention')<sup>1</sup> the countries ('Convention countries')<sup>2</sup> acceding to it formed themselves into a union for the protection of industrial property<sup>3</sup>. Most countries are now members of the union. The basis of the union is equal treatment of the nationals and residents of the Convention countries. The Paris Convention is not itself part of either domestic or EC law, though it may be referred to in accordance with general principles<sup>4</sup>. The Trade Marks Act 1994 does, however, implement a number of provisions of the Paris Convention, namely:

- 1 (1) the recognition of priority in Convention countries based on a first application in one Convention country<sup>5</sup>;
- 2 (2) the protection of well known trade marks<sup>6</sup>;
- 3 (3) controls on the registration of flags, armorial bearings, hallmarks or official signs of Convention countries or of international intergovernmental organisations<sup>7</sup>;
- 4 (4) the protection by means of a right to an injunction in respect of the matters mentioned in head (3) above<sup>8</sup>; and
- 5 (5) measures to prevent an agent of a person in a Convention country from registering or holding a mark of which that person is the owner<sup>9</sup>.

The Secretary of State<sup>10</sup> may by order make such amendments of the Trade Marks Act 1994, and rules made under it, as appear to him to be appropriate in consequence of any revision or amendment of the Paris Convention on or after 31 October 1994<sup>11</sup>.

1 The International Convention for the Protection of Industrial Property (Paris, 20 March 1883) (the 'Paris Convention'), as revised (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431). As to the Convention see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 652. For the purposes of the Trade Marks Act 1994, 'the Paris Convention' means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time: Trade Marks Act 1994 s 55(1)(a) (amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(2)). The text of the Convention is available from the World Intellectual Property Organisation ('WIPO') or on its website, accessible at the date at which this title states the law at [www.wipo.int](http://www.wipo.int).

2 For the purposes of the Trade Marks Act 1994, a 'Convention country' means a country, other than the United Kingdom, which is a party to the Paris Convention or to the WTO Agreement: Trade Marks Act 1994 s 55(1)(b) (amended by the Intellectual Property (Enforcement, etc) Regulations 2006, SI 2006/1028, Sch 2 para 18). For the meaning of 'United Kingdom' see PARA 12 note 2 post. As to the WTO Agreement see PARA 7 post.

3 'Property' covers patents, utility models, industrial designs, trade marks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition: see the International Convention for the Protection of Industrial Property art 1(2). The term is to be understood in its broadest sense: see art 1(3), (4). Broadly speaking, the Convention relates to all forms of intellectual property save for copyright.

4 See INTERNATIONAL RELATIONS LAW vol 61 (2010) PARA 12 et seq.

5 See the Trade Marks Act 1994 s 35; and PARA 378 post.

6 See *ibid* s 56 (as amended); and PARA 153 post.

7 See *ibid* ss 57-59 (as amended); and PARAS 67-68, 490-491 post.

8 See *ibid* ss 57(6), 58(4); and PARAS 490-491 post.

9 See *ibid* s 60; and PARA 154 post.

10 As to the Secretary of State see PARA 14 post.

11 Trade Marks Act 1994 s 55(2) (amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(3)). Any such order must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament: Trade Marks Act 1994 s 55(3). At the date at which this volume states the law no such order had been made.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(ii) International Legislation/7. The WTO Agreement and TRIPs.

## 7. The WTO Agreement and TRIPs.

The Agreement establishing the World Trade Organisation ('the WTO Agreement') was signed at Marrakesh on 15 April 1994<sup>1</sup>. That Agreement consisted of a series of individual agreements dealing with different subject matters, one of which was the Agreement on Trade-Related Aspects of Intellectual Property Rights, commonly known as 'TRIPs'<sup>2</sup>. The overall purpose of TRIPs is to reduce distortions and impediments to international trade arising from excessive discrepancies in national rules protecting intellectual property<sup>3</sup>. To that end, it contains provisions designed to lay down minimum standards concerning the availability, scope and use of intellectual property rights including trade marks<sup>4</sup>, together with minimum procedural standards for enforcement of intellectual property rights<sup>5</sup>. The WTO Agreement has been declared to be a Community Treaty for the purposes of the European Communities Act 1972<sup>6</sup>, and the European Court of Justice has held itself to have jurisdiction to interpret at least some aspects of TRIPs<sup>7</sup>.

TRIPs requires its members to give effect inter se to most of the substantive provisions of the Paris Convention<sup>8</sup>, including those relating to trade marks<sup>9</sup>. In some respects, it expands the effect of those provisions. TRIPs requires that the protection of well known marks provided for under the Paris Convention is to apply to marks for services as well as to trade marks for goods<sup>10</sup>. Effect has been given to this extension of protection for well known marks in United Kingdom domestic law<sup>11</sup>. TRIPs also requires that the protection of well known marks is to extend to goods or services which are not similar to those in respect of which the trade mark is registered, provided that the use of the trade mark would indicate a connection and there is a likelihood of damage<sup>12</sup>; however, it does not appear that effect has been given to this provision in United Kingdom domestic law<sup>13</sup>.

The Secretary of State<sup>14</sup> may by order make such amendments of the Trade Marks Act 1994, and rules made under it, as appear to him to be appropriate in consequence of any revision or amendment of the WTO Agreement (including TRIPs) on or after 31 October 1994<sup>15</sup>.

1 See the Agreement establishing the World Trade Organisation (Marrakesh, 15 April 1994; Cm 2557). The Agreement is commonly referred to, and is abbreviated in the text of the statute, as 'the WTO Agreement'. Most countries in the world have acceded to the WTO Agreement. For the purposes of the Trade Marks Act 1994, 'the WTO Agreement' means that Agreement: see s 55(1)(aa) (added by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(2)).

2 See the Agreement on Trade-Related Aspects of Intellectual Property Rights ('TRIPs') (1994) (Cm 2557). The text of TRIPs is available from the World Trade Organisation ('WTO') or on its website, accessible at the date at which this title states the law at [www.wto.org](http://www.wto.org).

3 Ibid preamble.

4 Ibid Pt II, s 2 (arts 15 to 21), defines what kinds of signs member states must treat as protectable subject matter for trade mark registration, defines in broad terms the exclusive right which flows from registration and the minimum term of protection, allows cancellation for non-use only if an uninterrupted period of at least three years has elapsed, and prevents member states from unjustifiably encumbering the use of a trade mark in the course of trade or granting compulsory licences of trade marks.

5 Ibid Pt III. Articles 42-49 provide for civil and administrative procedures and remedies, including injunctions (art 44), damages (art 45) and seizure of infringing goods (art 46). Article 50 requires that the judicial authorities be given power to order prompt and effective provisional measures (such as temporary or interim injunctions). Articles 51-60 provide for customs seizures of infringing goods. Article 61 requires the member

states to provide for criminal procedures and penalties to be applied at least in cases of wilful trademark counterfeiting on a commercial scale.

6 See the European Communities (Definition of Treaties) (The Agreement Establishing the World Trade Organisation) Order 1995, SI 1995/265.

7 Case C-53/96 *Hermès International Société en commandite par actions, Paris v FHT Marketing Choice BV* [1998] ECR I-3603, [1999] RPC 107, [1998] All ER (D) 275, ECJ.

8 The International Convention for the Protection of Industrial Property (Paris, 20 March 1883) (the 'Paris Convention'), as revised (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431). As to the Paris Convention see PARA 6 ante.

9 The Agreement on Trade-Related Aspects of Intellectual Property Rights art 2(1) requires members to comply with the Paris Convention arts 1-12, 19.

10 The Agreement on Trade-Related Aspects of Intellectual Property Rights art 16(2) requires that the Paris Convention art 6(bis) (which provides for the protection of well known marks) is to apply *mutatis mutandis* to services: see PARA 153 post.

11 See the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(4) (made under the European Communities Act 1972 s 2(2)), which amends the Trade Marks Act 1994 s 56(1) and (2) by adding a reference to the WTO Agreement after the reference to the Paris Convention. Thus the Trade Marks Act 1994 s 56 (see PARA 153 post) on the protection of well known marks will apply to marks for services upon which protection is conferred by TRIPs art 16(2), as well as to marks for goods which are protected by the Paris Convention art 6(bis) as it applied in the absence of TRIPs. The Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 14(1) contains a transitional provision protecting persons who continue a bona fide use of a trade mark begun before 1 January 1996. Corresponding amendments are made by reg 13(1) to the Trade Marks Act 1994 s 6(1)(c) (see PARA 70 post), so conferring on the owner of a well known service mark protected under TRIPs the right to object to someone else attempting to register an identical or similar mark: see PARAS 70-72, 153 post.

12 Agreement on Trade-Related Aspects of Intellectual Property Rights art 16(3).

13 The Trade Marks Act 1994 s 56(2) (as amended: see PARA 153 post) gives the proprietor of the well known mark the right to restrain use in relation to identical or similar goods or services. The Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13, while inserting a reference to the WTO Agreement (see note 11 *supra*), has not amended the wording of the provision to extend its scope to goods or services which are not similar. It may be arguable, however, that an effect of the WTO Agreement having been defined as a Community Treaty (see note 6 *supra*) is that some of its provisions could enjoy direct effect within the domestic law of the United Kingdom by virtue of the European Communities Act 1972 s 2(1); in which case, TRIPs art 16(3) might be construed as having such direct effect.

14 As to the Secretary of State see PARA 14 post.

15 Trade Marks Act 1994 s 55(2) (amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(3)). Any such order must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament: Trade Marks Act 1994 s 55(3). At the date at which this volume states the law no such order had been made.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(ii) International Legislation/8. The Madrid Agreement and the Madrid Protocol.

## **8. The Madrid Agreement and the Madrid Protocol.**

The Madrid Agreement Concerning the International Registration of Marks<sup>1</sup> provides for a system by which a mark registered in one country may be deposited with an international bureau<sup>2</sup> and will take effect, subject to prior rights, in other countries which are parties to the Madrid Agreement. An application so made is called an 'international application' and a mark so registered an 'international registration'. The United Kingdom<sup>3</sup> is not a party to the Madrid Agreement, but is a party to the Protocol to the Madrid Agreement<sup>4</sup>. The parties to the Protocol, even where they are not party to the Madrid Agreement, are members of the same union of which countries party to the Madrid Agreement are members<sup>5</sup>.

The Secretary of State<sup>6</sup> may by order make such provision as he thinks fit for giving effect in the United Kingdom to the provisions of the Madrid Protocol<sup>7</sup>. Provision may in particular be made with respect to:

- 6 (1) the making of applications for international registrations by way of the Patent Office<sup>8</sup> as office of origin<sup>9</sup>;
- 7 (2) the procedures to be followed where the basic United Kingdom application or registration fails or ceases to be in force<sup>10</sup>;
- 8 (3) the procedures to be followed where the Patent Office receives from the International Bureau<sup>11</sup> a request for extension of protection to the United Kingdom<sup>12</sup>;
- 9 (4) the effects of a successful request for extension of protection to the United Kingdom<sup>13</sup>;
- 10 (5) the transformation of an application for an international registration, or an international registration, into a national application for registration<sup>14</sup>;
- 11 (6) the communication of information to the International Bureau<sup>15</sup>;
- 12 (7) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals<sup>16</sup>.

Without prejudice to the generality of the above provisions, provision may be made by regulations applying, in relation to an international trade mark (UK)<sup>17</sup>, the statutory provisions relating to the remedy for groundless threats of infringement proceedings<sup>18</sup>, the importation of infringing goods, material or articles<sup>19</sup>, and offences<sup>20</sup>.

1 The Madrid Agreement Concerning the International Registration of Marks (Madrid, 14 April 1891; TS 71 (1970); Cmnd 4437), as revised at Stockholm in 1967 and as amended in 1979.

2 This bureau is known as the International Bureau of the World Intellectual Property Organisation ('WIPO') and is based in Geneva.

3 For the meaning of 'United Kingdom' see PARA 3 note 2 post.

4 The Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid, 27 June 1989; Cmnd 1601), as amended in 2006. The Protocol was also published with the parallel text of the Madrid Agreement Concerning the International Registration of Marks by WIPO in 1990. The Madrid Agreement itself has, however, still not been ratified by the United Kingdom. The text of both the Madrid Agreement and the Protocol is available from WIPO or on its website, accessible at the date at which this title states the law at [www.wipo.int](http://www.wipo.int).

5 Protocol relating to the Madrid Agreement Concerning the International Registration of Marks art 1. The European Community has also acceded to the Madrid Protocol: EC Council Regulation 40/94 (OJ L11, 14.1.94, p

1) on the Community trade mark, arts 140-156 (added by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p.1)); EC Council Decision 2003/793 (OJ L296, 14.11.03, p 20) approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989. See note 17 infra; and PARA 176 post.

6 As to the Secretary of State see PARA 14 post.

7 Trade Marks Act 1994 s 54(1). For these purposes, 'the Madrid Protocol' means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27 June 1980 (see note 4 supra): Trade Marks Act 1994 s 53.

Under this power, the Secretary of State has made the Trade Marks (International Registration) Order 1996, SI 1996/714 (as amended), which came into force on 1 April 1996. See further PARAS 11-13 post.

8 As to the Patent Office, its organisation and seal see PARA 14 note 2 post; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

9 Trade Marks Act 1994 s 54(2)(a).

10 Ibid s 54(2)(b).

11 For these purposes, 'the International Bureau' means the International Bureau of the World Intellectual Property Organisation (see note 2 supra): Protocol relating to the Madrid Agreement Concerning the International Registration of Marks art 2(1); definition applied by the Trade Marks Act 1994 s 53.

12 Ibid s 54(2)(c).

13 Ibid s 54(2)(d).

14 Ibid s 54(2)(e).

15 Ibid s 54(2)(f).

16 Ibid s 54(2)(g). An order under s 54 must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament: s 54(4).

17 For these purposes, 'international trade mark (UK)' means a trade mark which is entitled to protection in the United Kingdom under the Madrid Protocol and 'international trade mark (EC)' means a trade mark which is entitled to protection in the European Community under the Madrid Protocol: Trade Marks Act 1994 s 53 (amended by the Trade Marks (International Registrations Designating the European Community etc) Regulations, SI 2004/2332, reg 5).

18 Ie the Trade Marks Act 1994 s 21: see PARAS 123-125 post.

19 Ie ibid ss 89-91 (as amended): see PARAS 149-152 post.

20 Ibid s 54(3). The provisions so specified in relation to offences are s 92 (see PARAS 141-144 post), s 93 (see PARA 146 post), s 95 (see PARA 148 post) and s 96 (as amended) (supplementary provisions relating to summary proceedings in Scotland): s 54(3).

## UPDATE

### 8 The Madrid Agreement and the Madrid Protocol

NOTE 7--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(ii) International Legislation/9. The Trademark Law Treaty and the Singapore Treaty on the Law of Trademarks.

## **9. The Trademark Law Treaty and the Singapore Treaty on the Law of Trademarks.**

The Trademark Law Treaty ('TLT')<sup>1</sup> was adopted under the auspices of the World Intellectual Property Organisation ('WIPO')<sup>2</sup>. Its aim is to make national and regional trade mark registration systems more user-friendly by simplifying and harmonising procedures during the phases of application, changes after registration and renewal<sup>3</sup>. The Singapore Treaty on the Law of Trademarks<sup>4</sup> was also adopted under the auspices of WIPO, and is a revision of the TLT. Its aim is similar to that of the TLT, but it has a wider scope of application and addresses new developments in the field of communication technology, as well as making procedural changes<sup>5</sup>.

1 The Trademark Law Treaty (Geneva, 27 October 1994; TS 76 (1996); Cm 3348). The text of the treaty is available from WIPO or on its website, accessible at the date at which this title states the law at [www.wipo.int](http://www.wipo.int).

2 See PARA 8 text and note 2 ante.

3 The United Kingdom has ratified the Trademark Law Treaty, but the Trade Marks Act 1994 contains no express reference to it.

4 The Singapore Treaty on the Law of Trademarks (Singapore, 27 March 2006). The text of the treaty is available from WIPO or on its website, accessible at the date at which this title states the law at [www.wipo.int](http://www.wipo.int).

The Singapore Treaty will enter into force when it has been ratified by ten eligible states or intergovernmental organisations: art 28. At the date on which this title states the law the Singapore Treaty is not yet in force.

5 The United Kingdom is a signatory to the Singapore Treaty and may be expected to ratify it in due course. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(ii) International Legislation/10. The Nice Agreement.

## **10. The Nice Agreement.**

The Nice Agreement<sup>1</sup> establishes an International Classification of goods and services for the purposes of registering trade marks. The International Classification consists of a list of classes (currently 34 for goods and 11 for services) and an alphabetical list of goods and services allocating them to classes (currently comprising some 11,000 items). Both lists are from time to time amended and supplemented by a Committee of Experts on which all contracting states are represented<sup>2</sup>.

1 The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice, 15 June 1957; Misc 16 (1977); Cmnd 6898), revised at Stockholm on 14 July 1967 and at Geneva on 13 May 1977 and amended on 28 September 1979.

2 The ninth edition of the International Classification entered into force on 1 January 2007. At the date at which this title states the law the ninth edition was given effect in the United Kingdom by the Trade Marks Rules 2000, SI 2000/136, r 7(2) (as substituted): see PARA 370 post. Copies of the International Classification are available from the World Intellectual Property Organisation and from its website, accessible at the date at which this title states the law at [www.wipo.int](http://www.wipo.int).

### **UPDATE**

## **10 The Nice Agreement**

NOTE 2--SI 2000/136 r 7(2) now Trade Marks Rules 2008, SI 2008/1797.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(iii) International Trade Marks/11. International registration of trade marks.

### **(iii) International Trade Marks**

#### **11. International registration of trade marks.**

In order for the United Kingdom<sup>1</sup> to participate in the system of international registration of trade marks in accordance with the Madrid Protocol<sup>2</sup>, it has been necessary to make provision in domestic law for two main aspects of the system, namely: (1) outgoing international applications, that is, applications for international protection which are based upon a United Kingdom registered trade mark or a trade mark application filed in the United Kingdom; and (2) the legal effects within the United Kingdom of international trade marks which receive protection here and for the domestic procedures by which such protection is conferred. Provision has been made in the domestic law of the United Kingdom for both these aspects by the Trade Marks (International Protection) Order 1996<sup>3</sup>. The international aspects of the trade mark registration process, that is the procedures operated by the International Bureau<sup>4</sup> including the maintenance of and the making of entries in the international register, are governed directly by the Madrid Protocol and by the Common Regulations<sup>5</sup>.

1 For the meaning of 'United Kingdom' see PARAS 3 note 2 ante, 12 note 3 post.

2 As to the Madrid Protocol see PARA 8 ante.

3 See the Trade Marks (International Registration) Order 1996, SI 1996/714 (as amended), made under the Trade Marks Act 1994 s 54. See further PARAS 12-13 post.

4 I.e the International Bureau of the World Intellectual Property Organisation ('WIPO'): see PARA 8 text and note 2 ante.

5 I.e the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, adopted by the Assembly of the Madrid Union with effect from 1 April 1996, as amended with effect from 1 April 2004. The text of the Common Regulations is available from WIPO or on its website, accessible at the date at which this title states the law at [www.wipo.int](http://www.wipo.int).

### **UPDATE**

#### **11-13 International Trade Marks**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(iii) International Trade Marks/12. Outgoing applications for international protection.

## **12. Outgoing applications for international protection.**

The proprietor of a United Kingdom trade mark, or an applicant for such a mark, may apply through the Registrar of Trade Marks<sup>1</sup> for the international registration of the trade mark<sup>2</sup>. However, this route of application via the United Kingdom registrar is restricted to persons or bodies with a specified connection with the United Kingdom<sup>3</sup>; persons or bodies not having the necessary United Kingdom connections will need to make their application for international protection via the registry of some other country with which they are connected, based on an appropriate application or trade mark registration there. If the application is in order<sup>4</sup>, the registrar must submit the international application to the International Bureau<sup>5</sup>, and must also notify the International Bureau of subsequent events which affect the status of the domestic application or registered trade mark upon which the international application is based<sup>6</sup>. The registrar may accept fees for transmission to the International Bureau in relation to an application made through him or for the renewal of an international registration originating in the United Kingdom<sup>7</sup>.

1 As to the registrar see PARA 17 post.

2 Trade Marks (International Registration) Order 1996, SI 1996/714, art 22(1). 'International registration' means the registration of a trade mark in the international register: art 2. 'International register' means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol: Trade Marks (International Registration) Order 1996, SI 1996/714, art 2. As to the Madrid Protocol see PARA 8 ante. 'International Bureau' means the International Bureau of the World Intellectual Property Organisation ('WIPO') (see PARA 8 text and note 2 ante): Trade Marks (International Registration) Order 1996, SI 1996/714, art 2.

3 The applicant must be a British citizen, a British overseas territories citizen, a British overseas citizen, a British subject or a British protected person, or be domiciled in the United Kingdom, or have a real and effective industrial or commercial establishment in the United Kingdom, or be a body or corporation sole incorporated or constituted under the law of any part of the United Kingdom: *ibid* art 22(2) (amended by the British Overseas Territories Act 2002 s 2(3)). The applicant must provide at the request of the registrar such evidence as may be necessary to satisfy him that the applicant is eligible to make the application: Trade Marks (International Registration) Order 1996, SI 1996/714, art 22(4). 'United Kingdom' for these purposes includes the Isle of Man: art 2. For the meaning of 'United Kingdom' generally see PARA 3 note 2 ante.

4 The particulars appearing in the application must correspond with the particulars appearing at that time in the basic application or basic registration as the case may be: *ibid* art 22(3). The application or registration upon which the international application is based is referred to as the 'basic application' or the 'basic registration': art 22(6). This terminology is adopted from the Common Regulations, r 1 (xiii), (xiv). As to the Common Regulations see PARA 11 note 5 ante.

5 Trade Marks (International Registration) Order 1996, SI 1996/714, art 22(5).

6 See *ibid* art 23, which sets out the events which the registrar is required to notify. 'International application' means an application to the International Bureau for registration of a trade mark in the international register: art 2.

7 See *ibid* art 31.

## **UPDATE**

### **11-13 International Trade Marks**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(1) LEGISLATION AND INTERNATIONAL BACKGROUND/(iii) International Trade Marks/13. Effects within the United Kingdom of international registrations.

### **13. Effects within the United Kingdom of international registrations.**

A request may be made to extend the protection of an international registration<sup>1</sup> to the United Kingdom, either in a relevant international application<sup>2</sup> or subsequently<sup>3</sup>. Such an international registration is or becomes an 'international registration designating the United Kingdom'<sup>4</sup> and the International Bureau<sup>5</sup> notifies the United Kingdom registrar<sup>6</sup>, who then examines it in the same way as a domestic application<sup>7</sup>, and against the same substantive requirements for registrability<sup>8</sup>. If it appears to him that those requirements are not met, the registrar gives notice of provisional refusal to the International Bureau<sup>9</sup>; or if it appears that those requirements are met, the registrar publishes a notice specifying particulars of the international application and specifying the goods or services on which protection will be conferred<sup>10</sup>. There are provisions allowing any person to oppose the conferring of protection, which mirror those allowing opposition proceedings against the registration of a domestic trade mark<sup>11</sup>. Subject to any such opposition, or to the registrar changing his mind whether as a result of third party observations<sup>12</sup> or otherwise, after the publication of the notice, the international registration becomes protected as a 'protected international trade mark (UK)'<sup>14</sup>. When it becomes protected, the registrar must publish a notice specifying the number of the international registration, the date on which protection is conferred and the date and place of publication of the notice<sup>15</sup>. Once the international registration has achieved the status of a protected international trade mark (UK), it is thereafter treated for all intents and purposes like a domestic trade mark which has been registered under the Trade Marks Act 1994<sup>16</sup>.

Where an international registration designating the United Kingdom is cancelled or the range of goods or services which it covers is restricted at the request of the office of origin<sup>17</sup>, the holder of the international registration may within three months make a transformation application to the British registrar in respect of some or all of the goods or services in respect of which the international registration was cancelled<sup>18</sup>. If the international registration has achieved protection in the United Kingdom, the holder of the cancelled international registration is entitled to be granted a domestic registered trade mark replacing the cancelled international registration<sup>19</sup> and enjoying the same date of registration<sup>20</sup>; where the international registration has not yet achieved protected status in the United Kingdom, the transformation application effectively becomes an application for a domestic trade mark putting the holder in the same position as if he had applied to the British registry for a domestic registered trade mark in the first place<sup>21</sup>.

1 For the meaning of 'international registration' see PARA 12 note 2 ante.

2 For the meaning of 'international application' see PARA 12 note 6 ante.

3 I.e. under the Madrid Protocol art 3(ter)(1) or (2). As to the Madrid Protocol see PARA 8 ante.

4 Trade Marks (International Registration) Order 1996, SI 1996/714, art 2.

5 For the meaning of 'International Bureau' see PARA 12 note 2 ante.

6 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(1).

7 See *ibid* arts 3, 9(1), (2).

8 See *ibid* art 3(1). As to the requirements for registrability see PARA 55 *et seq post*. As to the provisions of the Trade Marks Act 1994 and the Trade Marks Rules 2000, SI 2000/136, which are to be disregarded in relation to international registration see the Trade Marks (International Registration) Order 1996, SI 1996/714, art 3(2); and PARA 365 *post*.

9 See *ibid* art 9(3) (amended by SI 2002/692). Notice of provisional refusal must specify a period within which the holder may make representations: Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(4). A holder making representations must file an address for service in the United Kingdom, another EEA state or the Channel Islands on Form TM33: art 9(5) (amended by SI 2006/763). For the meaning of 'United Kingdom' see PARA 3 note 2 *ante*. 'EEA state' means a member state, Iceland, Liechtenstein or Norway: Trade Marks (International Registration) Order 1996, SI 1996/714, art 2 (amended by SI 2006/763).

Except where it is based on an opposition the notice of provisional refusal must not be given after the expiry of 18 months of the date on which the International Bureau sent notification of the request for extension to the United Kingdom (Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(1) (art 11 substituted by SI 2002/692)); and the notice must set out the matters required by the Madrid Protocol art 5 and by the Common Regulations r 17 (Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(3) (as so substituted)). As to the Common Regulations see PARA 11 note 5 *ante*. The registrar must inform the International Bureau that oppositions may be filed after the expiry of the period of 18 months unless, at least four months before the expiry of that period, he has published the notice referred to in the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (see the text and note 10 *infra*): art 11(2) (as so substituted). Where the registrar has given notice of provisional refusal to the International Bureau pursuant to art 9(3) (as amended) (see PARA 373 *post*), art 9A(1) (as added) (see PARA 373 *post*) or art 10A(5) (as added) (see PARA 384 *post*), the registrar must, upon deciding whether the provisional refusal is to be upheld, in whole or in relation to some only of the goods or services in relation to which protection in the United Kingdom is requested, notify the International Bureau of that decision: art 11(4) (as so substituted; and amended by SI 2004/948). Where, after such a decision has been notified to the International Bureau the decision is referred to an appointed person or the court on appeal or further appeal from the registrar, the registrar must notify the International Bureau of the decision of that person or court: Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(5) (as so substituted).

10 *Ibid* art 10(1) (art 10 substituted by SI 2004/948). The registrar may consider that these requirements are met across part but not all of the range of goods or services comprised in the international registration, in which case he publishes a notice in respect of the range which he accepts and sends a notice of provisional refusal in respect of the rest of the range: see the Trade Marks (International Registration) Order 1996, SI 1996/714, arts 9(3) (as so amended), 10(1) (as so substituted).

11 See *ibid* arts 10A-10C (arts 10A-10C as added; and art 10A as amended); and PARAS 357, 384-385 *post*.

12 As to the submission of such observations see *ibid* art 10(3) (as substituted: see note 10 *supra*).

14 *Ibid* arts 2, 12 (art 12 amended by SI 2002/692). A protected international trade mark (UK) is generally treated as being registered under the Trade Marks Act 1994 as of the date of the international registration: see the Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(2); and PARA 21 *post*.

15 *Ibid* art 12(3) (substituted by SI 2002/692).

16 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(1). Because the treatment accorded to the two species of marks is so similar, the other provisions of the Trade Marks (International Registration) Order 1996, SI 1996/714, relating to protected international trade marks (UK) are noted in detail in the paragraphs of this title which deal with the corresponding provisions of the Trade Marks Act 1994 relating to United Kingdom registered trade marks.

17 *Ie* the office in the country of the basic application or the basic registration upon which the international registration is based. That office is required to notify the International Bureau if the basic application or registration fails or is restricted in scope within five years of the date of international registration (Madrid Protocol art 6(3), (4)); after that period, the international registration becomes independent of the basic application or registration (art 6(2)).

18 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 19(1). A transformation application must be made on Form TM3 and must state that it is made by way of transformation: art 19(2).

19 *Ibid* art 20(1).

20 See *ibid* art 19(3).

21 See *ibid* art 20(2), (3).

## UPDATE

### **11-13 International Trade Marks**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

### **13 Effects within the United Kingdom of international registrations**

NOTE 8--SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(i) The Secretary of State/14. Functions of the Secretary of State.

## **(2) ADMINISTRATION**

### **(i) The Secretary of State**

#### **14. Functions of the Secretary of State.**

The Secretary of State<sup>1</sup> is responsible for the Patent Office<sup>2</sup>. He appoints and supervises the Comptroller General of Patents, Designs and Trade Marks<sup>3</sup>, who has the immediate control of the Patent Office<sup>4</sup> and is the Registrar of Trade Marks<sup>5</sup>. The Secretary of State may appoint and remove examiners and other officers and clerks for the Patent Office<sup>6</sup>. The Secretary of State has power to make rules<sup>7</sup> and to prescribe fees<sup>8</sup>.

The Secretary of State no longer has any direct involvement in the administration of registered trade marks<sup>9</sup>.

1 He one of Her Majesty's principal Secretaries of State: see the Interpretation Act 1978 s 5, Sch 1. As to the office of Secretary of State see CONSTITUTIONAL LAW AND HUMAN RIGHTS vol 8(2) (Reissue) PARA 355.

2 As to the Patent Office, its organisation and seal see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet. In relation to its functions as to trade marks the Patent Office is generally called the Trade Marks Registry. Its address is Concept House, Cardiff Road, Newport, Gwent, NP10 8QQ; and its London office is at Harmsworth House, 13-15 Bouverie Street, London EC4Y 8DP. As to the business hours and the business days of the Patent Office see PARA 352 post.

3 As to the Comptroller General of Patents, Designs and Trade Marks see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

4 See the Patents and Designs Act 1907 s 62(2) (as amended); and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

5 See the Trade Marks Act 1994 s 62; and PARA 17 post.

6 Patents and Designs Act 1907 s 63(1) (amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 2(1), (3)(a)).

7 See PARA 15 post.

8 See PARA 16 post.

9 His former function of supervision etc of certification trade marks (ie under the Trade Marks Act 1938 s 37 (repealed)) is now exercisable by the registrar (see the Trade Marks Act 1994 s 50, Sch 2; and PARA 165 et seq post); and his former function of hearing appeals from the registrar (eg under the Trade Marks Act 1938 s 17(4) (repealed)) is now exercisable by a person appointed for the purpose (see the Trade Marks Act 1994 ss 76, 77 (both as amended); and PARAS 405-408 post).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(i) The Secretary of State/15. Power to make rules.

## **15. Power to make rules.**

The Secretary of State<sup>1</sup> may make rules:

- 13 (1) for the purposes of any provision of the Trade Marks Act 1994 authorising the making of rules with respect to any matter; and
- 14 (2) for prescribing anything authorised or required by any provision of that Act to be prescribed,

and generally for regulating practice and procedure under that Act<sup>2</sup>.

Provision may in particular be made: (a) as to the manner of filing of applications and other documents; (b) requiring and regulating the translation of documents and the filing and authentication of any translation; (c) as to the service of documents; (d) authorising the rectification of irregularities of procedure; (e) prescribing time limits for anything required to be done in connection with any proceeding under the Trade Marks Act 1994; (f) providing for the extension of any time limit so prescribed, or specified by the registrar<sup>3</sup>, whether or not it has already expired<sup>4</sup>.

Rules under the Trade Marks Act 1994 must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament<sup>5</sup>.

<sup>1</sup> As to the Secretary of State see PARA 14 ante.

<sup>2</sup> Trade Marks Act 1994 s 78(1). As to the rules that have been made see the Trade Marks Rules 2000, SI 2000/136 (as amended), which came into force on 17 February 2000 (r 1). Where an application for registration of a mark made under the old law is advertised on or after 31 October 1994, the period within which notice of opposition may be filed is three months from the date of advertisement and such period is not extendible: r 73. Except as provided by r 73, where (1) immediately before 17 February 2000 any time or period prescribed by the rules revoked by the Trade Marks Rules 2000, SI 2000/136 (as amended) had effect in relation to any act or proceeding and had not expired; and (2) the corresponding time or period prescribed by the Trade Marks Rules 2000, SI 2000/136 (as amended) would have expired or would expire earlier, the time or period prescribed by those other rules and not by the Trade Marks Rules 2000, SI 2000/136 (as amended) applies to that act or proceeding: r 74(2). As to the rules revoked by the Trade Mark Rules 2000, SI 2000/136 (as amended) see r 74(1), Sch 1. For these purposes, 'old law' means the Trade Marks Act 1938 and any rules made thereunder existing immediately before 31 October 1994 (ie the date on which the Trade Marks Act 1994 came into force: see the Trade Marks Act 1994 (Commencement) Order 1994, SI 1994/2550, art 2): Trade Marks Rules 2000, SI 2000/136, r 2(1). As to the meaning of 'old law' for the purposes of the Trade Marks Act 1994 see s 105, Sch 3 para 1(1); and PARA 4 note 3 ante. Any proceedings commenced before the registrar before 17 February 2000 must proceed under the Trade Marks Rules 1994, SI 1994/2583 (now revoked), or the old law as appropriate; but where a new step is to be taken on or after 26 April 2000 in relation to any such proceedings commenced under the Trade Mark Rules 1994, SI 1994/2583 (now revoked), the Trade Marks Rules 2000, SI 2000/136, apply to such proceedings from that date: r 74(3).

<sup>3</sup> As to the registrar see PARA 17 post.

<sup>4</sup> Trade Marks Act 1994 s 78(2).

<sup>5</sup> Ibid s 78(3). In so far as the rules are procedural rules for the registrar (see PARA 358 et seq post), the Secretary of State must consult with the Council on Tribunals before making them: see the Tribunals and Inquiries Act 1992 s 8(1), Sch 1 Pt 1 (as amended); and ADMINISTRATIVE LAW vol 1(1) (2001 Reissue) PARAS 56-57.

## **UPDATE**

**15-17 Power to make rules ... General functions, reports and publications of the Registrar of Trade Marks**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(i) The Secretary of State/16. Power to prescribe fees.

## **16. Power to prescribe fees.**

There must be paid in respect of applications and registration<sup>1</sup> and other matters under the Trade Marks Act 1994 such fees as may be prescribed<sup>2</sup>; and provision may be made by rules as to the payment of a single fee in respect of two or more matters and as to the circumstances, if any, in which a fee may be repaid or remitted<sup>3</sup>.

1 As to the requirements for registration see PARA 55 et seq post; and as to the procedure on the application see PARA 352 et seq post. For the meaning of 'registration' see PARA 19 note 2 post.

2 Trade Marks Act 1994 s 79(1); Trade Marks Rules 2000, SI 2000/136, r 4(1). Any form required to be filed with the registrar in respect of any specified matter is subject to the payment of the fee, if any, prescribed in respect of that matter by rules made under the Trade Marks Act 1994 s 79: Trade Marks Rules 2000, SI 2000/136, r 4(2). As to the use of forms see PARA 353 post; and as to the registrar see PARA 17 post.

As to the rules that have been made see the Trade Marks (Fees) Rules 2000, SI 2000/137, which came into force on 17 February 2000 (r 1). The Trade Marks (Fees) Rules 2000, SI 2000/137, are to be construed as one with the Trade Marks Rules 2000, SI 2000/136 (as amended) and the Trade Marks (International Registration) Order 1996, SI 1996/714 (as amended): Trade Marks (Fees) Rules 2000, SI 2000/137, r 2. The fees to be paid in respect of any matters arising under the Trade Marks Act 1994, the Trade Marks (International Registration) Order 1996, SI 1996/714 (as amended) and the Trade Marks Rules 2000, SI 2000/136 (as amended) are those specified in the Trade Marks (Fees) Rules 2000, SI 2000/137, r 3, Schedule; and in any case where a form specified therein as the corresponding form in relation to any matter is specified in the Trade Marks Rules 2000, SI 2000/136 (as amended) or the Trade Marks (International Registration) Order 1996, SI 1996/714 (as amended) that form must be accompanied, unless those rules or that order otherwise provides, by the fee, if any, specified in respect of that matter: Trade Marks (Fees) Rules 2000, SI 2000/137, r 3. All fees must be collected in money: see the Public Offices Fees (Patents, Designs and Trade Marks) Order 1964, SI 1964/45, art 1. As to the Secretary of State see PARA 14 ante.

3 Trade Marks Act 1994 s 79(2). Where a fee has been paid in error, the registrar must repay the same; and, where a fee is paid in excess of the amount specified in the Trade Marks (Fees) Rules 2000, SI 2000/137, the registrar must remit the amount paid in excess: r 4.

### **UPDATE**

#### **15-17 Power to make rules ... General functions, reports and publications of the Registrar of Trade Marks**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

#### **16 Power to prescribe fees**

NOTE 2--SI 2000/137 (as amended) replaced by Trade Marks (Fees) Rules 2008, SI 2008/1958 (amended by SI 2009/2089), except in relation to fees payable in respect of matters arising under SI 1996/714, in respect of which it is revoked by SI 2008/2207. For fee in relation to protected international trade marks (UK), see the Trade Marks (International Registration) Order 2008, SI 2008/2206, art 7, Sch 6 (Sch 6 amended by SI 2009/2426).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(ii) The Registrar of Trade Marks/17. General functions, reports and publications of the Registrar of Trade Marks.

## **(ii) The Registrar of Trade Marks**

### **17. General functions, reports and publications of the Registrar of Trade Marks.**

In the Trade Marks Act 1994, 'the registrar' means the Comptroller General of Patents, Designs and Trade Marks<sup>1</sup>. The register of trade marks<sup>2</sup> must be maintained by the registrar<sup>3</sup>. He has functions as to the registration of trade marks<sup>4</sup> and the rectification or correction of the register<sup>5</sup>. The registrar must include in his annual report as to patents and designs<sup>6</sup> a report on the execution of the Trade Marks Act 1994, including the discharge of his functions under the Madrid Protocol<sup>7</sup>; and that report must include an account of all money received and paid by him under or by virtue of the Act<sup>8</sup>. The registrar must also publish:

- 15 (1) a journal, entitled 'the Trade Marks Journal', containing particulars of any application for the registration of a trade mark<sup>9</sup>, including a representation of the mark, such information as is required to be published<sup>10</sup> and such other information relating to trade marks as the registrar thinks fit<sup>11</sup>;
- 16 (2) reports of cases relating to trade marks decided by him and of cases relating to trade marks decided by any court or body, whether in the United Kingdom<sup>12</sup> or elsewhere<sup>13</sup>.

1 Trade Marks Act 1994 s 62. As to his appointment and supervision by the Secretary of State see PARA 14 ante. As to the Comptroller General of Patents, Designs and Trade Marks generally see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577. In practice the principal functions of the Registrar of Trade Marks are carried out by an officer having the rank of Assistant Comptroller; and that officer is often called 'the registrar'. Other functions are carried out by officers and clerks appointed by the Secretary of State: see PARA 14 ante.

2 As to the register see PARA 19 post.

3 Trade Marks Act 1994 s 63(1).

4 See PARA 352 et seq post.

5 See PARAS 121, 396 et seq post.

6 Ie under the Patents Act 1977 s 121 (as amended): see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 578.

7 Trade Marks Act 1994 s 71(1). As to the Madrid Protocol see PARA 8 note 7 ante.

8 Trade Marks Act 1994 s 71(2).

9 For the meaning of 'trade mark' see PARA 57 post.

10 Ie under the Trade Marks Rules 2000, SI 2000/136 (as amended). For the purposes of the Trade Marks Act 1994, 'publish' means make available to the public; and references to publication in relation to an application for registration are to publication under s 38(1) (see PARA 383 post) and in relation to registration are to publication under s 40(4) (see PARA 388 post): s 103(1). For the purposes of the Trade Marks Rules 2000, SI 2000/136 (as amended), 'publish' means, unless the context otherwise requires, publish in the Trade Marks Journal: r 2(1).

11 Trade Marks Act 1994 s 81; Trade Marks Rules 2000, SI 2000/136, r 71.

12 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

13 See the Patents Act 1977 s 123(7) (as amended); the Patents Rules 1995, SI 1995/2093, r 116; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 580. Publication of the Reports of Patent, Design and Trade Mark Cases, commonly known as 'Reports of Patent Cases' (RPC), began in 1884.

## **UPDATE**

### **15-17 Power to make rules ... General functions, reports and publications of the Registrar of Trade Marks**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **17 General functions, reports and publications of the Registrar of Trade Marks**

NOTE 13--SI 1995/2093 r 116 now Patents Rules 2007, SI 2007/3291, r 118.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(ii) The Registrar of Trade Marks/18. Exclusion of liability in respect of official acts.

### **18. Exclusion of liability in respect of official acts.**

The registrar<sup>1</sup> is not to be taken to warrant the validity of the registration<sup>2</sup> of a trade mark<sup>3</sup> under the Trade Marks Act 1994 or under any treaty, convention, arrangement or engagement to which the United Kingdom<sup>4</sup> is a party<sup>5</sup>.

The registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by the Act<sup>6</sup>, or by the Trade Marks (International Registration) Order 1996<sup>7</sup>, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination<sup>8</sup>.

No proceedings lie against an officer of the registrar in respect of any matter for which the registrar is not liable by virtue of the above provisions<sup>9</sup>.

1 As to the registrar see PARA 17 ante.

2 For the meaning of 'registration' see PARA 19 note 2 post.

3 For the meaning of 'trade mark' see PARA 57 post.

4 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

5 Trade Marks Act 1994 s 70(1).

6 See *ibid* s 37; and PARA 372 post.

7 *ie* the Trade Marks (International Registration) Order 1996, SI 1996/714 (as amended).

8 Trade Marks Act 1994 s 70(2); Trade Marks (International Registration) Order 1996, SI 1996/714, art 26(1).

9 Trade Marks Act 1994 s 70(3); Trade Marks (International Registration) Order 1996, SI 1996/714, art 26(2).

### **UPDATE**

### **18 Exclusion of liability in respect of official acts**

NOTES 7-9--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/19. Maintenance of register.

### **(iii) The Register of Trade Marks**

#### **19. Maintenance of register.**

The registrar<sup>1</sup> must maintain a register of trade marks<sup>2</sup>; and there must be entered in the register in accordance with the Trade Marks Act 1994<sup>3</sup>:

- 17 (1) registered trade marks<sup>4</sup>;
- 18 (2) such particulars as may be prescribed of registrable transactions<sup>5</sup> affecting a registered trade mark<sup>6</sup>; and
- 19 (3) such other matters relating to registered trade marks as may be prescribed<sup>7</sup>.

The register must be kept in such manner as may be prescribed<sup>8</sup> but need not be kept in documentary form<sup>9</sup>.

The registrar must also maintain a supplementary register which records in relation to international trade marks (UK) disclaimers and limitations<sup>10</sup>, and notifiable transactions<sup>11</sup>.

Existing registered marks<sup>12</sup> had to be transferred on 31 October 1994 to the register so kept and have effect<sup>13</sup> as if registered under the Act<sup>14</sup>; and existing registered marks registered as a series<sup>15</sup> had to be similarly registered in the new register<sup>16</sup>. In any other case notes indicating that existing registered marks were associated with other marks ceased to have effect on that date<sup>17</sup>.

1 As to the registrar see PARA 17 ante.

2 Trade Marks Act 1994 s 63(1). References in the Trade Marks Act 1994 to 'the register' are to the register so maintained by the registrar; and references to 'registration' (in particular, in the expression 'registered trade mark') are, unless the context otherwise requires, to registration in that register: s 63(1). As to the meaning of 'registered trade mark' see PARA 127 post. As to falsification of the register see PARA 147 post.

For the purposes of s 105, Sch 3 (transitional provisions) the Sheffield register kept under the Trade Marks Act 1938 Sch 2 (repealed) (see PARA 351 post) is to be treated as part of the register of trade marks kept under that Act: Trade Marks Act 1994 Sch 3 para 20(1). Applications made to the Cutlers' Company in accordance with the Trade Marks Act 1938 Sch 2 (repealed) which were pending on 31 October 1994 (ie the date on which the Trade Marks Act 1994 came into force: see the Trade Marks Act 1994 (Commencement) Order 1994, SI 1994/2550, art 2) must proceed after that date as if they had been made to the registrar: Trade Marks Act 1994 Sch 3 para 20(2).

There is no longer any requirement to maintain a copy in Manchester of copies of all entries in the register relating to textile goods as was formerly required under the Trade Marks Act 1938 s 39 (repealed): see PARA 350 post.

3 Trade Marks Act 1994 s 63(2).

4 Ibid s 63(2)(a). In practice the register includes details of pending applications for registration as well of registered trade marks.

5 As to the registrable transactions see PARA 130 et seq post.

6 Trade Marks Act 1994 s 63(2)(b). As to the particulars so prescribed see PARA 22 post.

7 Ibid s 63(2)(c).

8 Ibid s 63(3). Provision must in particular be made for public inspection of the register, and the supply of certified or uncertified copies, or extracts, of entries in the register: see s 63(3); and PARA 24 post.

9 Trade Marks Rules 2000, SI 2000/136, r 38. In practice the register is now kept in the form of an electronic database which is publicly searchable via the Patent Office website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). The Patent Office is now operating under the name 'the UK Intellectual Property Office': see the UK Intellectual Property Office Name Change Fact Sheet.

10 Ie made under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(4) (as amended): see PARA 83 post.

11 Ibid art 24(1) (amended by SI 2002/692). That register need not be kept in documentary form: Trade Marks (International Registration) Order 1996, SI 1996/714, art 24(2). The provisions of the Trade Marks Rules 2000, SI 2000/136, rr 40-45 (see PARAS 24, 27-28, 131-132 post) apply, with the necessary modifications, to this supplementary register: Trade Marks (International Registration) Order 1996, SI 1996/714, art 24(3) (substituted by SI 2000/138).

12 Ie whether registered in Part A or Part B of the register kept under the Trade Marks Act 1938. For the meaning of 'existing registered mark' see PARA 4 note 2 ante.

13 Ie subject to the provisions of the Trade Marks Act 1994 Sch 3 (transitional provisions).

14 Ibid Sch 3 para 2(1). A condition entered on the former register in relation to an existing registered mark immediately before 31 October 1994 ceased to have effect on that date: Sch 3 para 3(1).

Proceedings under the Trade Marks Act 1938 s 33 (repealed) (application to expunge or vary registration for breach of condition) which were pending on 31 October 1994 must be dealt with under the old law and any necessary alteration made to the new register: Trade Marks Act 1994 Sch 3 para 3(1). For the meaning of 'the old law' see PARA 4 note 3 ante.

A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before 31 October 1994 had to be transferred to the new register and has effect as if entered on the register in pursuance of s 13 (see PARA 83 post): Sch 3 para 3(2).

15 Ie under the Trade Marks Act 1938 s 21(2) (repealed).

16 Trade Marks Act 1994 Sch 3 para 2(2). Provision may be made by rules for putting such entries in the same form as is required for entries under the Trade Marks Act 1994: Sch 3 para 2(2). At the date at which this title states the law no such rules had been made.

17 Ibid Sch 3 para 2(3).

## **UPDATE**

### **19 Maintenance of register**

NOTE 9--SI 2000/136 r 38 now Trade Marks Rules 2008, SI 2008/1797, r 46.

NOTES 10, 11--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206 (amended by SI 2009/2464).

NOTE 11--SI 2000/136 rr 40-45 now SI 2008/1797 rr 48-53.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/20. Registration of trade mark.

## **20. Registration of trade mark.**

A trade mark is registered once the application for registration<sup>1</sup> has been accepted<sup>2</sup>, either no notice of opposition<sup>3</sup> has been given within the prescribed time or all opposition proceedings have been withdrawn or decided in favour of the applicant, and any prescribed fee has been paid within the prescribed period<sup>4</sup>.

1 As to the application procedure see PARAS 352 et seq post.

2 As to acceptance see PARA 381 post.

3 As to opposition proceedings see PARA 384 post.

4 See the Trade Marks Act 1994 s 40(1), (2) (s 40(1) as amended); and PARA 388 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/21. Date of registration; retrospective effect.

## **21. Date of registration; retrospective effect.**

A trade mark<sup>1</sup>, when registered<sup>2</sup>, is registered as of the date of filing of the application for registration<sup>3</sup>; and that date is deemed<sup>4</sup> to be the date of registration<sup>5</sup>.

A protected international trade mark (UK)<sup>6</sup> is treated as being registered under the Trade Marks Act 1994 as of the date of the international registration<sup>7</sup>, or, if later, as of the date when a request for extension of protection to the United Kingdom is recorded in the international register<sup>8</sup>. When the holder of a protected international trade mark (UK) is also the proprietor of a United Kingdom registered trade mark which covers the same goods and services and which has an earlier date, the international mark is treated as backdated to the registration date of the United Kingdom mark<sup>9</sup>.

1 For the meaning of 'trade mark' see PARA 57 post.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13 ante, 55 note 8 post.

3 For the meaning of 'the date of filing of an application for registration' see PARA 366 post. As to the requirements for registration see PARA 55 et seq post; and as to the procedure on the application see PARA 352 et seq post.

4 Ie for the purposes of the Trade Marks Act 1994.

5 Ibid s 40(3). The effect of registration is thus, for most purposes, retrospective to the date of application. As to actions for infringement and criminal proceedings, in respect of acts committed during the period after application is made for registration of a trade mark but before the date of actual registration, see PARA 85 post.

6 For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

7 For the meaning of 'international registration' see PARA 12 note 2 ante.

8 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(2). For the meaning of 'international register' see PARA 12 note 2 ante. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

9 See ibid art 21.

## **UPDATE**

## **21 Date of registration; retrospective effect**

NOTE 8--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/22. Particulars of registered trade marks.

## 22. Particulars of registered trade marks.

In addition to the entries in the register<sup>1</sup> of registered trade marks<sup>2</sup>, there must be entered in the register in respect of each trade mark registered therein the following particulars<sup>3</sup>:

- 20 (1) the date of registration<sup>4</sup>, that is to say, the date of the filing of the application for registration<sup>5</sup>;
- 21 (2) the actual date of registration, that is to say, the date of the entry in the register<sup>6</sup>;
- 22 (3) the priority date, if any, to be accorded pursuant to a claim to a right to priority<sup>7</sup>;
- 23 (4) the name and address of the proprietor<sup>8</sup>;
- 24 (5) the address for service, if any, as duly furnished<sup>9</sup>;
- 25 (6) any disclaimer or limitation of rights<sup>10</sup>;
- 26 (7) any memorandum or statement of the effect of any memorandum relating to a trade mark of which the registrar has been notified on the appropriate form<sup>11</sup>;
- 27 (8) the goods or services in respect of which the mark is registered<sup>12</sup>;
- 28 (9) where the mark is a collective<sup>13</sup> or certification<sup>14</sup> mark, that fact<sup>15</sup>;
- 29 (10) where the mark is registered<sup>16</sup> with the consent of the proprietor of an earlier trade mark or other earlier right, that fact<sup>17</sup>;
- 30 (11) where the mark is registered pursuant to a transformation application<sup>18</sup>, the number of the international registration<sup>19</sup>, and either the priority date accorded to the international registration, or that date on which the request to extend the international registration to the United Kingdom was recorded<sup>20</sup>; and
- 31 (12) where the mark arises from the conversion of a Community trade mark or an application for a Community trade mark<sup>21</sup>, the number of any other registered trade mark from which the Community trade mark or the application for a Community trade mark claimed seniority and the earliest seniority date<sup>22</sup>.

1 As to the register see PARA 19 ante.

2 I.e. in addition to the entries in the register of registered trade marks required by the Trade Marks Act 1994 s 63(2)(a): see PARA 19 head (1) ante. For the meaning of 'registered trade mark' see PARA 127 post.

3 Trade Marks Rules 2000, SI 2000/136, r 39. As to falsely representing a trade mark as registered see PARA 148 post.

4 I.e. as determined in accordance with the Trade Marks Act 1994 s 40(3): see PARA 21 ante.

5 Trade Marks Rules 2000, SI 2000/136, r 39(a). As to the requirements for registration see PARA 55 et seq post; and as to the procedure on the application see PARA 352 et seq post.

6 Ibid r 39(b). As to the date of registration see PARA 21 ante.

7 Ibid r 39(c), which refers to claims made under the Trade Marks Act 1994 s 35 (see PARA 378 post) or s 36 (see PARA 379 post).

8 Trade Marks Rules 2000, SI 2000/136, r 39(d). For these purposes, 'proprietor' means the person registered as the proprietor of the trade mark: r 2(1).

9 Ibid r 39(e). As to the address for service see r 10 (as amended); and PARA 357 post.

10 Ibid r 39(f), which refers to disclaimers and limitations under the Trade Marks Act 1994 s 13(1)(a) or s 13(1)(b): see PARA 83 heads (1)-(2) post.

11 Trade Marks Rules 2000, SI 2000/136, r 39(g). The appropriate form is Form TM24: r 39(g). As to the use of forms see PARA 353 post. As to the registrar see PARA 17 ante.

12 Ibid r 39(h).

13 As to collective marks see PARA 155 et seq post.

14 As to certification marks see PARA 165 et seq post.

15 Trade Marks Rules 2000, SI 2000/136, r 39(i).

16 Ie pursuant to the Trade Marks Act 1994 s 5(5): see PARA 78 post.

17 Trade Marks Rules 2000, SI 2000/136, r 39(j).

18 As to transformation applications see PARA 13 ante.

19 As to international registrations see PARA 11 ante.

20 See the Trade Marks Rules 2000, SI 2000/136, r 39(k).

21 As to Community trade marks see PARA 176 et seq post; and as to conversion of Community trade marks or Community trade mark applications see PARAS 197-203 post.

22 Trade Marks Rules 2000, SI 2000/136, r 39(l).

## **UPDATE**

## **22 Particulars of registered trade marks**

TEXT AND NOTES--SI 2000/136 r 39 now Trade Marks Rules 2008, SI 2008/1797, r 47.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/23. Trusts and equities.

### **23. Trusts and equities.**

No notice of any trust (express, implied or constructive) may be entered in the register<sup>1</sup>; and the registrar<sup>2</sup> is not affected by any such notice<sup>3</sup>.

Equities in respect of a registered trade mark may be enforced in like manner as in respect of other personal or movable property<sup>4</sup>.

1 As to the register see PARA 19 ante.

2 As to the registrar see PARA 17 ante.

3 Trade Marks Act 1994 s 26(1). This does not prevent notice of agreements which affect the proprietorship of the registered trade mark, whether by creating trusts or otherwise, from being entered upon the register: *Re Casey's Patents* [1892] 1 Ch 104, (1891) 9 RPC 9, CA; *Kakkar v Szelke* [1989] FSR 225, (1988) Times, 18 October, CA. The provisions of the Trade Marks Act 1994 s 26 apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark: s 27(1). As to the meaning of 'registered trade mark' see PARA 127 post. As to the requirements for registration see PARA 55 et seq post; and as to the procedure on the application see PARA 352 et seq post.

4 Ibid s 26(2). See also note 3 supra.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/24. Inspection of the register; provision of copies and extracts.

## **24. Inspection of the register; provision of copies and extracts.**

The register<sup>1</sup> must be open for inspection at the Patent Office<sup>2</sup> during its hours of business as duly<sup>3</sup> published<sup>4</sup>; and, where any portion of the register is kept otherwise than in documentary form, the right of inspection is a right to inspect the material on the register<sup>5</sup>.

The registrar must supply a certified copy or extract or uncertified copy or extract, as requested on the appropriate form<sup>6</sup>, of any entry in the register<sup>7</sup>.

1 As to the register see PARA 19 ante.

2 As to the Patent Office, its organisation and seal see PARA 14 note 2 post; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

3 In accordance with the Trade Marks Rules 2000, SI 2000/136, r 70: see PARA 352 post.

4 Trade Marks Act 1994 s 63(3)(a); Trade Marks Rules 2000, SI 2000/136, r 42(1). See PARA 19 note 8 ante. For the meaning of 'publish' see PARA 17 note 10 ante. In practice the register is now kept in the form of an electronic database which is publicly searchable via the Patent Office website, accessible at the date on which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). The Patent Office is now operating under the name 'the UK Intellectual Property Office': see the UK Intellectual Property Office Name Change Fact Sheet.

5 Trade Marks Act 1994 s 63(3)(a); Trade Marks Rules 2000, SI 2000/136, r 42(2). See PARA 19 note 8 ante.

6 The appropriate form is Form TM31R: *ibid* r 43.

7 Trade Marks Act 1994 s 63(3)(b); Trade Marks Rules 2000, SI 2000/136, r 43. See PARA 19 note 8 ante. As to the use of forms see PARA 353 post.

## **UPDATE**

### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

## **24 Inspection of the register; provision of copies and extracts**

NOTE 3--See now Trade Marks Rules 2008, SI 2008/1797, r 80.

NOTES 4, 5--See now SI 2008/1797 r 50.

NOTES 6, 7--See now SI 2008/1797 r 51.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/25. Inspection of documents.

## 25. Inspection of documents.

The registrar<sup>1</sup> must permit all documents filed<sup>2</sup> or kept at the Patent Office in relation to a registered mark or, where an application for the registration of a trade mark has been published<sup>3</sup>, in relation to that application, to be inspected<sup>4</sup>. Corresponding provisions apply to an international trade mark<sup>5</sup> once the registrar has published notice that it appears to satisfy the requirements for protection<sup>6</sup>, but until that stage is reached the right to inspect is limited to the information recorded in the international register<sup>7</sup>, the particulars contained in any application for registration of a notifiable transaction and any entry in the supplementary register resulting from such an application<sup>8</sup>. The registrar is not, however, obliged to permit the inspection of any such document until he has completed any procedure, or the stage in the procedure which is relevant to the document in question, which he is required or permitted<sup>9</sup> to carry out<sup>10</sup>.

Such right of inspection does not apply<sup>11</sup> to:

- 32 (1) any document until 14 days after it has been filed at the Patent Office<sup>12</sup>;
- 33 (2) any document prepared in the Patent Office solely for use therein<sup>13</sup>;
- 34 (3) any document sent to the Patent Office, whether at its request or otherwise, for inspection and subsequent return to the sender<sup>14</sup>;
- 35 (4) any request for information<sup>15</sup>;
- 36 (5) any document issued by the Patent Office which the registrar considers should be treated as confidential<sup>16</sup>;
- 37 (6) any document in respect of which the registrar issues directions<sup>17</sup> that it be treated as confidential<sup>18</sup>.

Nothing in the above provisions is to be construed as imposing on the registrar any duty of making available for public inspection<sup>19</sup>:

- 38 (a) any document or part of a document which in his opinion disparages any person in a way likely to damage him<sup>20</sup>;
- 39 (b) any document or information filed at or sent to or by the Patent Office before 31 October 1994<sup>21</sup>; or
- 40 (c) any document or information filed at or sent to or by the Patent Office after 31 October 1994 relating to an application for registration of a trade mark under the Trade Marks Act 1938<sup>22</sup>.

No appeal lies from a decision of the registrar<sup>23</sup> not to make any document or part of a document available for public inspection<sup>24</sup>.

1 As to the registrar see PARA 17 ante.

2 For these purposes, references to the filing of any application, notice or other document are to be construed as references to its being delivered to the registrar at the Patent Office: Trade Marks Rules 2000, SI 2000/136, r 2(3). As to the filing of documents by electronic means see PARA 354 post. As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS VOL 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'); see the UK Intellectual Property Office Name Change Fact Sheet.

3 For the meaning of 'publish' see PARA 17 note 10 ante. As to publication of the application see PARA 383 post.

4 Trade Marks Rules 2000, SI 2000/136, r 50(1), which is expressed to be subject to r 50(2), (3) (see the text and notes 9-18 infra).

5 Ibid rr 50(2)-(5), 51 (see the text and notes 9-24 infra; and PARA 26 post) apply to the right of inspection conferred by the Trade Marks (International Registration) Order 1996, SI 1996/714, art 25(3) in relation to an international registration designating the United Kingdom: see art 25(5) (substituted by SI 2000/138). For the meaning of 'international registration' see PARA 12 note 2 ante.

6 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 25(3). Such notice is published under art 10(1) (as substituted): see PARA 13 ante. A request for information relating to an international registration designating the United Kingdom must be made on Form TM31M: art 25(4).

7 For the meaning of 'international register' see PARA 12 note 2 ante.

8 Trade Marks (International Registration) Order 1996, SI 1996/714, art 25(1), (2). An exception exists when a person has been notified that the proprietor of the international trade mark will bring proceedings against him; he may then inspect documents relating to the international application even before the notice has been published: see art 25(6).

9 Ie under the Trade Marks Act 1994 or the Trade Marks Rules 2000, SI 2000/136 (as amended).

10 Ibid r 50(2). See also note 5 supra.

11 Ibid r 50(3). See also note 5 supra.

12 Ibid r 50(3)(a).

13 Ibid r 50(3)(b).

14 Ibid r 50(3)(c). For these purposes, unless the context otherwise requires, 'send' includes give: r 2(1).

15 Ibid r 50(3)(d), which refers to requests under r 48: see PARA 390 post.

16 Ibid r 50(3)(e).

17 Ie under ibid r 51: see PARA 26 post.

18 Ibid r 50(3)(f).

19 Ibid r 50(4). See also note 5 supra.

20 Ibid r 50(4)(a).

21 Ibid r 50(4)(b).

22 Ibid r 50(4)(c). The Trade Marks Act 1938 is now repealed.

23 Ie under the Trade Marks Rules 2000, SI 2000/136, r 50(4): see the text to notes 19-22 supra.

24 Ibid r 50(5). See also note 5 supra.

## **UPDATE**

### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

## **25 Inspection of documents**



TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 58.

NOTES 5-8--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/26. Confidential documents.

## **26. Confidential documents.**

Where a document other than a form required by the registrar<sup>1</sup> and duly published<sup>2</sup> is filed<sup>3</sup> at the Patent Office<sup>4</sup> and the person filing it requests, at the time of filing or within 14 days of the filing, that it or a specified part of it be treated as confidential, giving his reasons, the registrar may direct that it or part of it, as the case may be, be treated as confidential, and the document is not open to public inspection while the matter is being determined by the registrar<sup>5</sup>.

Where such direction has been given and not withdrawn, nothing in these provisions is to be taken to authorise or require any person to be allowed to inspect the document or part of it to which the direction relates except by leave of the registrar<sup>6</sup>. The registrar may not withdraw any direction so given without prior consultation with the person at whose request the direction was given, unless the registrar is satisfied that such prior consultation is not reasonably practical<sup>7</sup>.

Where the registrar considers that any document issued by the Patent Office should be treated as confidential, he may so direct; and upon such direction that document is not open to public inspection except by leave of the registrar<sup>8</sup>.

Where a direction is given under the above provisions for a document to be treated as confidential, a record of the fact must be filed with the document<sup>9</sup>.

1 As to the registrar see PARA 17 ante.

2 I.e. in accordance with the Trade Marks Rules 2000, SI 2000/136, r 3: see PARA 353 post. For the meaning of 'publish' see PARA 17 note 10 ante.

3 For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 post.

4 As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

5 Trade Marks Rules 2000, SI 2000/136, r 51(1). As to the principles applicable to a application to keep documents or parts thereof confidential see *Diamond Shamrock Technologies SA's Patent* [1987] RPC 91. As to the application of the Trade Marks Rules 2000, SI 2000/136, r 51 to international trade marks see PARA 25 note 5 ante.

6 Ibid r 51(2).

7 Ibid r 51(3).

8 Ibid r 51(4).

9 Ibid r 51(5).

## **UPDATE**

### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

## **26 Confidential documents**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 59.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/27. Request for change of name or address in the register.

## **27. Request for change of name or address in the register.**

The registrar<sup>1</sup> must, on a request made on the appropriate form<sup>2</sup> by the proprietor<sup>3</sup> of a registered trade mark<sup>4</sup> or a licensee<sup>5</sup> or any person having an interest in or charge on a registered trade mark which has been duly registered<sup>6</sup>, enter any change in his name or address as recorded in the register<sup>7</sup>.

1 As to the registrar see PARA 17 ante.

2 The appropriate form is Form TM21: see the Trade Marks Rules 2000, SI 2000/136, r 44(1). As to the use of forms see PARA 353 post.

3 For the meaning of 'proprietor' see PARA 22 note 8 ante.

4 As to the meaning of 'registered trade mark' see PARA 127 post.

5 As to the licensing of trade marks see PARAS 136-137 post.

6 I.e. registered under the Trade Marks Rules 2000, SI 2000/136, r 40: see PARA 131 post.

7 Trade Marks Act 1994 s 64(4); Trade Marks Rules 2000, SI 2000/136, r 44(1).

## **UPDATE**

### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

## **27 Request for change of name or address in the register**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 52.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/28. Registrar's power to remove matter from the register.

## **28. Registrar's power to remove matter from the register.**

Where it appears to the registrar<sup>1</sup> that any matter in the register has ceased to have effect, he may remove that matter from the register<sup>2</sup>; but, before doing so:

- 41 (1) he may, where he considers it appropriate, publish<sup>3</sup> his intention to remove that matter<sup>4</sup>; and
- 42 (2) where any person appears to him to be affected by the removal, he must send<sup>5</sup> notice of his intention to that person<sup>6</sup>.

Within three months of the date on which his intention to remove the matter is published, or notice of his intention is sent, as the case may be<sup>7</sup>:

- 43 (a) any person may file<sup>8</sup> notice of opposition to the removal on the appropriate form<sup>9</sup>; and
- 44 (b) the person to whom a notice is sent under head (2) above may file, in writing, his objections, if any, to the removal, or a request to have his objections heard orally<sup>10</sup>.

If, after considering any objections or opposition to the removal, the registrar is satisfied that the matter has not ceased to have effect, he must not remove it<sup>11</sup>.

Where there has been no response to the registrar's notice, he may remove the matter; and, where representations objecting to the removal of the entry have been made, whether in writing or orally, the registrar may, if he is of the view after considering the objections that the entry or any part thereof has ceased to have effect, remove it or, as appropriate, the part thereof<sup>12</sup>.

1 As to the registrar see PARA 17 ante.

2 Trade Marks Act 1994 s 64(5); Trade Marks Rules 2000, SI 2000/136, r 45(1). As to the register see PARA 19 ante.

3 For the meaning of 'publish' see PARA 17 note 10 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 45(1)(a).

5 For the meaning of 'send' see PARA 25 note 14 ante.

6 Trade Marks Rules 2000, SI 2000/136, r 45(1)(b).

7 Ibid r 45(2).

8 For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 post.

9 Trade Marks Rules 2000, SI 2000/136, r 45(2)(a). See also note 10 infra. The appropriate form is Form TM7: r 45(2)(a). As to the use of forms see PARA 353 post.

10 Ibid r 45(2)(b). Where opposition or objection is made under r 45(2)(a) or r 45(2)(b), r 54 (see PARA 358 post) applies: r 45(2).

11 Ibid r 45(3).

12 Ibid r 45(4).

## **UPDATE**

### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797  
(see PARA 352-375).

### **28 Registrar's power to remove matter from the register**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 53.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/29. Duration and renewal of registration.

## **29. Duration and renewal of registration.**

A trade mark<sup>1</sup> is registered<sup>2</sup> for a period of ten years from the date of registration<sup>3</sup>; but registration may be renewed<sup>4</sup> for further periods of ten years<sup>5</sup>.

The registration of a trade mark may be renewed by the proprietor<sup>6</sup> filing<sup>7</sup> a request for renewal on the appropriate form<sup>8</sup> at any time within the period of six months ending on the date of the expiration of the registration, subject to payment of a renewal fee<sup>9</sup>. At any time not earlier than six months nor later than one month before the expiration of the last registration of a trade mark, the registrar<sup>10</sup> must, except where renewal has already been duly effected<sup>11</sup>, send<sup>12</sup> to the registered proprietor notice of the approaching expiration and inform him at the same time that the registration may be renewed<sup>13</sup>. If it appears to the registrar that a trade mark may be registered<sup>14</sup> at any time within six months before or at any time after the date on which renewal would be due, by reference to the date of application for registration, the registrar is to be taken to have complied with this obligation if he sends to the applicant notice thereof within one month following the date of actual registration<sup>15</sup>.

A request for renewal must be made, and the renewal fee paid, before the expiry of the registration<sup>16</sup>. If, on the expiration of the last registration of a trade mark, the renewal fee has not been paid, the registrar must publish<sup>17</sup> that fact, and, if within six months from the date of the expiration of the last registration the request for renewal is filed on the appropriate form<sup>18</sup> accompanied by the appropriate renewal fee and additional renewal fee, the registrar must renew the registration without removing the mark from the register<sup>19</sup>.

Renewal takes effect from the expiry of the previous registration<sup>20</sup>.

Where no request for renewal is filed, the registrar must remove the trade mark from the register<sup>21</sup>, subject to his power<sup>22</sup> to restore the registration<sup>23</sup>.

Where a mark is due to be registered after the date on which it is due for renewal, by reference to the date of application for registration, the request for renewal must be filed together with the renewal fee and additional renewal fee within six months after the date of actual registration<sup>24</sup>.

The renewal or removal of any registration must be published<sup>25</sup>.

1 For the meaning of 'trade mark' see PARA 57 post.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13 ante, 55 note 8 post.

3 Trade Marks Act 1994 s 42(1). For the meaning of 'date of registration' see PARA 21 ante. Section 42(1) applies in relation to the registration of a mark in pursuance of an application made on or after 31 October 1994 (ie the date on which the Trade Marks Act 1994 came into force: see the Trade Marks Act 1994 (Commencement) Order 1994, SI 1994/2550, art 2); and the old law continues to apply in any other case: Trade Marks Act 1994 s 105, Sch 3 para 15(1). It is immaterial when the fee is paid: Sch 3 para 15(3). For the meaning of 'the old law' see PARA 4 note 3 ante.

4 Ie in accordance with ibid s 43: see the text and notes 6-25 infra.

5 Ibid s 42(2). This applies where the renewal falls due on or after 31 October 1994; and the old law applies in any other case: Sch 3 para 15(2). It is immaterial when the fee is paid: Sch 3 para 15(3).

6 For the meaning of 'proprietor' see PARA 22 note 8 ante.

7 For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 post.

8 The appropriate form is Form TM11: Trade Marks Rules 2000, SI 2000/136, r 28. As to the use of forms see PARA 353 post.

9 Trade Marks Act 1994 s 43(1); Trade Marks Rules 2000, SI 2000/136, r 28. As to fees see PARA 16 ante; and as to acts done by authorised agents see PARA 31 post. The Trade Marks Act 1994 s 43 applies where the renewal falls due on or after 31 October 1994; and the old law applies in any other case: Sch 3 para 15(2). It is immaterial when the fee is paid: Sch 3 para 15(3).

10 As to the registrar see PARA 17 ante.

11 Ie under the Trade Marks Rules 2000, SI 2000/136, r 28: see the text to notes 6-9 supra.

12 For the meaning of 'send' see PARA 25 note 14 ante.

13 Trade Marks Act 1994 s 43(2); Trade Marks Rules 2000, SI 2000/136, r 27(1). See also note 9 supra.

14 Ie under the Trade Marks Act 1994 s 40 (see PARA 388 post): Trade Marks Rules 2000, SI 2000/136, r 27(2).

15 Ibid r 27(2).

16 Trade Marks Act 1994 s 43(3). See also note 9 supra.

17 For the meaning of 'publish' see PARA 17 note 10 ante.

18 The appropriate form is Form TM11: Trade Marks Rules 2000, SI 2000/136, r 29(1).

19 Trade Marks Act 1994 s 43(3); Trade Marks Rules 2000, SI 2000/136, r 29(1). The periods specified in r 29 may not be extended: see r 68(1), (3) (as amended); and PARA 356 post. See also note 9 supra.

20 Trade Marks Act 1994 s 43(4). See also note 9 supra.

21 As to the register see PARA 19 ante.

22 Ie under the Trade Marks Rules 2000, SI 2000/136, r 30: see PARA 30 post.

23 Trade Marks Act 1994 s 43(5); Trade Marks Rules 2000, SI 2000/136, r 29(2). See also notes 9, 19 supra. As to appeals from decisions of the registrar, including acts of the registrar in exercise of a discretion, see the Trade Marks Act 1994 ss 76, 77 (both as amended); and PARA 405 et seq post.

24 Trade Marks Rules 2000, SI 2000/136, r 29(3). See also note 19 supra.

25 Trade Marks Act 1994 s 43(6); Trade Marks Rules 2000, SI 2000/136, r 29(4). See also notes 9, 19 supra.

## **UPDATE**

### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

## **29 Duration and renewal of registration**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 34-37.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iii) The Register of Trade Marks/30. Restoration to the register.

### **30. Restoration to the register.**

Where the registrar<sup>1</sup> has removed the mark from the register for failure to renew its registration<sup>2</sup>, he may, upon a request filed on the appropriate form<sup>3</sup> within six months of the date of the removal of the mark accompanied by the appropriate renewal fee and appropriate restoration fee, restore the mark to the register<sup>4</sup> and renew its registration if, having regard to the circumstances of the failure to renew, he is satisfied that it is just to do so<sup>5</sup>. The restoration of the registration must be published, with the date of restoration shown<sup>6</sup>.

1 As to the registrar see PARA 17 ante.

2 Ie in accordance with the Trade Marks Rules 2000, SI 2000/136, r 29: see PARA 29 ante.

3 The appropriate form is Form TM13: *ibid* r 30(1). As to the use of forms see PARA 353 post.

4 As to the register see PARA 19 ante.

5 Trade Marks Act 1994 s 43(5); Trade Marks Rules 2000, SI 2000/136, r 30(1). The periods specified in r 30 may not be extended: see r 68(1), (3) (as amended); and PARA 356 post. As to fees see PARA 16 ante. The Trade Marks Act 1994 s 43 applies where the renewal falls due on or after 31 October 1994; and the old law applies in any other case: Sch 3 para 15(2). For the meaning of 'the old law' see PARA 4 note 3 ante. In the absence of a challenge to the registrar's decision to restore a registration by way of judicial review, misconduct by the applicant for restoration (such as failure fully to disclose to the registrar all the relevant circumstances) cannot itself constitute grounds for a challenge to the restoration by way of rectification of the register, although it may be relevant to the exercise of any discretion by a tribunal hearing an application for rectification of the register on other grounds: *Second Sight Ltd v Novell UK Ltd and Novell Inc* [1995] RPC 423.

6 Trade Marks Act 1994 s 43(6); Trade Marks Rules 2000, SI 2000/136, r 30(2). See also note 5 *supra*.

## **UPDATE**

### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **30 Restoration to the register**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 36, 37.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/31. Recognition of agents.

## **(iv) Trade Mark Agents**

### **A. IN GENERAL**

#### **31. Recognition of agents.**

Any act required or authorised by the Trade Marks Act 1994 to be done by or to a person in connection with the registration<sup>1</sup> of a trade mark<sup>2</sup>, or any procedure relating to a registered trade mark<sup>3</sup>, may be done<sup>4</sup> by or to an agent authorised by that person orally or in writing<sup>5</sup>. Where an agent has been so authorised, the registrar<sup>6</sup> may in any particular case require the personal signature or presence of the agent or the person authorising him to act as agent<sup>7</sup>.

Where, after a person has become a party to proceedings before the registrar, he appoints an agent for the first time or appoints one agent in substitution for another, the newly appointed agent must file the appropriate form<sup>8</sup>; and any act required or authorised by the Trade Marks Act 1994 in connection with the registration of a trade mark or any procedure relating to a trade mark may not be done by or to the newly appointed agent until on or after the date on which he files that form<sup>9</sup>.

The registrar may by notice in writing sent to an agent require him to produce evidence of his authority<sup>10</sup>.

1 For the meaning of 'registration' see PARA 19 note 2 ante.

2 For the meaning of 'trade mark' see PARA 57 post.

3 As to the meaning of 'registered trade mark' see PARA 127 post.

4 I.e. except as otherwise provided by rules. As to the making of rules generally see PARA 15 ante.

5 Trade Marks Act 1994 s 82. As to agency generally see AGENCY.

6 As to the registrar see PARA 17 ante.

7 Trade Marks Rules 2000, SI 2000/136, r 52(1).

8 The appropriate form is Form TM33: *ibid* r 52(2). As to the use of forms see PARA 353 post.

9 *Ibid* r 52(2).

10 *Ibid* r 52(3).

### **UPDATE**

#### **24-31 Inspection of the register; provision of copies and extracts ... Recognition of agents**

Trade Marks Rules 2000, SI 2000/136, replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

#### **31 Recognition of agents**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 60.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/32. Restrictions on practice.

### **32. Restrictions on practice.**

An individual who is not a registered trade mark agent<sup>1</sup> may not<sup>2</sup>:

- 45 (1) carry on a business<sup>3</sup>, otherwise than in partnership, under any name or other description which contains the words 'registered trade mark agent'<sup>4</sup>; or
- 46 (2) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent<sup>5</sup>.

A partnership may not:

- 47 (a) carry on a business under any name or other description which contains the words 'registered trade mark agent'<sup>6</sup>; or
- 48 (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a firm of registered trade mark agents<sup>7</sup>,

unless all the partners are registered trade mark agents or the partnership satisfies such conditions as may be prescribed for these purposes<sup>8</sup>.

A body corporate may not:

- 49 (i) carry on a business, otherwise than in partnership, under any name or other description which contains the words 'registered trade mark agent'<sup>9</sup>; or
- 50 (ii) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trade mark agent<sup>10</sup>,

unless all the directors<sup>11</sup> of the body corporate are registered trade mark agents or the body satisfies such conditions as may be prescribed for these purposes<sup>12</sup>.

A person who contravenes the above provisions commits an offence and is liable on conviction to a penalty<sup>13</sup>; and proceedings for such an offence may be begun at any time within a year from the date of the offence<sup>14</sup>.

1 For these purposes, 'registered trade mark agent' means a person whose name is entered in the register kept under the Trade Marks Act 1994 s 83 (see PARA 39 post): s 83(1).

2 Ibid s 84(1).

3 For these purposes 'business' includes a trade or profession: ibid s 103(1).

4 Ibid s 84(1)(a).

5 Ibid s 84(1)(b).

6 Ibid s 84(2)(a).

7 Ibid s 84(2)(b).

8 Ibid s 84(2). As to the power to prescribe conditions etc for mixed partnerships and bodies corporate, and as to the conditions so prescribed, see PARA 33 post.

9 Ibid s 84(3)(a).

10 Ibid s 84(3)(b).

11 For these purposes, 'director', in relation to a body corporate whose affairs are managed by its members, means any member of the body: *ibid* s 103(1).

12 Ibid s 84(3). See also note 8 *supra*.

13 Ibid s 84(4). The penalty on summary conviction is a fine not exceeding level 5 on the standard scale: s 84(4). 'Standard scale' means the standard scale of maximum fines for summary offences as set out in the Criminal Justice Act 1982 s 37 (as amended): see the Interpretation Act 1978 s 5, Sch 1 (definition added by the Criminal Justice Act 1988 s 170(1), Sch 15 para 58); and SENTENCING AND DISPOSITION OF OFFENDERS vol 92 (2010) PARA 142. At the date at which this volume states the law, the standard scale is as follows: level 1, £200; level 2, £500; level 3, £1,000; level 4, £2,500; level 5, £5,000: Criminal Justice Act 1982 s 37(2) (substituted by the Criminal Justice Act 1991 s 17(1)). As to the determination of the amount of the fine actually imposed, as distinct from the level on the standard scale which it may not exceed, see the Criminal Justice Act 2003 s 164 (as amended); and SENTENCING AND DISPOSITION OF OFFENDERS vol 92 (2010) PARA 144.

As to offences by partnerships and bodies corporate see PARA 139 *post*.

14 Trade Marks Act 1994 s 84(4).

## UPDATE

### 32 Restrictions on practice

TEXT AND NOTE 1--Reference to a registered trade mark agent is now to a registered trade mark attorney: Trade Marks Act 1994 s 84(1) (amended by Legal Services Act 2007 Sch 21 para 111(a)(i)).

TEXT AND NOTES 3-8--In heads (1), (2), (a) and (b) references to a registered trade mark agent are to a registered trade mark agent or registered trade mark attorney, reference to a partnership is to a partnership or other unincorporated body, and for 'all the partners ... purposes' read 'the body corporate is registered in the register kept under the Trade Marks Act 1994 s 83': s 84(1)(a), (b), (2), (3) (amended by Legal Services Act 2007 s 184(4), Sch 21 para 111(a)(ii), (b), (c)).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/33. Power to prescribe conditions etc for mixed partnerships and bodies corporate.

### **33. Power to prescribe conditions etc for mixed partnerships and bodies corporate.**

The Secretary of State<sup>1</sup> may make rules prescribing the conditions to be satisfied for the purposes of the statutory provisions relating to persons entitled to be described as registered trade mark agents<sup>2</sup>:

- 51 (1) in relation to a partnership where not all the partners are qualified persons<sup>3</sup>;  
or
- 52 (2) in relation to a body corporate where not all the directors<sup>4</sup> are qualified persons<sup>5</sup>,

and imposing requirements to be complied with by such partnerships or bodies corporate<sup>6</sup>.

The rules may in particular:

- 53 (a) prescribe conditions as to the number or proportion of partners or directors who must be qualified persons<sup>7</sup>;
- 54 (b) impose requirements as to the identification of qualified and unqualified persons in professional advertisements, circulars or letters issued by or with the consent of the partnership or body corporate and which relate to its business<sup>8</sup> and the manner in which a partnership or body corporate is to organise its affairs so as to secure that qualified persons exercise a sufficient degree of control over the activities of unqualified persons<sup>9</sup>.

A person who contravenes a requirement imposed by the rules commits an offence and is liable to a penalty<sup>10</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 I.e. the Trade Marks Act 1994 s 84 (see PARA 32 ante): s 85(1). For the meaning of 'registered trade mark agent' see PARA 32 note 1 ante.

3 Ibid s 85(1)(a). For these purposes, 'qualified person' means a registered trade mark agent: s 85(4).

4 For the meaning of 'director' see PARA 32 note 11 ante.

5 Trade Marks Act 1994 s 85(1)(b).

6 Ibid s 85(1). At the date at which this title states the law no such rules had been made but, by virtue of s 105, Sch 3 para 22(1), the Registered Trade Mark Agents (Mixed Partnerships and Bodies Corporate) Rules 1994, SI 1994/363, which came into force on 24 March 1994 (r 1) have effect as if so made. Rules so continued in force may be varied or revoked by further rules made under the relevant provisions of the Trade Marks Act 1994: Sch 3 para 22(3). As to the making of rules generally see PARA 15 ante.

For the purposes of s 84 (see PARA 32 ante), the conditions to be satisfied, in the case of a partnership where not all the partners are registered trade mark agents or in the case of a body corporate where not all the directors are registered trade mark agents, are: (1) that each partner or, as the case may be, director must be a person whose name is entered in at least one of the registers kept pursuant to rules made under the Copyright, Designs and Patents Act 1988 s 275 (see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 620) and the Trade Marks Act 1994 s 83 (see PARA 39 post); and (2) that at least one-quarter of the partners or, as the case may be, the directors, must be registered trade mark agents: Registered Trade Mark Agents (Mixed Partnerships and

Bodies Corporate) Rules 1994, SI 1994/363, r 3; and see the Trade Marks Act 1994 Sch 3 para 22(1). 'Registered trade mark agent' means a person whose name is entered in the register kept pursuant to rules made under s 83: Registered Trade Mark Agents (Mixed Partnerships and Bodies Corporate) Rules 1994, SI 1994/363, r 2; and see the Trade Marks Act 1994 Sch 3 para 22(1).

7 Ibid s 85(2)(a).

8 For the meaning of 'business' see PARA 32 note 3 ante.

9 Trade Marks Act 1994 s 85(2)(b).

10 Ibid s 85(3). The penalty on summary conviction is a fine not exceeding level 5 on the standard scale: s 85(3). As to the standard scale see PARA 32 note 13 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/34. Privilege for communications with registered trade mark agents.

### **34. Privilege for communications with registered trade mark agents.**

As regards any matter relating to the protection of any design or trade mark<sup>1</sup>, or as to any matter involving passing off<sup>2</sup>, any communication:

- 55 (1) between a person and his trade mark agent<sup>3</sup>; or
- 56 (2) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his trade mark agent<sup>4</sup>,

is privileged from disclosure in legal proceedings in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a solicitor<sup>5</sup>.

1 For the meaning of 'trade mark' see PARA 57 post.

2 See the Trade Marks Act 1994 s 87(1). As to passing off see PARA 304 et seq post.

3 Ibid s 87(2)(a). For these purposes, 'trade mark agent' means: (1) a registered trade mark agent; or (2) a partnership entitled to describe itself as a firm of registered trade mark agents; or (3) a body corporate entitled to describe itself as a registered trade mark agent: s 87(3). As to the modification of this definition in relation to Community trade marks see PARA 196 post. For the meaning of 'registered trade mark agent' see PARA 32 note 1 ante. As to partnerships entitled to describe themselves as firms of registered trade mark agents, and as to bodies corporate entitled to describe themselves as registered trade mark agents, see PARA 32 ante.

4 Ibid s 87(2)(b).

5 Ibid s 87(2). As to legal professional privilege see LEGAL PROFESSIONS vol 66 (2009) PARAS 1032.

## **UPDATE**

### **34 Privilege for communications with registered trade mark agents**

TEXT AND NOTES--References to a trade mark agent are now to a trade mark attorney: Trade Marks Act 1994 s 87(1), (2) (s 87(1) amended, s 87(2) substituted, by Legal Services Act 2007 Sch 21 para 113(a)-(c)).

NOTE 3--Definition of 'trade mark attorney' substituted to include head (3) any other unincorporated body or a body corporate entitled to describe itself as a registered trade mark attorney: Trade Marks Act 1994 s 87(3) (amended by Legal Services Act 2007 Sch 21 para 113(d)).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/35. Power of the registrar to refuse to deal with certain agents.

### **35. Power of the registrar to refuse to deal with certain agents.**

The Secretary of State<sup>1</sup> may make rules authorising the registrar<sup>2</sup> to refuse to recognise as agent in respect of any business under the Trade Marks Act 1994<sup>3</sup>:

- 57 (1) a person who has been convicted of the offence of describing himself as a registered trade mark agent when not entitled to do so<sup>4</sup>;
- 58 (2) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents<sup>5</sup> on the ground of misconduct<sup>6</sup>;
- 59 (3) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of trade mark agents, render him liable to have his name erased from the register on the ground of misconduct<sup>7</sup>;
- 60 (4) a partnership or body corporate of which one of the partners or directors<sup>8</sup> is a person whom the registrar could refuse to recognise under head (1), head (2) or head (3) above<sup>9</sup>.

The rules may contain such incidental and supplementary provisions as appear to the Secretary of State to be appropriate and may in particular prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct<sup>10</sup>.

The registrar may accordingly refuse to recognise as agent in respect of any business under the Trade Marks Act 1994<sup>11</sup>:

- 61 (a) a person who has been convicted of the offence of describing himself as a registered trade mark agent when not entitled to do so<sup>12</sup>;
- 62 (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents on the ground of misconduct<sup>13</sup>;
- 63 (c) a person who is found by the Secretary of State to have been guilty of such conduct as would, in the case of an individual registered in the register of trade mark agents, render him liable to have his name erased from the register on the ground of misconduct<sup>14</sup>;
- 64 (d) a partnership or body corporate of which one of the partners or directors is a person whom the registrar could refuse to recognise under head (a), head (b) or head (c) above<sup>15</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 As to the registrar see PARA 17 ante.

3 Trade Marks Act 1994 s 88(1). As to the making of rules generally see PARA 15 ante.

4 Ibid s 88(1)(a). The offence referred to in the text is an offence under s 84: see PARA 32 ante. For the meaning of 'registered trade mark agent' see PARA 32 note 1 ante.

5 As to the register of trade mark agents see PARA 39 et seq post.

6 Trade Marks Act 1994 s 88(1)(b).

- 7 Ibid s 88(1)(c).
- 8 For the meaning of 'director' see PARA 32 note 11 ante.
- 9 Trade Marks Act 1994 s 88(1)(d).
- 10 Ibid s 88(2).
- 11 Trade Marks Rules 2000, SI 2000/136, r 53.
- 12 Ibid r 53(a).
- 13 Ibid r 53(b).
- 14 Ibid r 53(c).
- 15 Ibid r 53(d).

## **UPDATE**

### **35 Power of the registrar to refuse to deal with certain agents**

TEXT AND NOTES 11-15--SI 2000/136 r 53 now Trade Marks Rules 2008, SI 2008/1797, r 61.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/36. Preparation of documents by registered trade mark agents.

### **36. Preparation of documents by registered trade mark agents.**

A registered trade mark agent<sup>1</sup> has the right to draw or prepare any instrument relating to any design or trade mark<sup>2</sup>.

<sup>1</sup> For these purposes, 'registered trade mark agent' has the same meaning as in the Trade Marks Act 1994 (see PARA 32 note 1 ante): Solicitors Act 1974 s 22(3A) (added by the Courts and Legal Services Act 1990 s 68(1), (3); and amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 5(1), (3)(a)).

<sup>2</sup> Solicitors Act 1974 s 22(2)(aa) (added by the Courts and Legal Services Act 1990 s 68(1), (2); and amended by the Trade Marks Act 1994 Sch 4 para 5(1), (2)).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/37. Use of the term 'trade mark attorney'.

### **37. Use of the term 'trade mark attorney'.**

No offence is committed under the enactments restricting the use of certain expressions in reference to persons not qualified to act as solicitors<sup>1</sup> by the use of the term 'trade mark attorney' in reference to a registered trade mark agent<sup>2</sup>.

<sup>1</sup> See under the Solicitors Act 1974 s 21 (as amended) (see LEGAL PROFESSIONS vol 65 (2008) PARA 424), the Solicitors (Scotland) Act 1980 s 31 and the Solicitors (Northern Ireland) Order 1976, SI 1976/582, art 22.

<sup>2</sup> Trade Marks Act 1994 s 86(1), (2). For the meaning of 'registered trade mark agent' see PARA 32 note 1 ante.

### **UPDATE**

### **37 Use of the term 'trade mark attorney'**

TEXT AND NOTE 2--Reference to a registered trade mark agent is now to a registered trade mark attorney: Trade Marks Act 1994 s 86(1) (amended by Legal Services Act 2007 Sch 21 para 112).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/A. IN GENERAL/38. Provision of legal services by trade mark attorneys.

### **38. Provision of legal services by trade mark attorneys.**

Appropriately qualified members of the Institute of Trade Mark Attorneys<sup>1</sup> may conduct trade mark, passing off and design litigation and have rights of audience in certain courts<sup>2</sup>.

The Legal Services Ombudsman<sup>3</sup> has jurisdiction to investigate allegations concerning the handling of complaints by the Institute of Trade Mark Attorneys<sup>4</sup>.

1 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 post.

2 See the Courts and Legal Services Act 1990 ss 27, 28 (both as amended); the Institute of Trade Mark Attorneys Order 2005, SI 2005/240, art 2; and COURTS vol 10 (Reissue) PARA 331-332.

3 As to the Legal Services Ombudsman generally see LEGAL PROFESSIONS vol 65 (2008) PARA 424 et seq.

4 See the Courts and Legal Services Act 1990 s 22 (as amended); the Legal Services Ombudsman (Jurisdiction) Order 1990, SI 1990/2485, art 2, Schedule Pt I (as amended); and LEGAL PROFESSIONS vol 65 (2008) PARA 425.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/B. THE REGISTER OF TRADE MARK AGENTS/39. General requirement to keep register of trade mark agents.

## ***B. THE REGISTER OF TRADE MARK AGENTS***

### **39. General requirement to keep register of trade mark agents.**

The Secretary of State<sup>1</sup> may make rules requiring the keeping of a register of persons who act as agent for others for the purposes of applying for or obtaining the registration of trade marks<sup>2</sup>. The rules may contain such provision as the Secretary of State thinks fit regulating the registration of persons<sup>3</sup>, and may in particular:

- 65 (1) require the payment of such fees as may be prescribed<sup>4</sup>; and
- 66 (2) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person's registration<sup>5</sup>.

The rules may delegate the keeping of the register to another person<sup>6</sup>, and may confer on that person:

- 67 (a) power to make regulations with respect to the payment of fees, in the cases and subject to the limits prescribed by the rules and with respect to any other matter which could be regulated by the rules<sup>7</sup>; and
- 68 (b) such other functions, including disciplinary functions, as may be prescribed by the rules<sup>8</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 Trade Marks Act 1994 s 83(1). At the date at which this volume states the law, the Register of Trade Mark Agents Rules 1990, SI 1990/1458 (as amended) (see PARA 40 et seq post), which came into force on 1 October 1990 (r 1), have effect as if made under this provision, by virtue of the Trade Marks Act 1994 s 105, Sch 3 para 22(1). Rules so continued in force may be varied or revoked by further rules made under the relevant provisions of the Trade Marks Act 1994: Sch 3 para 22(3). As to the making of rules generally see PARA 15 ante.

For the meaning of 'registration' in relation to trade marks see PARA 19 note 2 ante. For the meaning of 'trade mark' see PARA 57 post.

3 Ibid s 83(2).

4 Ibid s 83(2)(a).

5 Ibid s 83(2)(b).

6 Ibid s 83(3).

7 Ibid s 83(3)(a).

8 Ibid s 83(3)(b).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/B. THE REGISTER OF TRADE MARK AGENTS/40. The register.

#### **40. The register.**

There must be kept by the Institute of Trade Mark Attorneys<sup>1</sup> the register of trade mark agents<sup>2</sup> in which must be entered the name of each person who is entitled to be registered<sup>3</sup>, together with his business address, the date of his registration, his qualifications, and such other particulars as the registrar<sup>4</sup> may, at the request of that person, think fit to include<sup>5</sup>. A registered trade mark agent<sup>6</sup> must give notice to the registrar of any change in the particulars relating to him entered in the register; and the registrar must, on payment of the prescribed fee<sup>7</sup>, if any, amend the register accordingly<sup>8</sup>.

Not later than 1 April in each year the Institute must cause to be printed, published and placed on sale a copy of the entries in the register, with the names arranged alphabetically, as at the end of the preceding calendar year<sup>9</sup>.

The registrar may, on being duly satisfied that any entry in the register has been made in error or that any entry is incorrect, erase or correct the same<sup>10</sup>. However, no such erasure or correction may be so made unless the registrar has first served notice of the proposed erasure or correction on the person appearing to him to be affected, has afforded that person the opportunity to make written representations regarding the same and has taken into account any such representations<sup>11</sup>.

Names may also be erased for failure to pay the annual practising fee<sup>12</sup> or after due inquiry into misconduct<sup>13</sup>.

The Comptroller General of Patents, Designs and Trade Marks<sup>14</sup> may from time to time give general directions to the Institute as to any matters relating to the register<sup>15</sup>.

1 The Institute was formerly known as the Institute of Trade Mark Agents (see the Register of Trade Mark Agents Rules 1990, SI 1990/1458 (as originally enacted)), but is now known as the Institute of Trade Mark Attorneys (see r 2 (amended by SI 1999/983)). As to the continued relevance of these rules see PARA 39 note 2 ante.

2 'The register' means the register of trade mark agents required to be kept under the Register of Trade Mark Agents Rules 1990, SI 1990/1458 (as amended): r 2.

3 Ie pursuant to *ibid* r 10: see PARA 46 post.

4 As to the registrar see PARA 42 post.

5 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 3.

6 For these purposes, 'registered trade mark agent' means a trade mark agent whose name is entered in the register: *ibid* r 2.

7 Ie the fee, if any, prescribed by regulations made under *ibid* r 20: see PARA 53 post.

8 *Ibid* r 11.

9 *Ibid* r 6.

10 *Ibid* r 13(1).

11 *Ibid* r 13(2).

12 See *ibid* r 12; and PARA 47 post.

13 See *ibid* r 14; and PARA 48 post.

14 *Ibid* r 2. As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

15 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 21.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/B. THE REGISTER OF TRADE MARK AGENTS/41. Special record.

#### **41. Special record.**

There must be kept by the Institute of Trade Mark Attorneys<sup>1</sup> a special record; and the registrar<sup>2</sup> must transfer to the special record the names and particulars of any person whose name has been erased from the register<sup>3</sup>, and he must enter, against such name, the reason for the erasure<sup>4</sup>.

1 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

2 As to the registrar see PARA 42 post.

3 He under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 12 (see PARA 47 post) or r 13 (see PARA 40 text to notes 10-11 ante) or pursuant to a direction under r 14 (see PARA 48 post). As to the continued relevance of these rules see PARA 39 note 2 ante. For the meaning of 'the register' see PARA 40 note 2 ante.

4 Ibid r 4.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/B. THE REGISTER OF TRADE MARK AGENTS/42. The registrar of trade mark agents.

#### **42. The registrar of trade mark agents.**

There must be a registrar<sup>1</sup> who is charged with the duty of maintaining the register<sup>2</sup> and the special record<sup>3</sup> and who is<sup>4</sup> under the direction of the Institute of Trade Mark Attorneys<sup>5</sup>. The registrar must be appointed by the Institute for a period of one year and is eligible, on ceasing to hold office, for reappointment; he holds office and must vacate his office in accordance with such terms and conditions as the Institute may, after consultation with the Comptroller General of Patents, Designs and Trade Marks, determine<sup>6</sup>.

1 For these purposes, 'the registrar' means the person appointed in accordance with the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 7 to maintain the register: r 2.

2 For the meaning of 'the register' see PARA 40 note 2 ante.

3 As to the special record see PARA 41 ante.

4 He is subject to the Register of Trade Mark Agents Rules 1990, SI 1990/1458 (as amended), and to any general directions of the Comptroller General of Patents, Designs and Trade Marks under r 21 (see PARA 40 text to note 15 ante). As to the continued relevance of these rules see PARA 39 note 2 ante. As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

5 Ibid r 7(1). As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

6 Ibid r 7(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/B. THE REGISTER OF TRADE MARK AGENTS/43. Inspection of register and special record.

#### **43. Inspection of register and special record.**

The register<sup>1</sup> and the special record<sup>2</sup> or, if they are kept otherwise than in documentary form, entries therein made available in documentary form, must be open to public inspection at such times and in such manner as the registrar<sup>3</sup>, subject to any general directions of the Comptroller General of Patents, Designs and Trade Marks<sup>4</sup>, may direct<sup>5</sup>.

1 For the meaning of 'the register' see PARA 40 note 2 ante.

2 As to the special record see PARA 41 ante.

3 As to the registrar see PARA 42 ante.

4 le under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 21: see PARA 40 text to note 15 ante. As to the continued relevance of these rules see PARA 39 note 2 ante. As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

5 Ibid r 5.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/44. Qualifying examinations.

### ***C. QUALIFICATIONS FOR REGISTRATION***

#### **44. Qualifying examinations.**

The Institute of Trade Mark Attorneys<sup>1</sup> may by regulations<sup>2</sup> make provision for such educational qualifications, training and qualifying examinations, which examinations must be offered at least once in every year, as it considers appropriate for the registration of persons<sup>3</sup>; and it has<sup>4</sup> the entire management and control of such examinations<sup>5</sup>.

Any such regulations may make transitional provision for candidates who have, before the coming into force of the regulations, entered for any examinations held or to be held by the Institute for the purpose of admission to ordinary membership of the Institute to complete or take the same or part or parts thereof or such other examinations in lieu thereof within such time and subject to such conditions as may be specified<sup>6</sup>.

The Comptroller General of Patents, Designs and Trade Marks may from time to time give general directions to the Institute in relation to such matters as in his opinion will be conducive to the better regulation of any examinations held by the Institute<sup>7</sup>.

1 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

2 I.e. by regulations made by it after consultation with the Chartered Institute of Patent Agents and with the approval of the Comptroller General of Patents, Designs and Trade Marks. As to the Chartered Institute of Patent Agents see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 621. As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

3 I.e. under the Register of Trade Mark Agents Rules 1990, SI 1990/1458 (as amended). As to the continued relevance of these rules see PARA 39 note 2 ante.

4 I.e. subject to any such regulations and any general directions of the Comptroller under *ibid* r 21: see the text to note 7 *infra*.

5 *Ibid* r 8(1).

6 *Ibid* r 8(2).

7 *Ibid* r 21.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/45. Qualifications for registration.

#### 45. Qualifications for registration.

Each of the following persons qualifies for registration<sup>1</sup> as a trade mark agent<sup>2</sup>:

- 69 (1) a person who has passed the qualifying examinations<sup>3</sup> of the Institute of Trade Mark Attorneys<sup>4</sup> and who has completed:
- 1
1. (a) not less than two years' full-time practice in the field of intellectual property, including substantial experience in trade mark agency work<sup>5</sup>, under the supervision of either a registered trade mark agent<sup>6</sup> or of a registered patent agent<sup>7</sup>, barrister, solicitor or, in Scotland or the Isle of Man, an advocate, being a registered patent agent, barrister, solicitor or advocate who is engaged in or has substantial experience of trade mark agency work in the United Kingdom<sup>8</sup>; or
  2. (b) not less than four years' full-time practice in the field of intellectual property, including substantial experience in trade mark agency work in the United Kingdom<sup>9</sup>;
- 2
- 70 (2) a fellow or an ordinary member of the Institute of Trade Mark Attorneys<sup>10</sup>;
  - 71 (3) a person, being a registered patent agent, or a barrister or solicitor or, in Scotland or the Isle of Man, an advocate, who has in the period of eight years immediately preceding the date he seeks to have his name entered in the register<sup>11</sup> a total of three years' practice in trade mark agency work<sup>12</sup>;
  - 72 (4) a person who has in the period of eleven years immediately preceding the date he seeks to have his name entered in the register completed a total of eight years of full-time practice in trade mark agency work<sup>13</sup>; and
  - 73 (5) a person who passed in March 1990 the examination paper<sup>14</sup> set by the Chartered Institute of Patents Agents, and: (a) became a registered patent agent before 31 December 1992; or (b) passed before 31 December 1991 a special advanced trade mark examination paper set by the Institute of Trade Mark Attorneys pursuant to any regulations made<sup>15</sup> by it<sup>16</sup>.

A person mentioned in head (2), head (3) or head (4) above was not entitled, by virtue of his qualification for registration thereunder, to have his name entered in the register<sup>17</sup> after the expiration of:

- 74 (i) in the case of the person mentioned in head (2) above, the period of three years commencing from 1 October 1990<sup>18</sup>;
- 75 (ii) in the case of the person mentioned in head (3) above, the period of four years commencing from 1 October 1990<sup>19</sup>; and
- 76 (iii) in the case of the person mentioned in head (4) above, the period of two years commencing from 1 October 1990<sup>20</sup>.

1    le under the Register of Trade Mark Agents Rules 1990, SI 1990/1458 (as amended). As to the continued relevance of these rules see PARA 39 note 2 ante.

2    Ibid r 9(1).

3    As to the qualifying examinations see PARA 44 ante.

4 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 9(1)(a). As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

5 For these purposes, 'trade mark agency work' means work done in the course of carrying on the business of acting as agent for others for the purpose of applying for or obtaining the registration of trade marks in the United Kingdom or of conducting proceedings before the Comptroller General of Patents, Designs and Trade Marks relating to applications for, or otherwise in connection with, the registration of trade marks: *ibid* r 2. For these purposes, 'United Kingdom' includes the Isle of Man: r 2. For the meaning of 'United Kingdom' generally see PARA 3 note 2 ante. As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

6 For the meaning of 'registered trade mark agent' see PARA 40 note 6 ante.

7 For these purposes, 'registered patent agent' means a person whose name is entered in the register kept under rules made under the Copyright, Designs and Patents Act 1988 s 275 (see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 620): Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 9(3).

8 *Ibid* r 9(1)(a)(i).

9 *Ibid* r 9(1)(a)(ii).

10 *Ibid* r 9(1)(b).

11 *Ie* under *ibid* r 10: see PARA 46 post.

12 *Ibid* r 9(1)(c).

13 *Ibid* r 9(1)(d).

14 *Ie* the examination paper entitled 'Advanced Trade Marks Practice (T3)'.

15 *Ie* under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 8: see PARA 44 ante.

16 *Ibid* r 9(1)(e).

17 *Ibid* r 9(2).

18 *Ibid* r 9(2)(a), (3).

19 *Ibid* r 9(2)(b), (3).

20 *Ibid* r 9(2)(c), (3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/46. Entitlement to registration.

#### **46. Entitlement to registration.**

Unless a direction<sup>1</sup> by the Secretary of State<sup>2</sup> in relation to him is in force, a person who qualifies for registration<sup>3</sup> is entitled to have his name entered in the register<sup>4</sup> on production to the registrar<sup>5</sup> of evidence that he qualifies for registration and on the payment of the prescribed<sup>6</sup> fee<sup>7</sup>.

For the purpose of satisfying himself that a person has completed the requisite number of years of practice, the registrar may require that person to submit to him a statutory declaration attesting to that fact and may require such further particulars of that practice as he may consider necessary<sup>8</sup>.

Upon being satisfied after due inquiry<sup>9</sup> that a person, who would otherwise be entitled to be registered, has been guilty of misconduct, the Secretary of State may direct that the name of that person is not to be registered; and upon such direction the registrar must not, except with the prior consent of the Secretary of State, register the name of that person<sup>10</sup>.

1    Ie under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 10(3): see the text to note 10 infra. As to the continued relevance of these rules see PARA 39 note 2 ante.

2    As to the Secretary of State see PARA 14 ante.

3    Ie under the Register of Trade Mark Agents Rules 1990, SI 1990/1458 r 9: see PARA 45 ante.

4    For the meaning of 'the register' see PARA 40 note 2 ante.

5    As to the registrar see PARA 42 ante.

6    Ie the fee prescribed by regulations under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 20: see PARA 53 post.

7    Ibid r 10(1).

8    Ibid r 10(2).

9    Ie in accordance with ibid r 15: see PARA 48 post.

10   Ibid r 10(3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/47. Erasure of name for failure to pay fee.

#### **47. Erasure of name for failure to pay fee.**

If any registered trade mark agent<sup>1</sup> fails to pay any annual practice fee that may be prescribed<sup>2</sup> within one month from the day on which it becomes payable, the registrar<sup>3</sup> must send to him at his business address, as shown in the register<sup>4</sup>, a notice requiring him to pay the fee on or before a day specified in the notice; and, if that person fails to pay the fee on or before that date, the registrar may erase his name from the register<sup>5</sup>.

The name of a person so erased from the register may be restored to it by direction of the Institute of Trade Mark Attorneys<sup>6</sup> on payment by him of the fee or fees due from him, together with such further sum not exceeding the amount prescribed for the annual practice fee as the Institute may in each particular case direct<sup>7</sup>.

1 For the meaning of 'registered trade mark agent' see PARA 40 note 6 ante.

2 I.e. by regulations made under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 20: see PARA 53 post. As to the continued relevance of these rules see PARA 39 note 2 ante.

3 As to the registrar see PARA 42 ante.

4 For the meaning of 'the register' see PARA 40 note 2 ante.

5 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 12(1).

6 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

7 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 12(2).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/48. Erasure of registration after due inquiry into misconduct.

#### **48. Erasure of registration after due inquiry into misconduct.**

Where the Secretary of State<sup>1</sup> is satisfied, after due inquiry<sup>2</sup>, that a person has been guilty of misconduct, that is to say, conduct discreditable to a registered trade mark agent<sup>3</sup>, he may at his discretion, having regard to the circumstances of the misconduct, direct that the name of that person be erased from the register<sup>4</sup>; and he may further direct that the name is to remain erased during such period as he may specify<sup>5</sup>. Upon such a direction the registrar<sup>6</sup> must erase the name and particulars of that person from the register accordingly<sup>7</sup>.

Where it appears to the Secretary of State<sup>8</sup> that a person may have been guilty of misconduct, he must serve on that person ('the person affected') a notice<sup>9</sup>:

- 77 (1) informing him of the grounds on which it so appears to the Secretary of State and the substance of any allegations of misconduct made against him<sup>10</sup>; and
- 78 (2) inviting him to submit to the Secretary of State, within such period, being not less than 21 days, as may be specified in the notice, his representations in writing and requiring him to serve notice, if he wishes, of his intention to make oral representations<sup>11</sup>.

A copy of the notice so served on the person affected and a copy of any written representations submitted by him to the Secretary of State must be served by the Secretary of State on the Institute of Trade Mark Attorneys<sup>12</sup>.

Where the person affected has so served notice of his intentions to make oral representations, the Secretary of State must give him not less than 21 days' notice, or such shorter notice as the person affected may request or consent to accept, of the date, time and place at which his representations will be heard<sup>13</sup>.

If the Secretary of State considers that he should proceed with his inquiry but for a reason which differs or on grounds which differ from those set out in the notice served by him, he must give<sup>14</sup> a further notice<sup>15</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 Ie in accordance with the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 15: see the text to notes 8-15 infra. As to the continued relevance of these rules see PARA 39 note 2 ante.

3 For the meaning of 'registered trade mark agent' see PARA 40 note 6 ante.

4 For the meaning of 'the register' see PARA 40 note 2 ante.

5 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 14.

6 As to the registrar see PARA 42 ante.

7 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 14.

8 Ie under *ibid* r 10(3) (see PARA 46 text to notes 9, 10 ante) or r 14 (see the text to notes 1-7 supra).

9 *Ibid* r 15(1).

- 10 Ibid r 15(1)(a).
- 11 Ibid r 15(1)(b).
- 12 Ibid r 15(2). As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.
- 13 Ibid r 15(3).
- 14 le under ibid r 15(1): see the text to notes 8-11 supra.
- 15 Ibid r 15(4).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/49. Hearing of representations.

#### **49. Hearing of representations.**

At the hearing of oral representations<sup>1</sup> the Secretary of State<sup>2</sup> must, at the request of the person affected<sup>3</sup>, permit any other person, in addition to the person affected, to make representations on his behalf or to give evidence or to introduce documents for him<sup>4</sup>. The Secretary of State may not refuse to admit evidence solely on the grounds that it would not be admissible in a court of law<sup>5</sup>.

The hearing may be adjourned at the discretion of the Secretary of State; and, if the hearing is so adjourned, he must give the person affected reasonable notice of the date, time and place at which the hearing is to be resumed<sup>6</sup>.

The Secretary of State must inform the Institute of Trade Mark Attorneys<sup>7</sup> of the date, time and place appointed for any hearing, and the Institute is entitled to be represented at the hearing and to make submissions touching on the matters in issue<sup>8</sup>.

1 He held pursuant to the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 15(3): see PARA 48 text to note 13 ante. As to the continued relevance of these rules see PARA 39 note 2 ante.

2 As to the Secretary of State see PARA 14 ante.

3 For the meaning of 'the person affected' see PARA 48 ante.

4 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 16(1).

5 Ibid r 16(2).

6 Ibid r 16(3).

7 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

8 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 16(4).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/50. Decision.

## **50. Decision.**

In deciding whether to issue a direction, the Secretary of State<sup>1</sup> must take into account any written or oral representations duly made<sup>2</sup> and:

- 79 (1) if he decides not to issue a direction, he must give notice of that decision to the person affected<sup>3</sup>, the Institute of Trade Mark Attorneys<sup>4</sup> and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person, if known, although he need not state the reasons for that decision<sup>5</sup>;
- 80 (2) if he decides to issue a direction, he must give notice of his decision, the terms thereof and his reasons for the decision to the person affected, the Institute and, where the decision relates to any allegations of misconduct made by any person against the person affected, to that person, if known<sup>6</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 17. The representations referred to in the text are those which are made in accordance with r 15 (see PARA 48 ante) and r 16 (see PARA 49 ante). As to the continued relevance of these rules see PARA 39 note 2 ante.

3 For the meaning of 'the person affected' see PARA 48 ante.

4 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

5 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 17(a).

6 Ibid r 17(b).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/C. QUALIFICATIONS FOR REGISTRATION/51. Restoration of name to the register.

### **51. Restoration of name to the register.**

On an application made to him by a person whose name has been erased from the register after due inquiry into misconduct<sup>1</sup>, the Secretary of State<sup>2</sup> may, if he thinks fit, direct that the name of that person is to be restored to the register; and he may further direct that such restoration is to be made either without a fee or on payment of such fee as he may fix not exceeding the prescribed fee<sup>3</sup> for the registration of a name<sup>4</sup>.

Upon a direction for the restoration of the name of a person, the registrar<sup>5</sup> must restore the name and particulars of that person to the register and must, in the case of a person whose name has been erased for a specified period and in respect of whom no direction has been issued under this provision, restore his name and particulars upon the expiration of that period and upon payment of the prescribed fee for the registration of a name<sup>6</sup>.

1     Ie under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 14: see PARA 48 ante. For the meaning of 'the register' see PARA 40 note 2 ante. As to the continued relevance of these rules see PARA 39 note 2 ante.

2     As to the Secretary of State see PARA 14 ante.

3     Ie the fee prescribed by regulations made under the Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 20: see PARA 53 post.

4     Ibid r 18(1).

5     As to the registrar see PARA 42 ante.

6     Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 18(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/D. APPEALS/52. Appeal to the Comptroller General of Patents, Designs and Trade Marks from decision of the Institute of Trade Mark Attorneys or the registrar.

## **D. APPEALS**

### **52. Appeal to the Comptroller General of Patents, Designs and Trade Marks from decision of the Institute of Trade Mark Attorneys or the registrar.**

A person aggrieved by any decision of the Institute of Trade Mark Attorneys<sup>1</sup> or the registrar<sup>2</sup> may appeal to the Comptroller General of Patents, Designs and Trade Marks<sup>3</sup> by serving on the Comptroller, within one month from the date of the decision, a notice of appeal, stating the grounds of appeal with a statement of his case in support thereof<sup>4</sup>. A copy of the notice with a copy of the statement of case must, at the same time, be served by that person ('the appellant') on the Institute or the registrar, as appropriate<sup>5</sup>.

On receipt of the notice of appeal, the Comptroller must give such directions as he thinks fit for the purpose of hearing the appeal and must give the appellant and the Institute or the registrar, as the case may be, not less than 14 days' notice, or such shorter notice as the appellant and the Institute or registrar may consent to accept, of the date, time and place appointed for the hearing of the appeal<sup>6</sup>.

At the hearing the Comptroller must, at the request of any party, permit any other person, in addition to that party, to appear on his behalf<sup>7</sup>.

The Comptroller must give his decision on the appeal in writing with a statement of his reasons and must serve a copy thereof on the appellant and the Institute or the registrar<sup>8</sup>.

The Comptroller's decision on the appeal is final; and for the purposes of giving effect to it he may give such directions to the Institute or the registrar as he thinks fit<sup>9</sup>.

1 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

2 As to the registrar see PARA 42 ante.

3 As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

4 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 19(1). As to the continued relevance of these rules see PARA 39 note 2 ante.

5 Ibid r 19(1).

6 Ibid r 19(2).

7 Ibid r 19(3).

8 Ibid r 19(4).

9 Ibid r 19(5).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/E. FEES/53. In general.

## ***E. FEES***

### **53. In general.**

The Institute of Trade Mark Attorneys<sup>1</sup> may, by regulations made by it with the approval of the Comptroller General of Patents, Designs and Trade Marks<sup>2</sup>, prescribe the fees to be paid<sup>3</sup> by:

- 81 (1) every candidate for any examinations, or part or parts thereof, duly held<sup>4</sup>;
- 82 (2) every person for the registration of his name<sup>5</sup>;
- 83 (3) every registered trade mark agent<sup>6</sup> as an annual practice fee<sup>7</sup>;
- 84 (4) a registered trade mark agent requesting an amendment of the register<sup>8</sup>,

and any such regulations may provide for the remission or refund of any fees in such circumstances as may be prescribed thereunder<sup>9</sup>.

When prescribing any fees for the purposes of head (1) above, the Institute must, as far as practicable, secure that the income therefrom does not exceed the expenditure properly incurred in administering any examinations, taking one year with another<sup>10</sup>.

1 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

2 As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

3 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 20(1). As to the continued relevance of these rules see PARA 39 note 2 ante.

4 Ibid r 20(1)(a). The examinations referred to in the text are those which are held in accordance with regulations made under r 8 (see PARA 44 ante).

5 Ibid r 20(1)(b).

6 For the meaning of 'registered trade mark agent' see PARA 40 note 6 ante.

7 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 20(1)(c).

8 Ibid 20(1)(d). The amendment referred to in the text is an amendment made under r 11 (see PARA 40 ante). For the meaning of 'the register' see PARA 40 note 2 ante.

9 Ibid r 20(1).

10 Ibid r 20(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(2) ADMINISTRATION/(iv) Trade Mark Agents/F. REPORT OF THE INSTITUTE/54. In general.

## ***F. REPORT OF THE INSTITUTE***

### **54. In general.**

The Institute of Trade Mark Attorneys<sup>1</sup> must before 30 April in every year send to the Comptroller General of Patents, Designs and Trade Marks<sup>2</sup> a report<sup>3</sup> stating:

- 85 (1) the number of applications for registration which were made in the preceding year and the number of registrations effected in that year<sup>4</sup>;
- 86 (2) the examinations which were held in that year and the results of them<sup>5</sup>;
- 87 (3) the amount of the fees received by the Institute in that year<sup>6</sup>; and
- 88 (4) that the limitation on income from fees for examinations<sup>7</sup> has been complied with and showing, by reference to income and expenditure, its compliance with that limitation<sup>8</sup>,

and must include in the report a statement on such other matters<sup>9</sup> as the Comptroller may from time to time require<sup>10</sup>.

1 As to the Institute of Trade Mark Attorneys see PARA 40 note 1 ante.

2 As to the Comptroller General of Patents, Designs and Trade Marks see PARA 17 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 577.

3 Register of Trade Mark Agents Rules 1990, SI 1990/1458, r 22. As to the continued relevance of these rules see PARA 39 note 2 ante.

4 Ibid r 22(a).

5 Ibid r 22(b).

6 Ibid r 22(c).

7 Ie ibid r 20(2): see PARA 53 ante.

8 Ibid r 22(d).

9 Ie in relation to the provisions of the Register of Trade Mark Agents Rules 1990, SI 1990/1458 (as amended), including any regulations made by the Institute pursuant thereto.

10 Ibid r 22.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(i) Introduction/55. In general.

### **(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS**

#### **(i) Introduction**

##### **55. In general.**

Any sign<sup>1</sup> may be registered as a trade mark pursuant to a United Kingdom application unless one of a number of specified grounds for refusal exists; the registrar<sup>2</sup> has no discretion to refuse an application if none of these grounds applies<sup>3</sup>. The grounds for refusal are divided into two classes, described in the Trade Marks Act 1994 as 'absolute grounds for refusal'<sup>4</sup> and 'relative grounds for refusal'<sup>5</sup>. The absolute grounds for refusal are concerned with the intrinsic qualities of the trade mark itself, whereas the relative grounds for refusal are concerned with conflict with the prior rights of third parties. In addition, registration may, or in some cases must, be refused if the trade mark contains or consists of certain specially protected emblems<sup>6</sup>. The same grounds for refusal apply to the protection of an international registration<sup>7</sup> designating the United Kingdom, since such a registration is entitled to become protected if it satisfies the requirements for registration imposed on domestic applications<sup>8</sup>.

Where grounds for refusal of registration exist in respect of only some of the goods or services for which the trade mark has been applied for, refusal of registration must cover those goods or services only<sup>9</sup>.

1 As to the meaning of 'sign' see PARA 57 note 1 post.

2 As to the registrar see PARA 17 ante.

3 *EUROLAMB Trade Mark*[1997] RPC 279, Appointed Person; *Procter & Gamble Ltd's Trade Mark Applications*[1999] RPC 673, CA; and see PARA 381 post. Cf the position on an application for revocation or a declaration of invalidity: see PARA 111 post.

4 See the Trade Marks Act 1994 s 3, marginal note. The same term is employed in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7 (as amended): see PARA 209 et seq post. As to the effect of marginal notes see STATUTES vol 44(1) (Reissue) PARA 1276. As to the absolute grounds for refusal of registration see PARA 58 et seq post.

5 See the Trade Marks Act 1994 s 5, marginal note. The same term is employed in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 8 (as amended): see PARA 218 et seq post. As to the relative grounds for refusal of registration see PARA 70 et seq post.

6 See the Trade Marks Act 1994 s 4 (as amended); and PARA 66 post.

7 Ie from an application made to the International Bureau under the Madrid Protocol: see PARA 11 ante. As to the Madrid Protocol see PARA 8 ante.

8 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 3(1). The terminology used for international trade marks is different since they 'become protected' in the United Kingdom rather than being registered, but the substantive requirements which they need to satisfy are the same: see PARA 13 ante.

9 See EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 13; and PARA 381 post.

## **UPDATE**

### **55 In general**

NOTE 8--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(i) Introduction/56. Date of assessment.

## **56. Date of assessment.**

Except where there is a valid claim to priority<sup>1</sup>, when considering whether a sign may be registered as a trade mark, the applicability of both the absolute and the relevant grounds of refusal<sup>2</sup> must be considered as at the date of filing of the application<sup>3</sup>. The same rule applies when considering whether a registration should be declared invalid<sup>4</sup>, except where the proprietor relies upon distinctive character acquired by use as an answer to an objection that the trade mark lacked distinctiveness<sup>5</sup>.

1    Ie under the Trade Marks Act 1994 ss 35, 36. As to priority see PARA 378 et seq post.

2    Ie under ibid ss 3, 5. As to meanings of 'absolute grounds of refusal' and 'relative grounds of refusal' see PARA 55 ante.

3    See eg Case C-192/03 *Alcon Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-8993, ECJ; Case T-247/01 *eCopy Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-5301, (2002) Times, 31 December, CFI; *Bongrain SA's Trade Mark Application* [2004] EWCA Civ 1690, [2005] RPC 306; *HOTPICKS Trade Mark* [2004] EWHC 689 (Ch), [2004] RPC 834; but see also Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-5089, [2005] IP & T 1, ECJ (declining to rule on question whether distinctiveness must also be judged as at date of registration). Nevertheless it is legitimate to take account of evidence from a later date if and in so far as it enables the drawing of conclusions as to the situation at the date of filing; Case C-192/03 *Alcon Inc v Office for Harmonisation in the Internal Market* supra; cf Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, ECJ. As to the date of filing see PARA 366 post.

4    Ie under the Trade Marks Act 1994 s 47: see PARA 118 et seq post.

5    Ie by virtue of the proviso to ibid s 47(1): see PARA 118 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(i) Introduction/57. Meaning of 'trade mark'.

## 57. Meaning of 'trade mark'.

For the purposes of the Trade Marks Act 1994, 'trade mark' means any sign<sup>1</sup> capable of being represented graphically<sup>2</sup> which is capable of distinguishing goods or services of one undertaking from those of other undertakings<sup>3</sup>. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging<sup>4</sup>.

References in the Act to a trade mark include, unless the context otherwise requires, references to a collective mark<sup>5</sup> or certification mark<sup>6</sup>.

1 A sign is anything which is capable of conveying information: *Philips Electronics BV v Remington Consumer Products Ltd* [1998] RPC 283 at 298 per Jacob J; affd on other grounds [1999] RPC 809, [1999] All ER (D) 465, CA; referred to EC sub nom C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ. The subject matter of an application for trade mark registration which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner is not a sign: Case C-321/03 *Dyson Ltd v Registrar of Trade Marks* [2007] ETMR 34, [2007] All ER (D) 201 (Jan). It has also been doubted whether an alignment of symbols on a fruit machine occurring on a (pseudo) random basis is a sign (*Electrocoin Automatics Ltd v Coinworld Ltd* [2004] EWHC 1498 (Ch) at [138], [2005] FSR 7 at [138], [2005] IP & T 132 at [138] per G Hobbs QC). See also the text and note 4 infra.

2 To satisfy this requirement, the sign must be represented by graphical means, in particular images, lines or characters, and the representation must be clear, precise, self-contained, easily accessible, durable and objective: Case C-273/00 *Sieckmann v Deutsches Patent- und Markenamt* [2003] Ch 487, [2002] ECR I-11737, ECJ; Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ; Case C-283/01 *Shield Mark BV v Kist (t/a Memex)* [2004] Ch 97, [2003] ECR I-14313, ECJ; Case C-49/02 *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, ECJ. A mere sample of colour does not satisfy this requirement, but a sample of a colour combined with a description in words of that colour may do so, as may a designation using an internationally recognised identification code: Case C-273/00 *Libertel Groep BV v Benelux-Merkenbureau* supra. The mere juxtaposition of two colours, without shape or contours, does not satisfy this requirement, but a systematic arrangement of two colours in a predetermined and uniform way may do so: Case C-49/02 *Heidelberger Bauchemie GmbH* supra. A description of a sound in words or using onomatopoeia or by means of a sequence of musical notes without more does not satisfy this requirement, but full musical notation may do so: Case C-283/01 *Shield Mark BV v Kist (t/a Memex)* supra. In the case of a spoken mark a sonogram has been held to comply with this requirement: Case R 295/2005-4 *Hexal AG's Application* (8 September 2005, unreported), OHIM Board of Appeal. A representation of an odour by means of a chemical formula, a description in words or the deposit of a sample or all three does not satisfy this requirement: Case C-273/00 *Sieckmann v Deutsches Patent- und Markenamt* supra; Case T-305/04 *Eden SARL v Office for Harmonisation in the Internal Market* [2006] ETMR 14, CFI (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie arts 4, 7(1)(a) (see PARAS 208, 210 post)). The same applies to a taste or flavour: Case R 120/2001-2 *Eli Lilly & Co's Application* [2004] ETMR 4, OHIM Board of Appeal (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie arts 4, 7(1)(a) (see PARAS 208, 210 post)). In the case of a three-dimensional sign, it may be necessary for the applicant to present a clearly defined image of the sign; a mere description, even if conveying the clear and precise appearance of the sign, is not sufficient: Case R 156/1998-2 *Antoni and Alison's Application* [1998] ETMR 460, OHIM Board of Appeal (method of packing) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie arts 4, 7(1)(a) (see PARAS 208, 210 post)); *Swizzels Matlow Ltd's Application* [1999] RPC 879, Appointed Person (shape of a sweet); and see Case C-321/03 *Dyson Ltd v Registrar of Trade Marks* [2007] ETMR 34 at [57]-[66], [2007] All ER (D) 201 (Jan) at [57]-[66] per Léger AG.

Even if the representation satisfies this requirement, lack of precision in the representation may have adverse consequences for the distinctiveness of the trade mark: see *Nestlé SA's Trade Mark Application* [2004] EWCA Civ 1008, [2005] RPC 77, sub nom *Société des Produits Nestlé SA v Mars UK Ltd* [2005] IP & T 551.

As to whether an inadequate graphical representation filed initially can subsequently be rectified and the impact on the date of filing if this is done see PARAS 366, 375 post.

3 Trade Marks Act 1994 s 1(1) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 2). Signs which do not satisfy the requirements of the Trade Marks Act 1994 s 1(1) may not be registered as trade marks: see s 3(1); and PARAS 59-60 post.

A sign is only incapable of distinguishing goods or services of one undertaking from those of other undertakings for this purpose if it is incapable of distinguishing the goods or services of the former from those of the latter irrespective of the goods or services in relation to which the sign may be used: Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch 1, [2004] ECR I-1619, ECJ.

A sign which consists of the shape of an article does not require any capricious addition, such as an embellishment which has no functional purpose, in order to be capable of distinguishing it for this purpose: Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ.

4 Trade Marks Act 1994 s 1(1). Trade marks may also consist of slogans: Case C-64/02P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Erpo Möbelwerk GmbH* [2004] ECR I-10031, ECJ. Trade marks may also consist of colours, sounds and odours provided that the requirement for graphical representation is complied with: Case C-273/00 *Sieckmann v Deutsches Patent- und Markenamt* [2003] Ch 487, [2002] ECR I-11737, ECJ; Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ; Case C-283/01 *Shield Mark BV v Kist (t/a Memex)* [2004] Ch 97, [2003] ECR I-14313, ECJ; Case C-49/02 *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, ECJ. It appears that trade marks may also consist of moving images; the registrar's practice is to accept moving image marks represented by a series of still images: Practice Amendment Circular PAC 2/00.

5 As to collective marks see PARA 155 et seq post. In relation to a collective mark the reference in the Trade Marks Act 1994 s 1(1) (see the text to notes 1-4 supra) to distinguishing goods or services of one undertaking from those of other undertakings is to be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings: s 49(2), Sch 1 para 2.

6 Ibid s 1(2). As to certification marks see PARA 165 et seq post. In relation to a certification mark the reference in s 1(1) (see the text to notes 1-4 supra) to distinguishing goods or services of one undertaking from those of other undertakings is to be construed as a reference to distinguishing goods or services which are certified from those which are not: s 50(2), Sch 2 para 2.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/58. In general.

## **(ii) Absolute Grounds for Refusal of Registration**

### **58. In general.**

Each of the absolute grounds of refusal<sup>1</sup> is independent of the others and calls for separate examination<sup>2</sup>. This examination must be stringent and full in order to prevent trade marks from being improperly registered<sup>3</sup>. The registrar<sup>4</sup> must have regard to all the relevant facts and circumstances, as must the appointed person<sup>5</sup> or the court<sup>6</sup> on appeal from the registrar subject to the limits on their powers<sup>7</sup>. In assessing the applicability of the absolute grounds for refusal, the limits on the effects of the trade mark once registered<sup>8</sup> are immaterial<sup>9</sup>. Account may be taken of decisions in other member states to register the same trade mark in respect of the same goods or services, but such decisions cannot be regarded as decisive<sup>10</sup>.

1 As to the meaning of 'absolute grounds of refusal' see PARA 55 ante. As to the grounds of refusal see PARA 59 et seq post.

2 Joined Cases C-53/01 and C-55/01 *Re Linde AG* [2003] ECR I-3161, sub nom *Linde AG v Deutsches Patent- und Markenamt* [2003] RPC 803, ECJ; Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch 1, [2004] ECR I-1619, ECJ; Case C-265/00 *Campina Melkunie BV v Benelux-Merkenbureau* [2004] ECR I-1699, [2004] IP & T 959, ECJ; Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-5089, [2005] IP & T 1, ECJ; Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-8317, ECJ; Case 64/02P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Erpo Möbelwerk GmbH* [2004] ECR I-10031, ECJ; Case C-37/03P *BioID AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR I-7975, [2005] All ER (D) 80 (Sep), ECJ.

3 Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ; Case C-64/02P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Erpo Möbelwerk GmbH* [2004] ECR I-10031, ECJ.

4 As to the registrar see PARA 17 ante.

5 As to appeals to the appointed person see PARA 406 et seq post.

6 As to appeals to the court see PARA 409 et seq post.

7 Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch 1, [2004] ECR I-1619, ECJ; Case C-49/02 *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, ECJ.

8 As to the limits on the effect of a trade mark once registered see the Trade Marks Act 1994 s 11; and PARA 92 et seq post.

9 Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ; Case C-404/02 *Nichols plc v Registrar of Trade Marks* [2004] ECR I-8499, [2005] All ER (EC) 1, ECJ.

10 Case C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt* [2004] ECR I-1725, ECJ.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/59. Signs which cannot constitute trade marks.

## **59. Signs which cannot constitute trade marks.**

Signs which do not satisfy the requirements of the statutory definition of a trade mark<sup>1</sup> may not be registered<sup>2</sup>.

<sup>1</sup> The signs which do not satisfy the requirements of the Trade Marks Act 1994 s 1(1): see PARA 57 ante. There is no category of signs which is not excluded from registration by s 3(1)(b)-(d), (3) but which is nonetheless excluded from registration by s 3(1)(a): Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ.

<sup>2</sup> Trade Marks Act 1994 s 3(1)(a) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(1)(a)). For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/60. Lack of distinctive character.

## 60. Lack of distinctive character.

The following must not be registered<sup>1</sup>:

- 89 (1) trade marks<sup>2</sup> which are devoid of any distinctive character<sup>3</sup>;
- 90 (2) trade marks which consist exclusively of signs or indications which may serve, in trade<sup>4</sup>, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services<sup>5</sup>;
- 91 (3) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade<sup>6</sup>.

A trade mark must not, however, be refused registration by virtue of head (1), head (2) or head (3) above if, before the date of application for registration<sup>7</sup>, it has in fact acquired a distinctive character as a result of the use<sup>8</sup> made of it<sup>9</sup>.

1 Trade Marks Act 1994 s 3(1). For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 6 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 Trade Marks Act 1994 s 3(1)(b) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(1)(b)). Despite its position the Trade Marks Act 1994 s 3(1)(b) (see head (1) in the text) performs 'a residual or sweeping-up function' backing up s 3(1)(c), (d) (see heads (2), (3) in the text): *Proctor & Gamble Ltd's Trade Mark Application* [1999] RPC 673 at 679, CA, per Robert Walker LJ. This is because lack of distinctive character is the essence of any objection under the Trade Marks Act 1994 s 3(1)(b), (c) or (d): *West (t/a Eastenders) v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44, [2003] IP & T 769. Thus a word mark which is descriptive of characteristics of the goods or services for the purposes of the Trade Marks Act 1994 s 3(1)(c) is necessarily devoid of distinctive character within s 3(1)(b): Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch 1, [2004] ECR I-1619, ECJ; Case C-265/00 *Campina Melkunie BV v Benelux-Merkenbureau* [2004] ECR I-1699, [2004] IP & T 959, ECJ. Conversely, a mark which is not descriptive may nevertheless be devoid of distinctive character: Joined Cases C-53/01 and C-55/01 *Re Linde AG* [2003] ECR I-3161, sub nom *Linde AG v Deutsches Patent- und Markenamt* [2003] RPC 803, ECJ; Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* supra.

For a trade mark to possess distinctive character, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings: Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ; Joined Cases C-53/01 and C-55/01 *Linde AG v Deutsches Patent- und Markenamt* supra; Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-5089, [2005] IP & T 1, ECJ; Case C-136/02P *Mag Instrument Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-9165, [2004] All ER (D) 75 (Oct), ECJ.

The distinctive character of a mark must be assessed: (1) in relation to the goods or services in respect of which registration is applied for; and (2) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect: Case C-299/99 *Koninklijke Philips Electronics v Remington Consumer Products* supra; Joined Cases C-53/01 and C-55/01 *Linde AG v Deutsches Patent- und Markenamt* supra; Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ; Case C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt* [2004] ECR I-1725, ECJ; Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* supra; Joined Cases C-468/01P to C-472/01P *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-5141, [2005] IP & T 1, ECJ; Case C-445/02P *Glaverbel SA v Office for Harmonisation in the*



*Internal Market (Trade Marks and Designs)* [2004] ECR I-6267, ECJ; Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market* supra. The fact that a sign is capable of constituting a trade mark does not necessarily mean that the sign has distinctive character in relation to a specific product or service: Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market* supra; Joined Cases C-468/01P to C-472/01P *Procter & Gamble Co v Office for Harmonisation in the Internal Market* supra.

The average consumer normally perceives a trade mark as a whole rather than analysing its details and therefore, in order to assess whether it has any distinctive character, the overall impression given by it must be considered; but it is legitimate for the competent authority first to examine each of the individual components of the mark: Case C-104/00P *DKV Deutsche Krankenversicherung AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR I-7561, [2002] All ER (D) 100 (Sep), ECJ; Joined Cases C-468/01P to C-472/01P *Procter & Gamble Co v Office for Harmonisation in the Internal Market* supra; Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-8317, ECJ; Case C-136/02P *Mag Instrument Inc v Office for Harmonisation in the Internal Market* supra; Case C-286/04P *Eurocermex SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR I-5797, [2005] IP & T 965, ECJ.

It is not necessary to establish distinctive character to show that the mark has a particular level of creativity or imagination or originality; but nor is it necessary to establish that the mark is devoid of distinctive character to show that the mark is commonly used or capable of being commonly used: Case C-329/02P *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market* supra; Case 64/02P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Erpo Möbelwerk GbmH* [2004] ECR I-10031, ECJ; Case C-37/03 *Biold AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR I-7975, ECJ.

The Court of First Instance has consistently held that a minimum degree of distinctive character is sufficient to render this ground of refusal inapplicable: Case T-34/00 *Eurocool Logistik GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-683, [2002] IP & T 756, CFI; Case T-79/00 *Rewe-Zentral AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-705, [2002] IP & T 533, CFI; Case T-128/01 *DaimlerChrysler Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-701, [2004] IP & T 150, CFI; Case T-305/02 *Nestlé Waters France v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-5207, [2004] IP & T 664, CFI; Case T-320/03 *Citicorp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] All ER (D) 81 (Sep), CFI. The European Court of Justice has held that it is not necessary to rule upon the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness: Case C-104/00P *Deutsche Krankenversicherung AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR I-7561, [2002] All ER (D) 100 (Sep), ECJ.

A trade mark can lose its distinctive character as a result of use by third parties: Case T-237/01 *Alcon Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-411, CFI; *BACH and BACH FLOWER REMEDIES Trade Marks* [2000] RPC 513, sub nom *Bach Flower Remedies Ltd v Healing Herbs Ltd* [1999] IP & T 146, CA; *Rugby Football Union v Cotton Traders Ltd* [2002] EWHC 467 (Ch), [2002] IP & T 646, [2002] ETMR 76; *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] FSR 508, [2007] ETMR 54.

The criteria for assessment of distinctive character are the same for all categories of trade marks; but nevertheless the perception of the relevant public is not the same for all categories of trade marks and it may therefore be more difficult to establish distinctive character in relation to some categories (such as shapes, surface treatments, colours, personal names and advertising slogans) than others: Joined Cases C-53/01 and C-55/01 *Linde AG v Deutsches Patent- und Markenamt* supra; Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* supra; Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market* supra; Case C-445/02P *Glaverbel SA v Office for Harmonisation in the Internal Market* supra; Case C-404/02 *Nichols plc v Registrar of Trade Marks* [2004] ECR I-8499, [2005] All ER (EC) 1, ECJ; Case C-136/02P *Mag Instrument Inc v Office for Harmonisation in the Internal Market* supra; Case 64/02P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Erpo Möbelwerk GbmH* supra; Case C-447/02P *KWS Saat AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-10107, [2007] IP & T 314, [2004] All ER (D) 294 (Oct), ECJ.

In the case of shapes, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of distinctive character; only a trade mark which departs significantly from the norms or customs of the sector and thereby fulfils its essential function of indicating origin is likely to possess distinctive character: Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market* supra; Joined Cases C-468/01P to C-472/01P *Procter & Gamble Co v Office for Harmonisation in the Internal Market* supra; Case C-136/02P *Mag Instrument Inc v Office for Harmonisation in the Internal Market* supra; Case T-15/05 *Wim De Waele v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] IP & T 1, [2006] All ER (D) 10 (Jun). The same applies to shapes consisting of the packaging of goods, such as liquids, which are packaged in trade for reasons linked to the very nature of the product: Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Deutsches Patent- und Markenamt* supra; Case C-173/04P *Deutsche SiSi-Werke GmbH & Co Betriebs KG v Office for Harmonisation in the Internal Market* [2006] ETMR 41, ECJ. For this purpose the sector extends wider than just the goods for which registration is sought: Case C-173/04P *Deutsche SiSi-Werke GmbH & Co Betriebs KG v*

*Office for Harmonisation in the Internal Market* supra. It is not enough to establish distinctive character that the shape is striking and unusual without more: *Bongrain SA's Trade Mark Application* [2004] EWCA Civ 1690, [2005] RPC 306, [2005] IP & T 563. Where, however, there is an established practice of using shapes to distinguish the trade origin of goods, the position is different: Case T-128/01 *DaimlerChrysler Corp'n v Office for Harmonisation in the Internal Market* supra (car radiator grilles).

In the case of colours, a single colour per se is very unlikely to be distinctive without use: Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* supra; Case C-447/02 *KWS Saat AG v Office for Harmonisation in the Internal Market* supra.

In the case of personal names, it is not legitimate to assess distinctive character by applying general criteria such as the number of entries in telephone directories (*Nichols plc v Registrar of Trade Marks* supra) but it is legitimate as part of a specific assessment of the distinctive character of the mark to take into account the commonness of the name and the extent to which personal names are used to designate commercial origin in the sector in question (*Oska's Ltd's Trade Mark Application* [2005] RPC 525, Appointed Person).

A mark that is perceived by the average consumer as a mere promotional slogan, particularly one that commends some attribute of the goods or services in question, lacks distinctive character: Case T-130/01 *Sykes Enterprises Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-5179, [2003] IP & T 213, CFI; Case T-216/02 *Fieldturf Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-1023, CFI; Case T-281/02 *Norma Lebensmittelfilialbetrieb GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-1915, [2004] All ER (D) 05 (Jul), CFI; Case T-320/03 *Citicorp v Office for Harmonisation in the Internal Market* supra; but cf Case 64/02P *Office for Harmonisation in the Internal Market v Erpo Möbelwerk GbmH* supra; and see also *Look-O-Look International BV's Application for Protection* (O/010/06), Appointed Person.

A term borrowed from the language of another member state, in which it is descriptive of the goods or services in question or otherwise devoid of distinctive character, is not precluded from registration by the Trade Marks Act 1994 s 3(1)(b) unless the relevant persons in the United Kingdom are capable of identifying the meaning of the term: Case C-421/04 *Matrazen Concorde AG v Hukla Germany SA* [2006] IP & T 483, [2006] ETMR 48, ECJ.

A mark may be devoid of distinctive character even if it is not exclusively descriptive, in particular because it includes graphical elements as well as descriptive words: see Case C-37/03 *BioID AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR I-7975, ECJ; *Cycling IS . . . Trade Mark Applications* [2002] RPC 729, Appointed Person; *Hormel Foods Corp'n v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822.

In the case of device marks, even simple devices with descriptive connotations may have inherent distinctive character: *Koninklijke Philips NV v Remington Consumer Products Ltd* [2006] EWCA Civ 16, [2007] IP & T 206, [2006] FSR 537.

4 For these purposes, 'trade' includes any business or profession: Trade Marks Act 1994 s 103(1).

5 Ibid s 3(1)(c) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 3(1)(c)). This provision serves a public interest, which is to ensure that descriptive terms may be freely used by all and cannot be reserved to one undertaking by being registered as trade marks: Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [2000] Ch 523, [1999] ECR I-2779, [1999] ETMR 585, ECJ; Joined Cases C-53/01 and C-55/01 *Re Linde AG* [2003] ECR I-3161, sub nom *Linde AG v Deutsches Patent- und Markenamt* [2003] RPC 803, ECJ; Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ; Case C-191/01P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Wm Wrigley Jr Co* [2003] ECR I-12447, sub nom *Wm Wrigley Jr Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] All ER (EC) 1040, ECJ; Case C-326/01P *Telefon & Buch VerlagsgmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-1371, ECJ; Case C-150/02P *Streamserve Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-1461, ECJ; Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch 1, [2004] ECR I-1619, ECJ; Case C-265/00 *Campina Melkunie BV v Benelux-Merkenbureau* [2004] ECR I-1699, [2004] IP & T 959, ECJ.

A mark must be refused registration under this provision if at least one of its possible meanings designates a characteristic of the goods or services concerned; it is not necessary that the mark actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services; it is sufficient that it could be used for such purposes: Case C-191/01P *Office for Harmonisation in the Internal Market v Wm Wrigley Jr Co* supra; Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* supra. It is not necessary for this provision to apply that the mark should be the only way of designating the characteristics of the goods or services in question; it is irrelevant whether there are other, more usual signs or indications for designating those characteristics: Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* supra; Case C-265/00 *Campina Melkunie BV v Benelux-Merkenbureau* supra. It is also irrelevant whether the characteristics of the goods or services in question are commercially essential or merely ancillary: Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* supra.

It is sufficient for this provision to apply that the mark has a descriptive meaning to specialists whether or not that meaning is known to the general public: Case T-367/02 *Wieland-Werke AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-47, [2005] All ER (D) 29 (Jan), CFI.

As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services, without introducing any unusual variations, in particular as to syntax or meaning, will not result in anything other than a mark which designates characteristics of the goods or services; but such a combination may not be descriptive if it creates an overall impression which is sufficiently far removed from that produced by the elements themselves: Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* supra; Case C-265/00 *Campina Melkunie BV v Benelux-Merkenbureau* supra (BIOMILD); and see also Case C-104/00P *DKV Deutsche Krankenversicherung AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR I-7561, [2002] All ER (D) 100 (Sep), ECJ (COMPANYLINE); Case C-326/01P *Telefon & Buch VerlagsgmbH v Office for Harmonisation in the Internal Market* supra (UNIVERSALTELEFONBUCH); *Streamserve Inc v Office for Harmonisation in the Internal Market* supra (STREAMSERVE); Case C-273/05P *Office of Harmonisation in the Internal Market (Trade Marks and Designs) v Celltech R & D Ltd* [2007] ETMR 52, [2007] All ER (D) 135 (Apr), ECJ (CELLTECH).

If the mark sought to be registered consists exclusively of a descriptive word, registration is precluded by the Trade Marks Act 1994 s 3(1)(c) even though the word is sought to be registered in a stylised script; it is otherwise if the mark includes graphical elements in addition to the word: Case T-32/00 *Messe München GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2000] ECR II-3829, [2001] IP & T 298, CFI; *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822; cf *O2 Holdings Ltd's Trade Mark Applications* (O/127/07), Appointed Person.

A term borrowed from the language of another member state, in which it is descriptive of the goods or services in question, is not precluded from registration by the Trade Marks Act 1994 s 3(1)(c) unless the relevant persons in the United Kingdom are capable of identifying the meaning of the term: Case C-421/04 *Matratzen Concord AG v Hukla Germany SA* [2006] IP & T 483, [2006] ETMR 48, ECJ.

In the case of geographical names, this provision is not confined to prohibiting the registration of geographical names as trade marks where they are already associated with the goods or services concerned in the mind of the relevant class of persons; but it does not preclude the registration of geographical names where the relevant class of persons would be unlikely to believe that such goods or services originated there: Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* supra. Compare Case T-295/01 *Nordmilch eG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-4365, [2003] All ER (D) 244 (Oct), CFI (OLDENBURGER, Oldenburg being the name of two German towns, unregistrable for dairy products) with Case T-379/03 *Peek & Cloppenburg KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 167, [2006] ETMR 33, CFI (CLOPPENBURG, the name of a small German town, registrable for retail services). See also Case T-316/03 *Münchener Rückversicherungs-Gesellschaft AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ETMR 6, [2005] All ER (D) 09 (Jun), CFI (German equivalent of MUNICHFINANCIALSERVICES unregistrable for financial services); Decisions 621C/00207886/1 and 638C/00207866/2 *Think Promotions Ltd v All England Lawn Tennis Club (Wimbledon) Ltd* [2006] ETMR 36, OHIM Cancellation Division (WIMBLEDON registrable for variety of goods and services) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 7(1)(c) (see PARA 211 post)); *Nordic Saunas Ltd's Trade Mark Application* [2002] ETMR 18, Appointed Person (NORDIC unregistrable for goods made of wood, but had acquired distinctiveness for saunas); *Tottenham Hotspur plc's Trade Mark Application* (O/024/03), Appointed Person (TOTTENHAM registrable for wide variety of goods and services).

A collective or certification mark which consists of signs or indications which may designate the geographical origin of goods or services may, however, be registered: see the Trade Marks Act 1994 s 49(2), Sch 1 para 3 (collective marks: see PARA 156 post) and s 50(2), Sch 2 para 3 (certification marks: see PARA 166 post).

In principle there is nothing to prevent the application of this provision to an application to register a three-dimensional trade mark consisting of the shape of the goods: Joined Cases C-53/01 and C-55/01 *Linde AG v Deutsches Patent- und Markenamt* supra. Similarly, in the case of three-dimensional trade marks consisting of packaging of goods which are packaged for reasons relating to the nature of the goods, the packaging may serve to designate characteristics of the goods within the meaning of this provision: Case C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt* [2004] ECR I-1725, ECJ.

In the case of names of performers and other celebrities, the name may designate a characteristic (ie the subject matter) of certain goods (particularly image carriers such as posters and figurines) and thus be unregistrable in respect of such goods by virtue of this provision: *Linkin Park LLC's Trade Mark Application* [2006] ETMR 74, Appointed Person. As to the meaning of 'other characteristics' see *O2 Holdings Ltd's Trade Mark Applications* supra.

6 Trade Marks Act 1994 s 3(1)(d) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 3(1)(d)). This provision is to be interpreted as only precluding registration of a mark where the signs or indications of which the mark is exclusively composed had become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of the

mark is sought at the relevant date; it is immaterial for this purpose whether or not the mark is descriptive and whether or not the mark consists of an advertising slogan, indication of quality or incitement to purchase the goods or services: Case C-517/99 *Merz & Krell GmbH & Co v Deutsches Patent- und Markenamt* [2001] ECR I-6959, [2002] All ER (EC) 441, ECJ. In considering whether the mark has become customary in the current language it appears that the relevant circles principally consist of consumers and end users: Case T-322/03 *Telefon & Buch Verlagsgesellschaft gmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] All ER (D) 231 (Mar), CFI; cf Case C-371/02 *Björnekulla Fruktindustrier AB v Procordia Food AB* [2004] ECR I-5791, [2004] RPC 912, ECJ. Thus the essence of the objection is that the sign is generic either amongst the general public or amongst the trade: *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 77, [2005] IP & T 822; *Stash Ltd's Trade Mark Application* (O/281/04), Appointed Person; and see Case C-192/03 *Alcon Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-8993, ECJ (mark BSS generic in the relevant trade). In assessing the applicability of this objection it is legitimate to take into account materials published outside the relevant territory if these shed light on the position inside that territory: Case C-192/03 *Alcon Inc v Office for Harmonisation in the Internal Market* *supra*.

7 For the meaning of 'the date of application for registration' see PARA 366 note 5 post.

8 For these purposes, references to 'use' (or any particular description of use) of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, include use (or that description of use) otherwise than by means of a graphic representation: Trade Marks Act 1994 s 103(2).

9 *Ibid* s 3(1) proviso (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 3(3)). As to acquiring distinctive character as a result of use see PARA 61 post.

## UPDATE

### 60 Lack of distinctive character

NOTE 5--See also Case T-186/07 *Ashoka v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) [2008] All ER (D) 16 (Jul), CFI.

NOTE 6--See also Case C-102/07 *Adidas AG v Marca Mode CV* [2009] IP & T 279, ECJ.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/61. Distinctive character acquired as a result of use.

## **61. Distinctive character acquired as a result of use.**

A trade mark<sup>1</sup> must not be refused registration on the grounds that it is devoid of distinctive character or descriptive or generic<sup>2</sup> if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use<sup>3</sup> made of it<sup>4</sup>. Similarly, where a trade mark was registered in breach of one of these grounds<sup>5</sup>, it must not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered<sup>6</sup>. It is not necessary to consider whether the mark has acquired a distinctive character, however, unless the applicant or proprietor has invoked the relevant provision<sup>7</sup>.

In either case, what must be shown is that, through use<sup>8</sup>, the trade mark has come to identify the goods or services in respect of which the trade mark is sought to be registered or is registered as originating from a particular undertaking and thus distinguishes the goods or services from those of other undertakings<sup>9</sup>. The competent authority must make an overall assessment of the relevant evidence<sup>10</sup>. Regard must be had to the inherent characteristics of the mark in question, such as whether it contains an element which is descriptive of the goods or services in question<sup>11</sup>; and the following may also be taken into account:

- 92 (1) the market share held by the mark;
- 93 (2) how intensive, geographically widespread and longstanding the use of the mark has been;
- 94 (3) the amount invested by the proprietor in promoting the mark;
- 95 (4) the proportion of the relevant class of persons who, because of the mark, identify the goods or services as emanating from the proprietor;
- 96 (5) evidence from trade and professional associations; and
- 97 (6) (where the competent authority has particular difficulty in assessing the distinctive character) an opinion poll<sup>12</sup>.

If the relevant class of persons, or at least a significant proportion of them, identifies goods or services as originating from a particular undertaking because of the trade mark, it has acquired a distinctive character; however, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist by reference to general, abstract data such as predetermined percentages<sup>13</sup>.

Where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of the goods may be sufficient to give the sign a distinctive character in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with the trader and no other undertaking or believes that goods of that shape come from that trader; however, it is for the competent authority to verify that such circumstances exist on the basis of specific and reliable data and that such identification is as a result of the use of the sign as a trade mark<sup>14</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 The registration is precluded by the Trade Marks Act 1994 s 3(1)(b), (c) or (d) (see PARA 60 ante).

3 For the meaning of 'use' see PARA 60 note 8 ante. In order for the mark to have acquired distinctiveness it must have been used as a trade mark: Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ; C-24/05P *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 946, [2006] All ER (D) 275 (Jun), ECJ. Thus use of a mark as the name of goods (see eg *BACH and BACH FLOWER REMEDIES Trade Marks* [2000] RPC 513, sub nom *Bach Flower Remedies Ltd v Healing Herbs Ltd* [1999] IP & T 146, CA) or as the name of an ingredient of the goods (see eg *JERYL LYNN Trade Mark* [1999] FSR 491) will not result in the mark acquiring distinctive character. The effect of the requirement of use of the mark as a trade mark is unclear where the mark consists of the shape of the goods: see *Betafence Ltd v Registrar of Trade Marks* [2005] EWHC 1353 (Ch), [2005] All ER (D) 346 (Jun). See also note 13 infra.

4 Trade Marks Act 1994 s 3(1) proviso (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(3)); and see PARA 60 ante. This provision does not provide an independent right to have a trade mark registered, but is an exception to the relevant grounds of refusal: Case C-108/05 *Bovemij Verzekeringen NV v Benelux-Merkenbureau* [2007] ETMR 29, [2006] All ER (D) 46 (Sep), ECJ. It is irrelevant that the trade mark may have acquired distinctiveness through use after the application was filed but before it is examined: Case T-247/01 *eCopy Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-5301, (2002) Times, 31 September, CFI.

5 The registration should have been refused under the Trade Marks Act 1994 s 3(1)(b), (c) or (d) (see PARA 60 ante).

6 See *ibid* s 47(1) proviso (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 3(3)); and see PARA 118 post.

7 Case C-136/02P *Mag Instrument Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-9165, [2004] All ER (D) 75 (Oct), ECJ.

8 Such use may be as part of or in conjunction with a registered trade mark: Case C-353/03 *Société des Produits Nestlé SA v Mars UK Ltd* [2005] ECR I-6135, [2006] All ER (EC) 348, ECJ; Case C-24/05P *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 946, [2006] All ER (D) 275 (Jun), ECJ.

9 Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [2000] Ch 523, [1999] ECR I-2779, [1999] ETMR 585, ECJ; Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ. Registration of a trade mark can only be allowed on this basis if it is shown that the trade mark has acquired distinctive character through use throughout the territory of the member state and throughout the linguistic area in which there exists a ground for refusal: Case C-108/05 *Bovemij Verzekeringen NV v Benelux-Merkenbureau* [2007] ETMR 29, [2006] All ER (D) 46 (Sep), ECJ.

10 Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [2000] Ch 523, [1999] ECR I-2779, [1999] ETMR 585, ECJ; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ; Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ; Case C-136/02P *Mag Instrument Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-9165, [2004] All ER (D) 75 (Oct), ECJ. In assessing whether a trade mark has acquired distinctive character all the circumstances in which the relevant public may see that mark must be borne in mind including not only when the decision to purchase is made but also before that point, for example in advertising, and when the product is consumed: C-24/05P *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 946, [2006] All ER (D) 275 (Jun), ECJ.

11 Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [2000] Ch 523, [1999] ECR I-2779, [1999] ETMR 585, ECJ; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ. It follows that not all trade marks are equally lacking in distinctive character; and some will require more use than others before they acquire such character.

12 Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [2000] Ch 523, [1999] ECR I-2779, [1999] ETMR 585, ECJ; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ.

13 Joined Cases C-108/97 and 109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [2000] Ch 523, [1999] ECR I-2779, [1999] ETMR 585, ECJ; Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ.

14 Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ. It appears that the same principle applies to other types of marks: see Case C-24/05P *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 946, [2006] All ER (D) 275 (Jun), ECJ. A two-dimensional depiction of a three-dimensional product on the surface of packaging of that product does not necessarily amount to use as a trade mark for this purpose: Case C-24/05P *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* supra.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/62. Shape.

## 62. Shape.

A sign must not be registered<sup>1</sup> as a trade mark<sup>2</sup> if it consists exclusively of:

- 98 (1) the shape which results from the nature of the goods themselves<sup>3</sup>;
- 99 (2) the shape of goods which is necessary to obtain a technical result<sup>4</sup>; or
- 100 (3) the shape which gives substantial value to the goods<sup>5</sup>.

1 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

2 Trade Marks Act 1994 s 3(2) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(1)(e)). For the meaning of 'trade mark' see PARA 57 ante.

These provisions serve a public interest, which is to ensure that shapes having the specified characteristics may be freely used by all and cannot be reserved to one undertaking by being registered as trade marks: Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ; Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2004] Ch 83, [2003] ECR I-3793, ECJ.

These provisions apply both to marks consisting strictly of the shape of the goods and to marks consisting of graphical representations of the shape of the goods: Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* supra.

A sign which is refused registration by virtue of these provisions cannot constitute a trade mark and cannot acquire a distinctive character by the use made of it: Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* supra; Joined Cases C-53/01 and C-55/01 *Re Linde AG* [2003] ECR I-3161, sub nom *Linde AG v Deutsches Patent- und Markenamt* [2003] RPC 803, ECJ; Case C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt* [2004] ECR I-1725, ECJ. It follows that such an objection cannot be overcome by reliance upon opinion polls and similar evidence: Case R 856/2004-G *Lego Juris A/S v Mega Brands Inc* [2007] ETMR 11, OHIM Enlarged Board of Appeal (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 7(1)(e) (see PARA 212 post)).

3 Trade Marks Act 1994 s 3(2)(a). 'Goods' refers to the goods in respect of which the trade mark is sought to be registered, and 'the nature of the goods' refers to their innate characteristics, for example the shape of a banana for bananas: *Philips Electronics BV v Remington Consumer Products Ltd* [1999] RPC 809 at 820, [1999] All ER (D) 465, CA, per Aldous LJ; referred to ECJ sub nom C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ. Thus the shape of a three-headed electric razor is not precluded from registration by this provision (*Philips Electronics BV v Remington Consumer Products Ltd* supra), nor is the shape of an indented bar of soap (Case T-122/99 *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2000] ECR II-265, [2000] 2 CMLR 303, CFI).

4 Trade Marks Act 1994 s 3(2)(b). This provision must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable if it is established that the essential features of that shape are attributable only to the technical result; but this ground for refusal cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained: Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ; Case C-321/03 *Dyson Ltd v Registrar of Trade Marks* [2007] ETMR 34 at [76]-[102], [2007] All ER (D) 201 (Jan) at [76]-[102] per Léger AG. When assessing whether registration is precluded by this provision, the first step is to identify the essential characteristics or features of the shape of the goods judged by the impact on the eye of the average consumer; once they have been determined the second step is to determine whether the essential characteristics or features consisting solely of the shape of the goods are attributable only to the technical result: *Koninklijke Philips NV v Remington Consumer Products Ltd* [2006] EWCA Civ 16, [2007] IP & T 206, [2006] FSR 537. The fact that the shape was or is protected by a patent is not by itself a bar to the shape being registered as a trade mark, but it is strong evidence that the shape is functional: Case R 856/2004-G *Lego Juris A/S v Mega Brands Inc* [2007] ETMR 11, OHIM Enlarged Board of Appeal (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 7(1)(e)(ii)



(see PARA 212 post)). If the shape presented for registration is sufficiently stylised that the shape as a whole does not consist essentially of features attributable only to the technical result of using that shape, it is not precluded from registration by this provision: *Ekornes SA's Request for Protection* (O/017/06), Appointed Person.

5 Trade Marks Act 1994 s 3(2)(c). This provision excludes from registration shapes which add substantial value to the goods over other shapes, in the sense that they appeal to the eye: see *Philips Electronics BV v Remington Consumer Products Ltd* [1999] RPC 809 at 822, [1999] All ER (D) 465, CA, per Aldous LJ; referred to ECJ sub nom C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ. See also *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] RPC 304, Trade Marks Registry; considered but not ruled upon on appeal [1999] RPC 890 at 903, [1999] All ER (D) 729 per Lloyd J.

## **UPDATE**

### **62 Shape**

NOTE 4--See Case T-270/06 *Lego Juris A/S v Office of Harmonisation in the Internal Market (Trade Marks and Designs)* [2009] IP & T 383, CFI (registration of sign as trade mark was invalid as it consisted exclusively of shape of goods which was necessary to obtain technical result).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/63. Public policy; immoral trade marks.

### 63. Public policy; immoral trade marks.

A trade mark<sup>1</sup> must not be registered<sup>2</sup> if it is contrary to public policy<sup>3</sup> or to accepted principles of morality<sup>4</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

3 'Public policy' is a translation of the French expression 'ordre public': *Philips Electronics BV v Remington Consumer Products Ltd* [1998] RPC 283 at 310 per Jacob J (affd on other grounds [1999] RPC 809, [1999] All ER (D) 465, CA; referred to ECJ sub nom C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ); *FCUK Trade Mark* [2007] RPC 1, [2007] ETMR 8, Appointed Person. The concept of 'ordre public' covers the protection of public security, the physical integrity of individuals as part of society and the protection of the environment: Case T-356/93 *PLANT GENETIC SYSTEMS/Glutamine synthetase inhibitors* [1995] EPOR 357, EPO Board of Appeal.

4 Trade Marks Act 1994 s 3(3)(a) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(1)(f)). The applicability of this provision depends on the intrinsic qualities of the trade mark itself and not on circumstances relating to the conduct of the applicant: Case T-224/01 *Durferriit GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-1589, [2003] All ER (D) 136 (Apr), CFI; Case T-140/02 *Sportwetten GmbH Gera v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ETMR 15, [2005] All ER (D) 72 (Sep), CFI (in so far as they are relevant both cases were decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 7(1)(f) (see PARA 213 post)). This provision should be interpreted and applied consistently with the Convention for the Protection of Human Rights and Fundamental Freedoms (Rome, 4 November 1950; TS 71 (1953); Cmd 8969) art 10 (ie the right to freedom of expression, which is now incorporated into United Kingdom law in the Human Rights Act 1998 s 1(3), Sch 1 art 10) (see CONSTITUTIONAL LAW AND HUMAN RIGHTS vol 8(2) (Reissue) PARAS 158-159); it follows that registration should only be refused where this is justified by a pressing social need and is proportionate to the legitimate aim pursued: *Basic Trademark SA's Trade Mark Application* [2005] RPC 611, Appointed Person; Case R 495/2005-G *Kenneth's Application* [2007] ETMR 7, OHIM Enlarged Board of Appeal.

Marks which appear to glorify terrorism or offend the victims of terrorism will be refused under the first limb of this provision: Cases R 176/2004-2 and R 177/2004-2 *Falcon Sporting Goods AG's Application* (29 September 2004, unreported), OHIM Board of Appeal (BIN LADIN refused); Case R 495/2005-G *Kenneth's Application* supra.

For the second limb of this provision to apply, use of the mark must contravene a generally accepted moral principle: *Ghazilian's Trade Mark Application* [2002] RPC 628, [2002] ETMR 631, Appointed Person; *FCUK Trade Mark* [2007] RPC 1, [2007] ETMR 8, Appointed Person. Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough for this provision to apply; but it does apply if use of the mark would justifiably cause outrage, or would be the subject of justifiable censure, amongst an identifiable section of the public as being likely to undermine significantly current religious, family or social values: *Ghazilian's Trade Mark Application* supra; *Scranage's Trade Mark Application* (O/182/05), Appointed Person; *FCUK Trade Mark* supra. In considering whether the mark is offensive the nature of the goods is relevant since it affects the context in which the mark is likely to be encountered: Case R 495/2005-G *Kenneth's Application* supra (SCREW YOU acceptable for condoms and goods sold in sex shops but not for goods sold more widely). The slang meaning of a word may lead to an objection even if its normal meaning does not: Case R 111/2002-4 *Dick Lexic's Application* [2005] ETMR 99, OHIM Board of Appeal (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 7(1)(f) (see PARA 213 post)). On the other hand a word which happens to be offensive in another Community language will not be objectionable if it is evident that this is inadvertent: Case R 558/2006-2 *Reva Electric Car Co (PVT) Ltd's Application* (18 July 2006, unreported), OHIM Board of Appeal (REVA offensive in Finnish but accompanying words THE ELECTRICITY CAR made it clear that this was accidental) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 7(1)(f) (see PARA 213 post)).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/64. Deceptive trade marks.

#### 64. Deceptive trade marks.

A trade mark<sup>1</sup> must not be registered<sup>2</sup> if it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service<sup>3</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

3 Trade Marks Act 1994 s 3(3)(b) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(1)(g)). This provision is concerned with deceptiveness which is inherent in the trade mark itself, as opposed to deception caused by the similarity of the trade mark to another trade mark (which may give rise to a relative ground of refusal: see PARA 70 et seq post): see eg Case R-468/1999 *International Star Registry of Illinois Ltd's Application* (OJ OHIM 6/02, p 1185), OHIM Board of Appeal (INTERNATIONAL STAR REGISTRY likely to mislead consumers into believing that the organisation which used it was an authoritative body empowered to give names to stars) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 7(1)(g) (see PARA 214 post)). In some cases a mark may be excluded from registration partly under this provision and partly for lack of distinctiveness: see eg Case R 246/1999-1 *Enotria Holdings Ltd's Application* (27 March 2000, unreported), OHIM Board of Appeal (ARCADIA descriptive for wine produced in Greece, deceptive for wine produced in Italy) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 7(1)(g) (see PARA 214 post)); Decision 75C/000835728/1 *Beiersdorf AG's Trade Mark Application, Application for Cancellation by L'Oréal SA* [2001] ETMR 19, OHIM Cancellation Division (POUDRE LIBRE NATURELLE descriptive for cosmetics which were loose powders, deceptive for those which were not) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 7(1)(g) (see PARA 214 post)).

For registration to be refused there must be actual deceit or a serious risk that the consumer will be deceived: Case C-87/97 *Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co KG and Eduard Bracharz GmbH* [1999] ECR I-1301, [1999] 1 CMLR 1203, ECJ; Case C-259/04 *Emanuel v Continental Shelf 128 Ltd* [2006] IP & T 887, sub nom *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* [2006] ETMR 56, ECJ. A trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark may not, by reason of that feature alone, be refused registration on this ground even where the goodwill associated with that trade mark has been assigned, together with the business making the goods to which the mark relates, to another person: Case C-259/04 *Emanuel v Continental Shelf 128 Ltd* supra.

The fact that a trade description is a trade mark, or part of a trade mark, does not prevent it from being a false trade description when applied to any goods, except when certain conditions are satisfied: see the Trade Descriptions Act 1968 s 34 (as amended); and SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 488.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/65. Illegal trade marks.

## **65. Illegal trade marks.**

A trade mark<sup>1</sup> must not be registered<sup>2</sup> if or to the extent that its use<sup>3</sup> is prohibited in the United Kingdom<sup>4</sup> by any enactment or rule of law or by any provision of Community law<sup>5</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

3 For the meaning of 'use' see PARA 60 note 8 ante.

4 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

5 Trade Marks Act 1994 s 3(4) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(2)(a), which makes it clear that the provision is concerned with laws other than trade mark laws). A trade mark application must be refused under this provision if use of the mark would contravene EC Council Regulation 1493/99 (OJ L179, 14.7.99, p 1) on the common organisation of the market in wine (see PARA 302 note 2 post): *MEZZACORONA Trade Mark* [2003] EWCA Civ 1861, [2004] RPC 537, sub nom *Miguel Torres SA v Cantine Mezzacorona SCARL* [2003] All ER (D) 407 (Dec) (held on the facts that there was no contravention).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/66. Specially protected emblems.

## **66. Specially protected emblems.**

A trade mark<sup>1</sup> which consists of or contains:

- 101 (1) the royal arms<sup>2</sup>, or any of the principal armorial bearings of the royal arms, or any insignia or device so nearly resembling the royal arms or any such armorial bearing as to be likely to be mistaken for them or it<sup>3</sup>;
- 102 (2) a representation of the royal crown or any of the royal flags<sup>4</sup>;
- 103 (3) a representation of Her Majesty or any member of the royal family, or any colourable imitation thereof<sup>5</sup>; or
- 104 (4) words, letters or devices likely to lead persons to think that the applicant either has or recently has had royal patronage or authorisation<sup>6</sup>,

must not be registered<sup>7</sup> unless it appears to the registrar<sup>8</sup> that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the royal family<sup>9</sup>.

A trade mark which consists of or contains a representation of:

- 105 (a) the national flag of the United Kingdom (commonly known as the Union Jack)<sup>10</sup>; or
- 106 (b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man<sup>11</sup>,

must not be registered if it appears to the registrar that the use of the trade mark<sup>12</sup> would be misleading or grossly offensive<sup>13</sup>.

A trade mark must not be registered in the case of national emblems etc of Convention countries<sup>14</sup> or emblems etc<sup>15</sup> of certain international organisations<sup>16</sup>.

Where a representation of:

- 107 (i) any arms to which a person is entitled by virtue of a grant of arms by the Crown<sup>17</sup>; or
- 108 (ii) any insignia so nearly resembling such arms as to be likely to be mistaken for them<sup>18</sup>,

appears on a mark, the registrar must refuse to accept an application for the registration of the mark unless he is satisfied that the consent of the person entitled to the arms has been obtained<sup>19</sup>. Where such a mark is registered, nothing in the Trade Marks Act 1994 is to be construed as authorising its use in any way contrary to the laws of arms<sup>20</sup>.

A trade mark which consists of or contains a controlled representation within the meaning of the Olympic Symbol etc (Protection) Act 1995<sup>21</sup> must not be registered unless it appears to the registrar that the application is made by the proprietor of the Olympics association right<sup>22</sup>, or that consent has been given by or on behalf of the proprietor<sup>23</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 As to the royal arms see CROWN AND ROYAL FAMILY vol 12(1) (Reissue) PARAS 43-44; and as to the offence of unauthorised use of royal arms see PARA 488 post.

3 Trade Marks Act 1994 s 4(1)(a).

4 Ibid s 4(1)(b).

5 Ibid s 4(1)(c).

6 Ibid s 4(1)(d). In *QUEEN DIANA Trade Mark* [1991] RPC 395, Board of Trade, it was held that the mark was not caught by the corresponding rule made under the Trade Marks Act 1938 because there was no Queen Diana. The fact that a mark fell within the spirit of the rule was not sufficient to confer discretion to refuse to register.

7 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international application, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

8 As to the registrar see PARA 17 ante.

9 Trade Marks Act 1994 ss 3(5), 4(1). Sections 3(5), 4 derive from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(2)(c).

10 Trade Marks Act 1994 s 4(2)(a).

11 Ibid s 4(2)(b).

12 For the meaning of 'use' see PARA 60 note 8 ante.

13 Trade Marks Act 1994 ss 3(5), 4(2). See also note 9 supra. Provision may be made by rules identifying the flags to which s 4(2)(b) (see head (b) in the text) applies: ss 3(5), 4(2). At the date at which this title states the law no such rules had been made.

As to appeals against any decision of the registrar see ss 76, 77 (both as amended); and PARA 405 et seq post.

14 Ie the cases specified in ibid s 57 (as amended): see PARA 67 post. For the meaning of 'Convention country' see PARA 6 note 2 ante.

15 Ie the cases specified in ibid s 58 (as amended): see PARA 68 post.

16 Ibid ss 3(5), 4(3). See also note 9 supra.

17 Ibid s 4(4)(a).

18 Ibid s 4(4)(b).

19 Ibid ss 3(5), 4(4); Trade Marks Rules 2000, SI 2000/136, r 9. See also note 9 supra.

20 Trade Marks Act 1994 ss 3(5), 4(4). See also note 9 supra. As to the law of arms see PEERAGES AND DIGNITIES vol 79 (2008) PARA 870 et seq.

21 See PARA 493 post.

22 Ie the person for the time being appointed under the Olympic Symbol etc (Protection) Act 1995 s 1(2): see PARA 492 post. As to the Olympics association right see PARA 492 et seq post.

23 Trade Marks Act 1994 ss 3(5), 4(5) (s 4(5) added by the Olympic Symbol etc (Protection) Act 1995 s 13(2)). This provision has effect in relation to applications for registration made on or after 20 September 1995 (ie the date of commencement of the Olympic Symbol etc (Protection) Act 1995: s 13(3); Olympic Symbol etc (Protection) Act 1995 (Commencement) Order 1995, SI 1995/2472). See *Olympic Oils Ltd's Trade Mark Application* (O/081/00), Trade Marks Registry, where an application to register the word OLYMPIC alone and in combination with an Olympic torch device for oils and fats was refused on this ground.

## UPDATE

### 66 Specially protected emblems

NOTE 19--SI 2000/136 r 9 now Trade Marks Rules 2008, SI 2008/1797, r 10.





Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/67. National emblems etc of Convention countries.

## **67. National emblems etc of Convention countries.**

A trade mark<sup>1</sup> which:

- 109 (1) consists of or contains the flag of a Convention country<sup>2</sup> must not be registered<sup>3</sup> without the authorisation of the competent authorities of that country, unless it appears to the registrar<sup>4</sup> that use of the flag in the manner proposed is permitted without such authorisation<sup>5</sup>;
- 110 (2) consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention or the WTO Agreement<sup>6</sup> must not be registered without the authorisation of the competent authorities of that country<sup>7</sup>;
- 111 (3) consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty must not, where the sign or hallmark is protected under the Paris Convention or the WTO Agreement, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned<sup>8</sup>.

The above provisions as to national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark<sup>9</sup>.

Nothing in the above provisions prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official or hallmark, of that country, notwithstanding that it is similar to that of another country<sup>10</sup>.

For the above purposes, state emblems of a Convention country, other than the national flag, and official signs or hallmarks, are regarded as protected under the Paris Convention only if, or to the extent that<sup>11</sup>:

- 112 (a) the country in question has notified<sup>12</sup> the United Kingdom<sup>13</sup> that it desires to protect that emblem, sign or hallmark<sup>14</sup>;
- 113 (b) the notification remains in force<sup>15</sup>; and
- 114 (c) the United Kingdom has not objected to it<sup>16</sup> or any such objection has been withdrawn<sup>17</sup>.

Such notification has effect only in relation to applications for registration made more than two months after the receipt of the notification<sup>18</sup>. The registrar must keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of the state emblems and official signs or hallmarks which are for the time being so protected<sup>19</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'Convention country' see PARA 6 note 2 ante.

3 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

4 As to the registrar see PARA 17 ante.

5 Trade Marks Act 1994 s 57(1). Sections 57, 59 derive from the Paris Convention art 6(ter) and EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(1)(h). As to the competent authorities' power to obtain an injunction restraining the use of the mark in the United Kingdom without their authorisation see the Trade Marks Act 1994 s 57(6); and PARA 490 post. As to the Paris Convention see PARA 6 ante.

6 For the meaning of 'the WTO Agreement' see PARA 7 note 1 ante.

7 Trade Marks Act 1994 s 57(2) (s 57(2), (3) amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(5)). See also note 5 supra.

8 Trade Marks Act 1994 s 57(3) (as amended: see note 7 supra). See also note 5 supra.

9 Ibid s 57(4). See also note 5 supra. When making a comparison 'from a heraldic point of view' regard must be had to the heraldic description and not to any more detailed description: Case T-127/02 *Concept-Anlagen u Geräte nach 'GMP' für Produktion u Labour GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-1113, [2004] All ER (D) 175 (Apr), CFI (mark resembling emblem of Council of Europe with addition of letters ECA refused registration) (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 7(1)(h) (see PARA 216 post)).

10 Trade Marks Act 1994 s 57(5). See also note 5 supra.

11 Ibid s 59(1). See also note 5 supra.

12 Ie in accordance with the Paris Convention art 6(ter)(3) as applied by the WTO Agreement.

13 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

14 Trade Marks Act 1994 s 59(1)(a).

15 Ibid s 59(1)(b).

16 Ie in accordance with the Paris Convention art 6(ter)(4) as applied by the WTO Agreement: Trade Marks Act 1994 s 59(5) (added by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(7)).

17 Trade Marks Act 1994 s 59(1)(c).

18 Ibid s 59(3). See also note 5 supra.

19 Ibid s 59(4). See also note 5 supra.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/68. Emblems etc of certain international organisations.

## **68. Emblems etc of certain international organisations.**

The following provisions apply to:

- 115 (1) the armorial bearings, flags or other emblems; and
- 116 (2) the abbreviations and names,

of international intergovernmental organisations of which one or more Convention countries<sup>1</sup> are members<sup>2</sup>.

A trade mark<sup>3</sup> which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention or the WTO Agreement<sup>4</sup> must not be registered<sup>5</sup> without the authorisation of the international organisation concerned, unless it appears to the registrar<sup>6</sup> that the use of the emblem, abbreviation or name in the manner proposed: (a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation<sup>7</sup>.

The above provisions as to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates any such emblem<sup>8</sup>.

Nothing in the above provisions affects the rights of a person whose bona fide use<sup>9</sup> of the trade mark in question began before 4 January 1962, when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom<sup>10</sup>.

For the above purposes, the emblems, abbreviations and names of an international organisation are regarded as protected under the Paris Convention only if, or to the extent that<sup>11</sup>:

- 117 (i) the organisation in question has notified<sup>12</sup> the United Kingdom that it desires to protect that emblem, abbreviation or name<sup>13</sup>;
- 118 (ii) the notification remains in force<sup>14</sup>; and
- 119 (iii) the United Kingdom has not objected to it<sup>15</sup> or any such objection has been withdrawn<sup>16</sup>.

Such notification has effect only in relation to applications for registration made more than two months after the receipt of the notification<sup>17</sup>. The registrar must keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of the emblems, abbreviations and names of international organisations which are for the time being so protected<sup>18</sup>.

1 For the meaning of 'Convention country' see PARA 6 note 2 ante.

2 Trade Marks Act 1994 s 58(1). Sections 58, 59 derive from the Paris Convention art 6(ter) and EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(1)(h). As to an international organisation's power to obtain an injunction restraining the use of the mark in the United Kingdom without its authorisation see the Trade Marks Act 1994 s 58(4); and PARA 491 post. As to the Paris Convention see PARA 6 ante.

- 3 For the meaning of 'trade mark' see PARA 57 ante.
- 4 For the meaning of 'the WTO Agreement' see PARA 7 note 1 ante.
- 5 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.
- 6 As to the registrar see PARA 17 ante.
- 7 Trade Marks Act 1994 s 58(2) (amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(6)). See also note 2 supra.
- 8 Trade Marks Act 1994 s 58(3). See also note 2 supra. As to the meaning of 'from a heraldic point of view' see PARA 67 note 10 ante.
- 9 For the meaning of 'use' see PARA 60 note 8 ante.
- 10 Trade Marks Act 1994 s 58(5). See also note 2 supra. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.
- 11 Ibid s 59(2). See also note 2 supra.
- 12 Ie in accordance with the Paris Convention art 6(ter)(3) as applied by the WTO Agreement: Trade Marks Act 1994 s 59(5) (added by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(7)).
- 13 Trade Marks Act 1994 s 59(2)(a).
- 14 Ibid s 59(2)(b).
- 15 Ie in accordance with the Paris Convention art 6(ter)(4) as applied by the WTO Agreement (see note 12 supra).
- 16 Trade Marks Act 1994 s 59(2)(c).
- 17 Ibid s 59(3). See also note 2 supra.
- 18 Ibid s 59(4). See also note 2 supra.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(ii) Absolute Grounds for Refusal of Registration/69. Bad faith.

## 69. Bad faith.

A trade mark<sup>1</sup> must not be registered<sup>2</sup> if or to the extent that the application is made in bad faith<sup>3</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international application, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

3 Trade Marks Act 1994 s 3(6) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 3(2)(d)). Bad faith includes dishonesty and dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined: *Gromax Plasticulture Ltd v Dow & Low Nonwovens Ltd* [1999] RPC 367; Decision 466C/000659037/1 *DAAWAT Trade Mark* (28 June 2004, unreported), OHIM Cancellation Division (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 51(1)(b) (see PARA 243 post)). Many of the reported cases involve applications to register a third party's trade mark, while others concern the intention of the applicant to use the trade mark either at all or for all the goods or services applied for; but it is clear that this provision is not limited to such cases. Thus it is bad faith to register a trade mark dishonestly in order to block use of a 'trend term' by competitors: Decision 85C/000703579/1 *Gillette Co's Trade Mark* [2002] ETMR 65, OHIM Cancellation Division (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 51(1)(b) (see PARA 243 post)).

Bad faith is to be judged according to the combined test of dishonesty for accessory liability for breach of trust: *Harrison v Teton Valley Trading Co Ltd* [2004] EWCA Civ 1028, [2004] 1 WLR 2577, (2004) Times, 19 August. The combined test was re-stated in *Barlow Clowes International Ltd v Eurotrust International Ltd* [2005] UKPC 37, [2006] 1 All ER 333, [2006] 1 WLR 1476. Accordingly, in applying the combined test, it is necessary to show that the applicant had knowledge of the relevant circumstances, but it is not necessary to show that the applicant knew that his behaviour fell below generally accepted standards: *Ajit WEEKLY Trade Mark* [2006] RPC 633, Appointed Person.

An applicant who does not have a bona fide intention to use the trade mark cannot honestly sign the declaration with regard to use required by the Trade Marks Act 1994 s 32(3) (see PARA 363 post); accordingly, 'bad faith' covers the case where a mark is applied for by an applicant who at the time had no intention of using the mark: *DEMON ALE Trade Mark* [2000] RPC 345, Appointed Person; *Ferrero SpA's Trade Marks* [2004] RPC 583, Appointed Person; cf *LABORATOIRE DE LA MER Trade Marks* [2002] FSR 790; but see *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293, (2001) Times, 28 February; *South Cone Inc v Bessant (t/a Reef)* [2002] EWCA Civ 763, sub nom *REEF Trade Mark* [2003] RPC 101. To constitute bad faith, however, it is not enough for the applicant to have made a statement of intention to use the mark applied for that turns out to have been incorrect; it must be shown that the applicant knowingly made a false statement (or possibly made a statement with regardless disregard for whether it was true or false): *Robert McBride Ltd's Trade Mark Application* [2005] ETMR 85, Appointed Person.

By contrast, a lack of any intention to use a Community trade mark applied for does not amount to bad faith under the equivalent provisions in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 51(1)(b) (see PARA 243 post): see Decision 34C/000053447/1 *Trillium Digital Systems Inc's Trade Mark* [2000] ETMR 1054, OHIM Cancellation Division; Decision 468C/00512632/1 *POTTERY BARN Trade Mark* [2005] ETMR 74, OHIM Cancellation Division; Decision 813C/001628395/1 *NAKED Trade Mark* (14 December 2004, unreported), OHIM Cancellation Division; and PARA 243 note 6 post. It is arguable that EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) does not permit the United Kingdom authorities to require the applicant to verify his intention to use the mark in relation to the full width of the specification of goods or services set out in the application form: *Knoll AG's Trade Mark* [2002] EWHC 899 (Ch), [2003] RPC 175, [2002] All ER (D) 133 (May); and see also *Road Tech Computer Systems Ltd v Unison Software (UK) Ltd* [1996] FSR 805, IP & T Digest 22.

The relevant date for assessing bad faith is the date the application for registration of a trade mark is filed, not a later date: *HOTPICKS Trade Mark* [2004] EWHC 689 (Ch), [2004] RPC 834. An allegation of bad faith should be

clearly pleaded and proved, and should not be left to be inferred from the facts (*ROYAL ENFIELD Trade Marks* [2002] RPC 508, Appointed Person) but, if clearly pleaded and supported by indirect evidence, such an allegation does not have to be supported by direct evidence (see *Ferrero SpA's Trade Marks* supra; *BRUTT Trade Mark* [2007] RPC 462, Appointed Person).

## **UPDATE**

### **69 Bad faith**

NOTE 3--As to the criteria to be taken into consideration in order to determine bad faith see Case C-529/07 *Chocoladefabriken Lindt & Sprungli AG v Franz Hauswirth GmbH* [2009] All ER (D) 114 (Jun), ECJ.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/70. Meaning of 'earlier trade mark'.

### **(iii) Relative Grounds for Refusal of Registration**

#### **70. Meaning of 'earlier trade mark'.**

Many of the relative grounds for refusal of registration<sup>1</sup> depend upon the existence of an earlier trade mark<sup>2</sup>. An 'earlier trade mark' is:

- 120 (1) a registered trade mark<sup>3</sup>, international trade mark (UK)<sup>4</sup>, Community trade mark<sup>5</sup> or international trade mark (EC)<sup>6</sup> which has a date of application for registration<sup>7</sup> earlier than that of the trade mark in question, taking account (where appropriate) of the priorities<sup>8</sup> claimed in respect of the trade marks<sup>9</sup>;
- 121 (2) a Community trade mark or international trade mark (EC) which has a valid claim to seniority<sup>10</sup> from an earlier registered trade mark or international trade mark (UK)<sup>11</sup>;
- 122 (3) a registered trade mark or international mark (UK) which has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within head (2) above from an earlier trade mark, and accordingly has the same claim to seniority<sup>12</sup>; or
- 123 (4) a trade mark which, at the date of application for registration of the trade mark in question or, where appropriate, of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO Agreement<sup>13</sup> as a well known trade mark<sup>14</sup>.

References to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of head (1) or head (2) above, subject to its being so registered<sup>15</sup>.

A trade mark within head (1) or head (2) above whose registration expires<sup>16</sup> continues to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar<sup>17</sup> is satisfied that there was no bona fide use<sup>18</sup> of the mark during the two years immediately preceding the expiry<sup>19</sup>.

<sup>1</sup> As to the meaning of 'relative grounds for refusal' see PARA 55 ante. As to the relative grounds of refusal see PARA 71 et seq post.

<sup>2</sup> The definition of 'earlier trade mark' in the Trade Marks Act 1994 s 6 (as amended) (see the text and notes 3-19 infra) is derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 4(2).

<sup>3</sup> As to the meaning of 'registered trade mark' see PARA 127 post.

<sup>4</sup> For the meaning of 'international trade mark (UK)' see PARA 8 note 17 ante.

<sup>5</sup> For the meaning of 'Community trade mark' see PARA 206 post.

<sup>6</sup> For the meaning of 'international trade mark (EC)' see PARA 8 note 17 ante.

<sup>7</sup> For the meaning of 'the date of application for registration' in relation to a United Kingdom registered mark see PARA 366 note 5 post. In relation to an international trade mark, this is presumably the date of the

international registration or, if later, the date when a request for extension of protection to the United Kingdom was made: see PARAS 21 ante, 366 post.

8 As to claims to priority for registered trade marks of Convention applications and other relevant overseas applications see the Trade Marks Act 1994 ss 35, 36; and PARAS 378-379 post. As to claims to priority for Community trade marks of Convention applications and other relevant overseas applications see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 29-31, 33 (art 29 as amended); and PARA 284 et seq post.

9 Trade Marks Act 1994 s 6(1)(a) (amended by the Trade Marks (International Regulations Designating the European Community etc) Regulations 2004, SI 2004/2332, regs 2, 4(a)).

10 As to seniority see PARAS 287-288 post.

11 Trade Marks Act 1994 s 6(1)(b) (substituted by the Trade Marks (International Regulations Designating the European Community etc) Regulations 2004, SI 2004/2332, regs 2, 4(b)).

12 Trade Marks Act 1994 s 6(1)(ba) (added by the Trade Marks (International Regulations Designating the European Community etc) Regulations 2004, SI 2004/2332, regs 2, 4(b)).

13 For the meaning of 'well known trade mark entitled to protection under the Paris Convention or the WTO Agreement' see PARA 153 post. As to the Paris Convention see PARA 6 ante. For the meaning of the 'WTO Agreement' see PARA 7 note 1 ante.

14 Trade Marks Act 1994 s 6(1)(c) (amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(1)). The Trade Marks Act 1994 s 6(1)(c) (as amended) does not accurately reflect EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 4(2)(d): see *Le Mans Autoparts Ltd's Trade Mark Application* (O/012/05), Appointed Person.

15 Trade Marks Act 1994 s 6(2).

16 As to the duration of a registered trade mark see PARA 29 ante.

17 As to the registrar see PARA 17 ante.

18 For the meaning of 'use' see PARA 60 note 8 ante. As to the revocation of the registration of a trade mark by reason of non-use see the Trade Marks Act 1994 s 46; and PARA 114 et seq post.

19 Ibid s 6(3). Where, however, a trade mark which was on the register at the date of application has subsequently expired and can no longer be restored, it ceases to be an earlier trade mark (*TRANSPAY Trade Mark*[2001] RPC 191, Trade Marks Registry); and cf the position under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 8 (as amended) (see PARA 218 note 10 post). As to appeals from decisions of the registrar, including acts of the registrar in exercise of a discretion, see ss 76, 77 (both as amended); and PARA 405 et seq post.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/71. Identical earlier mark for identical goods or services.

## **71. Identical earlier mark for identical goods or services.**

A trade mark<sup>1</sup> must not be registered<sup>2</sup> if it is identical<sup>3</sup> with an earlier trade mark<sup>4</sup> and the goods or services in relation to which the trade mark is applied for are identical<sup>5</sup> with the goods or services for which the earlier trade mark is protected<sup>6</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

3 A trade mark is 'identical' with an earlier trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer: Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799, [2003] IP & T 994, ECJ; and see *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049 (these two cases refer to infringement (see PARA 86 post), but the discussions of 'identical' trade marks are applicable for these purposes). See also *International Business Machines Corp v Web-Sphere Ltd* [2004] EWHC 529 (Ch), [2004] All ER (D) 328 (Mar), sub nom *WEBSPIHERE Trade Mark* [2004] FSR 39, (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 9(1)(a) (see PARA 226 post)). Note that it is important to be clear as to the nature of the earlier trade mark: eg, if it is a word mark, then it will be identical to the same word presented in a particular script; but if it is a stylised word mark, then it may or may not be identical to the same word presented in a different script.

4 For the meaning of 'earlier trade mark' see PARA 70 ante.

5 There are 'identical' goods or services if the respective specifications overlap; there is no need for the specifications to co-extend: *GALILEO Trade Mark* [2005] RPC 569, Appointed Person (this case refers to infringement (see PARA 86 post), but the discussion of 'identical' goods and services is applicable for these purposes). If parts of the respective specifications overlap and parts do not, then this ground of refusal applies to the parts that overlap. Whether goods or services are 'identical' may depend on the construction of the specification; and in the case of services this involves identifying the core activity covered by the term used: *Avnet Ltd v Isoact Ltd* [1998] FSR 16 (provision of facility for customer to advertise on customer's own webpage not 'advertising and promotional services') (this case refers to infringement (see PARA 86 post), but the discussion of 'identical' goods and services is applicable for these purposes); *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049 (employment website did not provide 'employment agency services') (this case refers to infringement (see PARA 86 post), but the discussion of 'identical' goods and services is applicable for these purposes); and see also *Associated Newspapers Ltd v Express Newspapers* [2003] EWHC 1322 (Ch), [2003] FSR 51, [2004] IP & T 379 (free newspapers not identical to 'newspapers for sale in England and Wales' since not sold) (this case refers to infringement (see PARA 86 post), but the discussion of 'identical' goods and services is applicable for these purposes). The specification is to be construed as at the date of application: *Reed Executive plc v Reed Business Information Ltd* supra.

6 Trade Marks Act 1994 s 5(1) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks art 4(1)(a)). Cf the corresponding infringement provision: see the Trade Marks Act 1994 s 10(1); and PARA 86 post. As to the position where the proprietor of the earlier trade mark consents to the registration see s 5(5); and PARA 78 post.

## **UPDATE**

## **71 Identical earlier mark for identical goods or services**

NOTE 3--See also *Kitfix Swallow Group Ltd v Great Gizmos Ltd* [2008] EWHC 2723 (Ch), [2008] All ER (D) 133 (Dec) ('sequin art' product).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/72. Identical earlier mark and similar goods or services; similar earlier mark and identical or similar goods or services.

**72. Identical earlier mark and similar goods or services; similar earlier mark and identical or similar goods or services.**

A trade mark<sup>1</sup> must not be registered<sup>2</sup> if, because:

- 124 (1) it is identical<sup>3</sup> with an earlier trade mark<sup>4</sup> and is to be registered for goods or services similar<sup>5</sup> to those for which the earlier trade mark is protected<sup>6</sup>; or
- 125 (2) it is similar<sup>7</sup> to an earlier trade mark and is to be registered for goods or services identical<sup>8</sup> with or similar to those for which the earlier trade mark is protected<sup>9</sup>,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark<sup>10</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international application, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

3 For the meaning of 'identical' in this context see PARA 71 note 3 ante.

4 For the meaning of 'earlier trade mark' see PARA 70 ante.

5 For the meaning of 'similar goods or services' see PARA 73 post.

6 Trade Marks Act 1994 s 5(2)(a).

7 There may be visual, aural and/or conceptual similarities between marks: see PARA 74 note 14 post. As to whether a threshold level of similarity is required see PARA 74 note 3 post.

8 For the meaning of 'identical' in this context see PARA 71 note 5 ante.

9 Trade Marks Act 1994 s 5(2)(b). It has been held that evidence of parallel trading in the same market is a highly important factor when determining likelihood of confusion under s 5(2)(b): see *Lunan Group Ltd v Edwin Co Ltd* [2006] EWHC 3284 (Ch), [2006] All ER (D) 214 (Dec).

10 Trade Marks Act 1994 s 5(2) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 4(1)(b)). As to the likelihood of confusion see PARA 74 post; and as to the position where the proprietor of the earlier trade mark consents to the registration see the Trade Marks Act 1994 s 5(5); and PARA 78 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/73. Meaning of 'similar goods and services'.

### 73. Meaning of 'similar goods and services'.

The expression 'similar goods and services' is not defined<sup>1</sup>; the expression is not only important to refusal on one of the statutory relative grounds<sup>2</sup> but also to the statutory definition of infringement<sup>3</sup>. The purpose of the concept is to prevent marks from conflicting not only for the umbra of their respective actual goods or services, but for a penumbra also<sup>4</sup>. In some cases goods can be 'similar to' services.

In considering whether or not there is similarity, all factors relating to the goods or services must be taken into account<sup>5</sup>. These factors include: (1) the respective uses of the goods or services; (2) the respective users of the goods or services; (3) the physical nature of the goods or acts of service; (4) the respective trade channels through which the goods or services reach the market; (5) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets, and in particular whether they are, or are likely to be, found on the same or different shelves; and (6) the extent to which the respective goods are in competition with each other<sup>6</sup>. Even if the goods are not in competition with each other, they may be similar if they are complementary<sup>7</sup>. However, the mere fact that a particular product is used as a component of another does not suffice in itself to show that the two are similar<sup>8</sup>.

The nature of the marks being compared is irrelevant to the similarity or otherwise of the goods or services concerned; but when it comes to assessing the likelihood of confusion the two factors are interdependent<sup>9</sup>.

1     Ie in either the Trade Marks Act 1994 or EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks.

2     Ie the ground in the Trade Marks Act 1994 s 5(2); see PARA 72 ante.

3     See *ibid* s 10(2); and PARA 87 post.

4     *H Young (Operations) Ltd v Medici Ltd* [2003] EWHC 1589 (Ch) at [20], sub nom *ANIMAL Trade Mark* [2004] FSR 383 at [20] per Jacob J.

5     Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathe Communications Corpn)* [1998] ECR I-5507, [1998] All ER (EC) 934, [1999] FSR 332, ECJ; Case C-416/04P *The Sunrider Corpn v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, [2006] All ER (D) 178 (May), ECJ (decided under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (see PARA 176 et seq post)).

6     Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathe Communications Corpn)* [1998] ECR I-5507, [1998] All ER (EC) 934, [1999] FSR 332, ECJ; *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 296-297, [1996-97] ETMR 118 at 127 per Jacob J; and see also *Associated Newspapers Ltd v Express Newspapers* [2003] EWHC 1322 (Ch), [2003] FSR 51, [2003] All ER (D) 140 (Jun).

The inquiry as to the extent to which the respective goods are competitive may take into account how those in the trade classify goods (eg whether market research companies, who act for the industry, put the goods or services in the same or different sectors): *British Sugar plc v James Robertson & Sons Ltd* *supra* at 296-297 and 127 per Jacob J. However, the fact that the respective goods are in different classes for trade mark classification purposes does not necessarily mean that they are dissimilar: Case T-8/03 *El Corte Inglés SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-4297, CFI (decided under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (see PARA 176 et seq post)) on the

Community trade mark); Case T-202/03 *Alecansan SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 470, [2006] ETMR 93, [2006] All ER (D) 82 (Feb), CFI (decided under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (see PARA 176 et seq post)).

7 Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathe Communications Corp)* [1998] ECR I-5507, [1998] All ER (EC) 934, [1999] FSR 332, ECJ. Goods or services are complementary if there is a close connection between them: see Decision 500/2000 *Tobacna Ljubljana v Hugo Boss AB* (17 March 2000, unreported), OHIM Opposition Division (smokers' articles complementary to filter cigarettes); cf Decision 1051/2002 *Laboratoires Polive snc v Miniconf Srl* (22 April 2002, unreported), OHIM Opposition Division (babies' bottles etc not complementary to clothing for babies).

8 Case T-336/03 *Les Editions Albert René v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-4667, [2005] All ER (D) 322 (Oct), CFI (computer hardware and software not similar to telecommunications and other electronic products) (decided under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (see PARA 176 et seq post)).

9 As to the likelihood of confusion see PARA 74 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/74. Likelihood of confusion.

#### **74. Likelihood of confusion.**

The test of likelihood of confusion is used both for assessing the registrability of a trade mark<sup>1</sup> and as an ingredient of infringement<sup>2</sup>. The question in both situations is whether the combined effect of: (1) the identity or such similarity as there may be between the respective marks (or the mark and the sign); and (2) the identity or such similarity as there may be between the respective goods or services, is to give rise to a likelihood of confusion on the part of the public<sup>3</sup>. In the context of registration, the likelihood of confusion is to be judged assuming both marks are in fair and normal use<sup>4</sup>. In the context of infringement, the court must assume that the registered trade mark<sup>5</sup> is used in a normal and fair manner in relation to all the goods or services for which it is registered<sup>6</sup>. It must next identify the sign which the defendant is using<sup>7</sup>, and then assess the likelihood of confusion due to the use of that sign in relation to the goods or services in respect of which it is being used, discounting added matter or circumstances<sup>8</sup>.

The European Court of Justice has given guidance on the correct approach to the assessment of likelihood of confusion<sup>9</sup>:

- 126 (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors<sup>10</sup>;
- 127 (b) the matter must be judged through the eyes of the average consumer of the goods or services in question<sup>11</sup>, who is deemed to be reasonably well informed and reasonably circumspect and observant but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question<sup>12</sup>;
- 128 (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>13</sup>;
- 129 (d) the appreciation of the visual, aural and conceptual similarities of the marks must therefore be based on the overall impressions created by the marks bearing in mind their distinctive and dominant components<sup>14</sup>;
- 130 (e) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it<sup>15</sup>;
- 131 (f) there is an interdependence between the various relevant factors, so that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa<sup>16</sup>;
- 132 (g) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient<sup>17</sup>;
- 133 (h) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense<sup>18</sup>;
- 134 (i) the risk that the public might wrongly believe that the respective goods or services come from the same or economically linked undertakings constitutes a likelihood of confusion<sup>19</sup>.

Where there has been honest concurrent use<sup>20</sup> of the marks on a substantial scale for a substantial period of time without actual confusion, that may show that there is no likelihood of confusion provided that the circumstances of use of the later mark correspond to the

circumstances relevant to the assessment of likelihood of confusion, for example regarding the goods or services in relation to which the mark has been used<sup>21</sup>.

1     le under the Trade Marks Act 1994 s 5(2): see PARA 72 ante.

2     le under *ibid* s 10(2): see PARA 87 post. The same interpretation must be applied to both provisions: Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4861, [2000] All ER (EC) 694, [2000] 2 CMLR 1061, [2000] ETMR 723, ECJ.

3     Generally speaking, this is a single composite question: see eg *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283, [1998] ETMR 307, CA; *BALMORAL Trade Mark* [1999] RPC 297, Appointed Person. In some cases, it may be possible to say that there is no similarity at all between the respective trade marks (or between the respective goods or services) and therefore conclude that there is no likelihood of confusion: Case C-106/03P *Vedial SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR I-9573, ECJ (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)). This approach, however, can only safely be adopted in clear cases: Case C-235/05 *L'Oreal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-57, ECJ; Case T-396/04 *Soffass SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 272, [2005] All ER (D) 301 (Nov), CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 8(1)(b) (see PARA 220 post)); *Home-Tek International Ltd's Trade Mark Application* (O/144/05), Appointed Person; *CITYBOND Trade Mark* [2007] RPC 301, Appointed Person; *Hyundai Mobis Co Ltd's Trade Mark Application* (O/020/07), Appointed Person. Conflicting views have been expressed as to whether a threshold level of similarity is required before there can be a likelihood of confusion: see *Hachette Filipacchi Presse SA v Saprotex International (Proprietary) Ltd* [2007] EWHC 63 (Ch), [2007] All ER (D) 188 (Jan); *L'Oréal SA v Bellure NV* [2006] EWHC 2355 (Ch), [2007] RPC 328, [2007] ETMR 1; *esure Insurance Ltd v Direct Line Insurance plc* [2007] EWHC 1557 (Ch), [2007] All ER (D) 382 (Jun).

4     See eg *REACT Trade Mark* [2000] RPC 285, Appointed Person.

5     As to the meaning of 'registered trade mark' see PARA 127 post.

6     *Origin Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280; *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch), [2004] RPC 809, [2004] 17 LS Gaz R 32 (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 9(1)(b) (see PARA 227 post)). The registered trade mark may not in fact be used in relation to all the goods or services for which it is registered or at all.

7     Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799 at [49], [2003] IP & T 994 at [49] per Jacobs AG; *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049.

8     *Origin Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280 at 284 per Jacob J, corrected in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 293 per Jacob J; *United Biscuits (UK) Ltd v Asda Stores Ltd* [1997] RPC 513; *Aktiebolaget Volvo v Heritage (Leicester) Ltd* [2000] FSR 253, [1999] All ER (D) 478; *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218; *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293, (2001) Times, 28 February; *BP Amoco plc v John Kelly Ltd* [2001] IP & T 787, [2002] FSR 87, NI CA; *Julius Sämann Ltd v Tetrosyl Ltd* [2006] EWHC 529 (Ch), [2006] ETMR 75, [2006] All ER (D) 274 (Mar); but cf *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] EWCA Civ 1656, [2007] RPC 407, [2007] ETMR 19 (questions referred to the ECJ).

9     The leading cases are Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, [1998] RPC 199, [1998] 1 CMLR 445, ECJ; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ; Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathe Communications Corp'n)* [1998] ECR I-5507, [1998] All ER (EC) 934, [1999] FSR 332, ECJ; Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4861, [2000] All ER (EC) 694, [2000] 2 CMLR 1061, [2000] ETMR 723, ECJ.

The summary set out in heads (a)-(i) in the text is based on that adopted and applied by the Registrar of Trade Marks.

10    Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, [1998] RPC 199, [1998] 1 CMLR 445, ECJ.

11    Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, [1998] RPC 199, [1998] 1 CMLR 445, ECJ.

12 Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ.

13 Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, [1998] RPC 199, [1998] 1 CMLR 445, ECJ. The overall impression of a complex trade mark may in certain circumstances be dominated by one or more of its components: Case C-3/03P *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-3657, ECJ (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)); Case C-120/04 *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2006] ECR I-8551, [2006] IP & T 150, [2006] ETMR 13, ECJ. Nevertheless it is only if all the other components of the mark are negligible that the assessment of similarity can be carried out solely on the basis of the dominant element: Case C-334/05P *Office of Harmonisation in the Internal Market (Trade Marks and Designs) v Shaker di L Laudato & C Sas* [2007] All ER (D) 91 (Jun). A descriptive element will not constitute the distinctive and dominant component of a composite mark: Case T-129/01 *Jose Alejandro SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-2251, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)); Case T-117/02 *Grupo El Prado Cervera SL v Office for Harmonisation in the International Market* [2004] ECR II-2073, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)); Joined Cases T-117/03 to T-119/03 *New Look Ltd v Office for Harmonisation in the International Market* [2004] ECR II-3471, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)); Case T-147/03 *Devinlec Developpement Innovation Leclerc SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 436, [2006] All ER (D) 36 (Jan), CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b)). The same is true of a descriptive prefix (or presumably suffix) forming part of a word mark: Case T-202/04 *Madaus AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 591, [2006] ETMR 76, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b)). On the other hand, there may be a likelihood of confusion where the contested sign is composed by juxtaposing the company name of another party and a registered trade mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein: Case C-120/04 *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* supra.

14 Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, [1998] RPC 199, [1998] 1 CMLR 445, ECJ. Whether there is a likelihood of confusion depends on the net effect of the visual and/or aural and/or conceptual similarities in conjunction with the other factors. Thus mere conceptual similarity may be sufficient if the earlier mark has a particularly distinctive character (Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* supra); and mere aural similarity may also be sufficient (Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ). Conversely, in an appropriate case conceptual differences between the marks can counteract visual and aural similarities between them, leading to the conclusion that there is no likelihood of confusion: Case C-361/04P *Ruiz-Picasso v Office for Harmonisation in the International Market* [2006] ECR I-643, [2006] IP & T 283, ECJ (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)). This is particularly so if there are visual differences as well: Case C-206/04P *Mühlens GmbH & Co KG v Office for Harmonisation in the International Market* [2006] IP & T 558, [2006] EMLR 57 (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 8(1)(b) (see PARA 220 post)). Aural similarity between the marks is less important in the case of goods which are marketed in such a way that the relevant public usually perceives the mark visually: Case T-292/01 *Phillips-Van Heusen Corp v Office for Harmonisation in the International Market* [2003] ECR II-4335, [2003] All ER (D) 235 (Oct), CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 8(1)(b) (see PARA 220 post)); Joined Cases T-117/03 to T-119/03 *New Look Ltd v Office for Harmonisation in the International Market* [2004] ECR II-3471, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)); Case T-301/03 *Canali Ireland Ltd v Office for Harmonisation in the International Market* [2005] ECR II-2479, [2005] All ER (D) 317 (Jun), CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)). The likelihood of confusion may be increased if the earlier trade mark forms part of a 'family' of trade marks having a common element provided that the marks have been used: Case T-214/00 *Royal County of Berkshire Polo Club Ltd v Office for Harmonisation in the International Market* [2006] ETMR 59, CFI; Case T-194/03 *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR II-445, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)).

15 Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, [1998] RPC 199, [1998] 1 CMLR 445, ECJ; Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathe Communications Corp)* [1998] ECR I-5507, [1998] All ER (EC) 934, [1999] FSR 332, ECJ. In the infringement context, the distinctive character of the mark must be assessed as of the date when the defendant began to



use the sign: Case C-145/05 *Levi Strauss & Co v Casucci Spa* [2007] FSR 170, [2006] ETMR 71, ECJ. As to the assessment of distinctive character see PARAS 60-61 ante.

16 Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathe Communications Corp)* [1998] ECR I-5507, [1998] All ER (EC) 934, [1999] FSR 332, ECJ; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ; Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4861, [2000] All ER (EC) 694, [2000] 2 CMLR 1061, [2000] ETMR 723, ECJ.

17 Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1997] ECR I-6191, [1998] RPC 199, [1998] 1 CMLR 445, ECJ.

18 Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4861, [2000] All ER (EC) 694, [2000] 2 CMLR 1061, [2000] ETMR 723, ECJ.

19 Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc (formerly Pathe Communications Corp)* [1998] ECR I-5507, [1998] All ER (EC) 934, [1999] FSR 332, ECJ; Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819, [1999] All ER (EC) 587, [2000] FSR 77, ECJ. It appears that such a likelihood of confusion must exist at (or possibly before) the point of sale, and that post-sale confusion is irrelevant: Case C-361/04P *Ruiz-Picasso v Office for Harmonisation in the International Market* [2006] ECR I-643, [2006] IP & T 283, ECJ (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)).

20 As to honest concurrent use see PARAS 80-81 post.

21 Case T-31/03 *Grupo Sada pa SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1667, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)); Case T-29/04 *Castelblanch SA v Office for Harmonisation in the Internal Market* [2005] ECR II-5309, [2006] ETMR 61, CFI (this case considered the question of genuine use under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 43(2), (3) (see PARA 282 post)); Case T-346/04 *Sadas SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-4891, [2006] IP & T 420, [2006] ETMR 27, CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(1)(b) (see PARA 220 post)); *Phones4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244, [2007] RPC 83; *Lunan Group Ltd v Edwin Co Ltd* [2006] EWHC 3284 (Ch), [2006] All ER (D) 214 (Dec), sub nom *FIORELLI Trade Mark* [2007] RPC 447; *CODAS Trade Mark* [2001] RPC 240, Trade Mark Registry; *Professional Cycle Manufacturing Ltd's Trade Mark Application* (O/238/05), Appointed Person; *Ratiopharm GmbH's Application* (O/079/07), Appointed Person. See also Case R 415/1999-1 *Goldshield Group plc v Unilever plc* (12 September 2000, unreported), OHIM Board of Appeal. Co-existence on the register is not enough: Case R 360/2000-4 *Antas-Gestoa e Investimentos Lda v Magliera SL* (8 January 2002, unreported), OHIM Board of Appeal.

## UPDATE

### 74 Likelihood of confusion

NOTE 3--For European Court of Justice ruling in *L'Oréal SA v Bellure NV*, cited, see Case C-487/07 *L'Oréal SA v Bellure NV* [2010] All ER (EC) 28, ECJ; and PARA 96 NOTE 8. See also Case T-230/07: *Laboratorios Del Dr Esteve, SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Ester C Company intervening)* [2009] All ER (D) 98 (Sep), CFI.

NOTE 8--For ECJ decision in *O2 Holdings*, cited, see Case C-533/06 *O2 Holdings Ltd v Hutchison 3G UK Ltd* [2008] 3 CMLR 397, [2008] All ER (D) 155 (Jun).

See *esure Insurance Ltd v Direct Line Insurance plc* [2008] EWCA Civ 842, [2009] IP & T 706 (no reason why hearing officer should not decide issue of similarity on his own in absence of evidence, apart from marks themselves and evidence as to goods and services to which they apply).

NOTE 19--See also T-204/06 *Vivartia ABEE Proionton Diatrofis kai Ypiresion Estiasis v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2009] All ER (D) 176 (Aug), CFI.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/75. Identical or similar mark taking unfair advantage of, or being detrimental to, distinctive character or repute of earlier mark.

**75. Identical or similar mark taking unfair advantage of, or being detrimental to, distinctive character or repute of earlier mark.**

A trade mark<sup>1</sup> which is identical with or similar to an earlier trade mark<sup>2</sup> must not be registered<sup>3</sup> if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom<sup>4</sup> (or, in the case of a Community trade mark<sup>5</sup> or international trade mark (EC)<sup>6</sup>, in the European Community)<sup>7</sup> and the use<sup>8</sup> of the later mark without due cause<sup>9</sup> would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark<sup>10</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'earlier trade mark' see PARA 70 ante.

3 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

4 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

5 For the meaning of 'Community trade mark' see PARA 206 post.

6 For the meaning of 'international trade mark (EC)' see PARA 8 note 17 ante.

7 A trade mark has a reputation for this purpose if it is known to a significant part of the public concerned by the products or services covered by the trade mark, so that when confronted by a similar or identical mark, used even on dissimilar goods or services, they nevertheless make an association between the two marks: Case C-375/97 *General Motors Corpn v Yplon SA* [1999] ECR I-5421, [1999] All ER (EC) 865, [1999] 3 CMLR 427, [2000] RPC 572, ECJ. The stronger the registered trade mark's distinctive character and reputation, the easier it is to establish that unfair advantage will be taken of it or detriment will be caused to it: Case C-375/97 *General Motors Corpn v Yplon SA* supra; *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218; Case R 308/2003-1 *Mango Sport System SRL Socio Unico Mangone Antonio Vincenzo v Diknah SL* [2005] ETMR 5, OHIM Board of Appeal.

It is sufficient if the trade mark has acquired the necessary reputation in a substantial part of the United Kingdom: see Case C-375/97 *General Motors Corpn v Yplon SA* supra (sufficient that trade mark had reputation in a substantial part of a member state). In the case of a Community trade mark it must have a reputation in the Community and not merely in the United Kingdom: *Hyundai Mobis Co Ltd's Trade Mark Application* (O/020/07), Appointed Person.

8 For the meaning of 'use' see PARA 60 note 8 ante.

9 It is for the defendant to show that he has a 'due cause': *Pfizer Ltd v Eurofood Link (UK) Ltd* [2001] FSR 17; *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218. Mere honesty in adopting a trade mark is not enough; the defendant must show some sort of compulsion or right to use the mark or sign in question: *Premier Brands UK Ltd v Typhoon Europe Ltd* supra; Case R-281/1999-3 *Hollywood SAS v Souza Cruz SA* [2002] ETMR 64, OHIM Board of Appeal (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)). In an appropriate case the exercise of the right of freedom of expression may perhaps constitute due cause: cf *Laugh It Off Promotions CC v South African Breweries International (Finance) BV* 2005 (8) BCLR 743, SA CC.

10 Trade Marks Act 1994 s 5(3) (amended by the Trade Marks (Proof of Use, etc) Regulations 2004, SI 2004/946, regs 3, 7(1); and the Trade Marks (International Registrations Designating the European Community etc) Regulations, SI 2004/2332, regs 2, 3). This provision is derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 4(3), (4)(a). The amendment made by the Trade Marks (Proof of Use, etc) Regulations 2004, SI 2004/946, gives effect to the rulings of the European Court of Justice that EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 4(4)(a) is to

be interpreted as applying where the trade mark is sought to be registered for identical or similar goods or services to those in respect of which the earlier trade mark is registered as well as for goods or services which are not similar (Case C-292/00 *Davidoff & Cie SA v Gofkid Ltd* [2003] ECR I-389, [2003] All ER (EC) 1029, ECJ; Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120, [2003] ECR I-12537, ECJ), although the amendment was unnecessary (*Electrocoin Automatics Ltd v Coinworld Ltd* [2004] EWHC 1498 (Ch), [2005] FSR 7, [2005] IP & T 132). See also *Intel Corpn Inc v CPM United Kingdom Ltd* [2007] EWCA Civ 431, [2007] All ER (D) 218 (May) (questions referred to the ECJ). Cf the corresponding infringement provision: see the Trade Marks Act 1994 s 10(3) (as amended); and PARA 88 post. As to the concepts of unfair advantage and detriment see PARA 76 post. As to the position where the proprietor of the earlier mark consents to the registration see the Trade Marks Act 1994 s 5(5); and PARA 78 post.

## UPDATE

### **75 Identical or similar mark taking unfair advantage of, or being detrimental to, distinctive character or repute of earlier mark**

NOTE 10--The fact that the earlier mark is unique and has a huge reputation for certain specific types of goods or services, and that the later mark calls the earlier mark to mind, is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark: Case C-252/07 *Intel Corpn Inc v CPM United Kingdom Ltd* [2009] IP & T 559, ECJ. See also *Whirlpool Corpn v Kenwood Ltd* [2009] EWCA Civ 753, [2010] RPC 51, [2009] All ER (D) 271 (Jul).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/76. Unfair advantage and detriment to earlier trade mark.

## **76. Unfair advantage and detriment to earlier trade mark.**

The tests of taking unfair advantage of, and being detrimental to, the distinctive character or the repute of a mark are used both for assessing the registrability of a trade mark<sup>1</sup> and as an ingredient of infringement<sup>2</sup>. It must be shown that use<sup>3</sup> of the later trade mark would be likely to<sup>4</sup>, or use of the sign does<sup>5</sup>, take unfair advantage or cause detriment.

It is not necessary to prove confusion to establish an unfair advantage or detriment; it is sufficient for the degree of similarity between the trade mark applied for and the earlier trade mark to have the effect that the relevant section of the public establishes a link between them<sup>6</sup>. The existence of such a link must be appreciated globally taking into account all factors relevant to the circumstances of the case<sup>7</sup>.

'Unfair advantage' is taken where the use of the trade mark applied for would enable the applicant to exploit the distinctive character or repute of the earlier trade mark to market its goods or services, thereby taking the benefit of the promotional expenditure of the proprietor of the earlier trade mark and saving on its own investment in promotion<sup>8</sup>. It is not sufficient, without more, that the later trade mark would remind people of the earlier trade mark<sup>9</sup>.

'Detriment' to the distinctive character or repute of a trade mark may be established by showing that the use of the offending mark would give the mark an unfavourable connotation ('tarnishing')<sup>10</sup>. It may also be established by showing that the use of the later trade mark would erode the distinctiveness of the earlier trade mark ('blurring' or 'dilution')<sup>11</sup>, or by showing that use of the later mark would inhibit exploitation of the reputation of the earlier trade mark, for example by licensing or merchandising<sup>12</sup>.

1     I.e. under the Trade Marks Act 1994 s 5(3) (as amended) and under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 8(5): see PARAS 75 ante, 221 post. For the meaning of 'trade mark' see PARA 57 ante.

2     I.e. under the Trade Marks Act 1994 s 10(3) (as amended) and under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 9(1)(c): see PARAS 88, 228 post.

3     For the meaning of 'use' see PARA 60 note 8 ante.

4     Case T-67/04 *SA Spa Monopole v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1825, CFI (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, i.e. art 8(5) (see PARA 221 post)).

5     *Mastercard International Inc v Hitachi Credit (UK) plc* [2004] EWHC 1623 (Ch), [2005] RPC 551, [2005] ETMR 10.

6     Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120, [2003] ECR I-12537, ECJ; and see also Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421, [1999] All ER (EC) 865, [1999] 3 CMLR 427, [2000] RPC 572, ECJ.

In the infringement context, the necessary link will not be established if the public views the sign purely as an embellishment: Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* supra.

7     Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120, [2003] ECR I-12537, ECJ. See also *Intel Corp Inc v CPM United Kingdom Ltd* [2007] EWCA Civ 431, [2007] All ER (D) 218 (May) (questions referred to the ECJ).

8 Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120 at [39], [2003] ECR I-12537 at [39] per Jacobs AG (opinion); Case T-477/04 *Aktieselskabet af 21 November 2001 v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 63 (Feb) (TDK for clothing would take unfair advantage of TDK for audio and video tape) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)); Case T-67/04 *SA Spa Monopole, Compagnie Fermière de Spa SA/NV v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1825, CFI (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)); Case T-47/06 *Antarctica Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 156 (May), CFI (NASDAQ for various goods would take unfair advantage of NASDAQ for financial services); Case T-215/03 *SIGLA SA v Office for the Harmonisation in the Internal Markets (Trade Marks and Designs)* [2007] All ER (D) 380 (Mar), CFI (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)); Case R-308/2003-1 *Mango Sport System Srl Socio Unico Mangone Antonio Vincenzo v Diknah SL* [2005] ETMR 5, OHIM Board of Appeal (MANGO for protective helmets would take unfair advantage of reputation of MANGO for clothing); Case R 1204/2004-1 *V & S Vin & Spirit AB v Hoya Corpn* (12 July 2005, unreported), OHIM Board of Appeal (ABSOLUTE for eyeglasses would take unfair advantage of reputation of ABSOLUT for vodka) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)); Case R 301/2005-2 *Nike International Ltd v Fina Calzados SL* (19 May 2006, unreported), OHIM Board of Appeal (D'NICKERS and device for footwear would take unfair advantage of reputation of NIKE and device) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 8(5) (see PARA 221 post)); Case R 550/2004-4 *Suzuki Motor Corpn v Whirlpool Europe Srl* (3 July 2006, unreported), OHIM Board of Appeal (IGNIS for vehicles would take unfair advantage of reputation of IGNIS for household appliances) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), ie art 8(5) (see PARA 221 post)); *L'Oréal SA v Bellure NV* [2006] EWHC 2355 (Ch), [2007] RPC 328, [2007] ETMR 1 (packaging of 'smell-alike' perfumes took unfair advantage of reputation of packaging trade marks of branded perfumes).

9 *CA Sheimer (M) Sdn Bhd's Trade Mark Application* [2000] RPC 484 at 505, Appointed Person; *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218; *Electrocoin Automatics Ltd v Coinworld Ltd* [2004] EWHC 1498 (Ch), [2005] FSR 79, [2005] IP & T 132; Case T-215/03 *SIGLA SA v Office for the Harmonisation in the Internal Markets (Trade Marks and Designs)* [2007] All ER (D) 380 (Mar), CFI (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)).

10 Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] at [38], [2003] ECR I-12537 at [38] per Jacobs AG (opinion); Case T-67/04 *SA Spa Monopole, Compagnie Fermière de Spa SA/NV v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1825, CFI (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)); *CA Sheimer (M) Sdn Bhd's Trade Mark Application* [2000] RPC 484, Appointed Person (association between financial services and condoms); *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218 (allegation of detriment failed on the facts); *GALAXY Trade Mark* (O/179/00), Trade Marks Registry (association between chocolate and poisons); Case R-281/1999-3 *Hollywood SAS v Souza Cruz SA* [2002] ETMR 64, OHIM Board of Appeal (association between chewing gum and tobacco) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)); Case R-1007/2000-1 *ER Squibb & Sons LLC v Pharmalife Italia Srl* (30 November 2001, unreported), OHIM Board of Appeal (association between drug and bleaching preparations).

11 Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120 at [37], [2003] ECR I-12537 at [37] per Jacobs AG (opinion); Case T-67/04 *SA Spa Monopole, Compagnie Fermière de Spa SA/NV v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1825, CFI; *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218; *Intel Corpn v Sihra* [2003] EWHC 17 (Ch), [2003] RPC 789, [2004] ETMR 44 (use of INTEL-PLAY for toys would dilute repute of INTEL for microprocessors); Case R-470/2001-2 *J Floris Ltd v Istrad Ltd* [2005] ETMR 8, OHIM Board of Appeal (use of FLORIS for textile products would dilute repute of FLORIS for perfume) (decision made under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)). See also *Intel Corpn Inc v CPM United Kingdom Ltd* [2007] EWCA Civ 431, [2007] All ER (D) 218 (May) (questions referred to the ECJ).

The concept of 'blurring' is considered by Sir Thomas Bingham MR in *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75, [1993] FSR 641, CA. For a general discussion of the concept of dilution see *Premier Brands UK Ltd v Typhoon Europe Ltd* supra; Schecter *The Rational Basis of Trademark Protection* (1926) 40 Harv L Rev 813; Martino *Trademark Dilution* (1st Edn, 1996); Mostert *Famous and Well-Known Marks* (2nd Edn, 2004).

12 Case R 145/2003-2 *Deutsche Telekom AG v Comité International Olympique (Association)* (1 March 2004, unreported), OHIM Board of Appeal (decision made under the equivalent provision of EC Council Regulation

40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 8(5) (see PARA 221 post)); *Valucci Designs Ltd's Trade Mark Application* (O/455/00), Appointed Person.

## **UPDATE**

### **76 Unfair advantage and detriment to earlier trade mark**

NOTES 7, 10, 11--Proof of detriment to the distinctive character of a trade mark requires evidence of a change in the economic behaviour of the average consumer consequent on the use of an offending mark, or a serious likelihood that such a change will occur in the future: see Case C-252/07 *Intel Corp'n Inc v CPM United Kingdom Ltd* [2009] IP & T 559, ECJ.

NOTE 8--For European Court of Justice ruling in *L'Oréal SA v Bellure NV*, cited, see Case C-487/07 *L'Oréal SA v Bellure NV* [2010] All ER (EC) 28, ECJ; and PARA 96 NOTE 8.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/77. Refusal by virtue of an earlier right; meaning of 'earlier right'.

## **77. Refusal by virtue of an earlier right; meaning of 'earlier right'.**

A trade mark<sup>1</sup> must not be registered<sup>2</sup> if, or to the extent that, its use<sup>3</sup> in the United Kingdom<sup>4</sup> is liable to be prevented<sup>5</sup>:

- 135 (1) by virtue of any rule of law (in particular, the law of passing off<sup>6</sup>) protecting an unregistered trade mark or other sign used in the course of trade<sup>7</sup>; or
- 136 (2) by virtue of an earlier right<sup>8</sup>, in particular by virtue of the law of copyright<sup>9</sup>, design right<sup>10</sup> or registered designs<sup>11</sup>.

A person thus entitled to prevent the use of a trade mark is referred to in the Trade Marks Act 1994 as the proprietor of an 'earlier right' in relation to the trade mark<sup>12</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'registered' see PARA 19 note 2 ante. In the case of an international trade mark, the mark 'becomes protected': see PARAS 13, 55 note 8 ante.

3 For the meaning of 'use' see PARA 60 note 8 ante.

4 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

5 Trade Marks Act 1994 s 5(4). See also EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 4(4)(b), (c).

6 As to passing off see PARA 304 et seq post. In this context the correct approach is to consider whether normal and fair use of the trade mark applied for would result in passing off: *WILD CHILD Trade Mark* [1998] RPC 455, Appointed Person; *CORGI Trade Mark* [1999] RPC 549, Appointed Person. Normally the issue must be determined as at the date of the filing of the application, but if the mark applied for was in issue at that date, it would appear necessary to consider the position as at the date the use of the mark commenced: see PARA 307 post. If the applicant is the senior user he should prevail, at least so far as the application corresponds to his earlier use: *Croom's Trade Mark Application* [2005] RPC 23, Appointed Person; *Taplanes Ltd's Trade Mark Application* (O/135/06), Appointed Person.

7 Trade Marks Act 1994 s 5(4)(a). As to the meaning of 'trade' see PARA 60 note 4 ante.

8 I.e. other than those referred to in *ibid* s 5(1)-(3) (s 5(3) as amended) (see PARAS 71-72, 75 ante) or s 5(4)(a) (see head (1) in the text).

9 As to copyright see COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 3 et seq.

10 As to design right see COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARAS 10, 501 et seq.

11 Trade Marks Act 1994 s 5(4)(b). As to registered designs see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 681 et seq.

12 *Ibid* s 5(4). See also note 5 supra. Any person (and not only the proprietor of the earlier right) may oppose the registration of the trade mark: *WILD CHILD Trade Mark* [1998] RPC 455, Appointed Person. As to the position where the proprietor of the earlier mark consents to the registration see the Trade Marks Act 1994 s 5(5); and PARA 78 post.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/78. Permission of the proprietor of an earlier trade mark or earlier right.

**78. Permission of the proprietor of an earlier trade mark or earlier right.**

Nothing in the relative grounds for refusal of registration<sup>1</sup> prevents the registration of a trade mark<sup>2</sup> where the proprietor of the earlier trade mark<sup>3</sup> or other earlier right<sup>4</sup> consents to the registration<sup>5</sup>.

1     In the Trade Marks Act 1994 s 5 (as amended): see PARAS 71-77 ante. For the meaning of 'registration' see PARA 19 note 2 ante.

2     For the meaning of 'trade mark' see PARA 57 ante.

3     For the meaning of 'earlier trade mark' see PARA 70 ante.

4     For the meaning of 'earlier right' see PARA 77 ante.

5     Trade Marks Act 1994 s 5(5). See also EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 4(5). It is not clear whether consent given after registration is sufficient. In relation to Community trade marks, consent may be given at any time before the validity of the registration is challenged: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 52(3); and PARA 244 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/79. Raising of relative grounds in opposition proceedings in case of non-use.

## **79. Raising of relative grounds in opposition proceedings in case of non-use.**

In opposition proceedings<sup>1</sup>, where:

- 137 (1) an application for registration of a trade mark<sup>2</sup> has been published<sup>3</sup>;
- 138 (2) there is an earlier trade mark<sup>4</sup> in relation to which the specified conditions<sup>5</sup> obtain; and
- 139 (3) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication<sup>6</sup>,

the registrar<sup>7</sup> must not refuse to register the trade mark by reason of the earlier trade mark unless the 'use conditions' are met<sup>8</sup>. The 'use conditions' are met if:

- 140 (a) within the period of five years ending with the date of publication of the application, the earlier trade mark has been put to genuine use<sup>9</sup> in the United Kingdom<sup>10</sup> by the proprietor or with his consent in relation to the goods or services for which it is registered<sup>11</sup>; or
- 141 (b) the earlier trade mark has not been so used, but there are proper reasons<sup>12</sup> for non-use<sup>13</sup>.

Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it must be treated for these purposes as if it were registered only in respect of those goods or services<sup>14</sup>.

1 As to opposition proceedings see PARA 384 et seq post.

2 As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post. For the meaning of 'trade mark' see PARA 57 ante; and for the meaning of 'registration' see PARA 19 note 2 ante.

3 For the meaning of 'publish' see PARA 17 note 10 ante.

4 For the meaning of 'earlier trade mark' see PARA 70 ante.

5 I.e. the conditions specified in the Trade Marks Act 1994 s 5(1), (2) or (3) (s 5(3) as amended): see PARAS 71-72, 75 ante.

6 Cf ibid s 46(1)(a): see PARA 114 post.

7 As to the registrar see PARA 17 ante.

8 Trade Marks Act 1994 s 6A(1), (2) (s 6A added by the Trade Marks (Proof of Use, etc) Regulations 2004, SI 2004/946, regs 3, 4). See also EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 11(2). Nothing in the Trade Marks Act s 6A (as added) affects: (1) the refusal of the registration on the grounds mentioned in s 3 (absolute grounds for refusal: see PARA 58 et seq ante) or s 5(4) (refusal by virtue of an earlier right: see PARA 77 ante); or (2) the making of an application for a declaration of invalidity under s 47(2) (application on relative grounds where no consent to registration: see PARA 119 post): s 6A(7) (as so added).

9 For these purposes, use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered: *ibid* s 6A(4)(a) (as added: see note 8 *supra*). Cf s 46(2): see PARA 114 post.

For the meaning of 'genuine use' see PARA 114 note 6 post; and for the meaning of 'use' generally see PARA 60 note 8 ante.

10 For these purposes, use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes: *ibid* s 6A(4)(b) (as added: see note 8 *supra*). Cf s 46(2): see PARA 114 post. In relation to a Community trade mark, any reference to the United Kingdom in s 6A(3), (4) (as added) must be construed as a reference to the European Community: s 6A(5) (as so added). For the meaning of 'United Kingdom' generally see PARA 3 note 2 ante.

11 *Ibid* s 6A(3)(a) (as added: see note 8 *supra*). See also note 10 *supra*.

12 As to proper reasons see PARA 114 note 10 post.

13 Trade Marks Act 1994 s 6A(3)(b) (as added: see note 8 *supra*). See also note 10 *supra*.

14 *Ibid* s 6A(6) (as added: see note 8 *supra*).

## **UPDATE**

### **79 Raising of relative grounds in opposition proceedings in case of non-use**

TEXT AND NOTE 4--In head (2) the reference is to an earlier trade mark of a kind falling within the Trade Marks Act 1994 s 6(1)(a), (b) or (ba) (see PARA 70 heads (1)-(3)): s 6A(1) (amended by SI 2008/1067).

NOTE 10--Also in relation to an international trade mark (EC): Trade Marks Act 1994 s 6A(5) (amended by SI 2008/1067).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/80. Raising of relative grounds in case of honest concurrent use.

# **80. Raising of relative grounds in case of honest concurrent use.**

Where on an application for the registration of a trade mark<sup>1</sup> it appears to the registrar<sup>2</sup>:

- 142 (1) that there is an earlier trade mark<sup>3</sup> in relation to which the specified conditions<sup>4</sup> obtain<sup>5</sup>; or
- 143 (2) that there is an earlier right<sup>6</sup> in relation to which the specified condition is satisfied<sup>7</sup>,

but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use<sup>8</sup> of the trade mark for which registration is sought<sup>9</sup>, the registrar must not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings<sup>10</sup> by the proprietor of that earlier trade mark or other earlier right<sup>11</sup>.

If the proprietor of the earlier trade mark or other earlier right does raise an objection on that ground in opposition proceedings, the objection must be considered and, if made out, registration must be refused<sup>12</sup>.

1 As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post. For the meaning of 'trade mark' see PARA 57 ante; and for the meaning of 'registration' see PARA 19 note 2 ante.

2 As to the registrar see PARA 17 ante.

3 For the meaning of 'earlier trade mark' see PARA 70 ante.

4 I.e. the conditions specified in the Trade Marks Act 1994 s 5(1), (2) or (3) (s 5(3) as amended): see PARAS 71-72, 75 ante.

5 Ibid s 7(1)(a).

6 For the meaning of 'earlier right' see PARA 77 ante.

7 Trade Marks Act 1994 s 7(1)(b). The specified condition is set out in s 5(4): see PARA 77 ante.

8 For the meaning of 'honest concurrent use' see PARA 81 post.

9 Trade Marks Act 1994 s 7(1).

10 As to opposition proceedings see PARA 384 et seq post.

11 Trade Marks Act 1994 s 7(2). There is no provision corresponding to the Trade Marks Act 1994 s 7 in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks. It is arguable that the Trade Marks Act 1994 s 7(2) is inconsistent with EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 4 on the basis that it restricts opposition to the proprietor of the earlier trade mark or earlier right in question, assuming that this is not required by the Directive. The Trade Marks Act 1994 s 7(2) does not apply where the applicant did not overcome an objection based on the earlier trade mark or earlier right relied upon by the opponent during examination by reliance upon honest concurrent use: *Professional Cycle Manufacturing Ltd's Trade Mark Application* (O/238/05), Appointed Person.

Nothing in the Trade Marks Act 1994 s 7 affects: (1) the refusal of registration on the grounds mentioned in s 3 (absolute grounds for refusal: see PARA 58 et seq ante); or (2) the making of an application for a declaration of invalidity under s 47(2) (application on relative grounds where no consent to registration: see PARA 119 post): s 7(4). Section 7 does not apply when there is an order in force under s 8 (see PARA 82 post): s 7(5).

As to appeals from any decision of the registrar see ss 76, 77 (both as amended); and PARA 405 et seq post.

12 *Road Tech Computer Systems Ltd v Unison Software (UK) Ltd* [1996] FSR 805. The fact that there has been honest concurrent use may still be relevant. It will be a factor to consider in assessing any of the following: (1) the likelihood of confusion (see the Trade Marks Act 1994 s 5(2); and PARA 72 ante); (2) whether the applicant has 'due cause' within the meaning of s 5(3) (as amended) (see PARA 75 ante); (3) whether the applicant's use of the mark will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark (see PARA 76 ante); and (4) whether there is a likelihood of passing off (see s 5(4); and PARAS 77 ante, 304 et seq post).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/81. Meaning of 'honest concurrent use'.

### **81. Meaning of 'honest concurrent use'.**

'Honest concurrent use' means such use in the United Kingdom<sup>1</sup>, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of the Trade Marks Act 1938<sup>2</sup>.

For the purposes of that Act, in the case of honest concurrent use, or of other special circumstances which in the opinion of the court or the Registrar of Trade Marks made it proper to do so, the court or the registrar might permit the registration by more than one proprietor, in respect of the same goods, the same description of goods or goods and services or descriptions of goods and services which were associated with each other, of marks that were identical or nearly resembled each other, subject to such conditions and limitations, if any, as the court or the registrar might think it right to impose<sup>3</sup>. Under the doctrine of concurrent use<sup>4</sup>, given the honesty of the concurrent use, the following factors were relevant, namely: (1) the degree of likelihood of confusion; (2) the extent, period and area within which there had been concurrent use; (3) whether there had been confusion in fact; (4) the degree of hardship of refusing registration compared with the hardship the other way if it was allowed; and (5) the public interest<sup>5</sup>.

Each case had to be considered on its own merits, and the likelihood that real hardship might be caused by a refusal of the application might offset the possibility of confusion. The concurrent use had to be honest, and knowledge of the registration or use of another mark might be significant<sup>6</sup>. The public interest was important, but was not conclusive where the concurrent use was in good faith and registration was just<sup>7</sup>. A difficulty arose where the proprietor of an earlier registered mark had not actually used it, but the applicant had made extensive honest use of it, since there was then no use by the proprietor of the mark with which the applicant's use could be compared.

1 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

2 Trade Marks Act 1994 s 7(3).

3 Trade Marks Act 1938 s 12(2) (repealed). As to the registrar see PARA 17 ante.

4 As to the origins of this doctrine see *General Electric Co v General Electric Co Ltd* [1972] 2 All ER 507, [1972] 1 WLR 729, [1973] RPC 297, HL.

5 See *Re Alexander Pirie & Sons Ltd's Application* (1933) 50 RPC 147 at 159, HL, per Lord Tomlin. See also *Re Peddie's Applications* (1943) 61 RPC 31; *BALI Trade Mark (No 2)* [1978] FSR 193 at 220-221; *STAR Trade Mark* [1990] RPC 522. As to the likelihood of confusion see PARA 74 ante.

6 See the cases cited in note 5 supra.

7 *BULER Trade Mark* [1975] RPC 275.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iii) Relative Grounds for Refusal of Registration/82. Power to require that relative grounds be raised in opposition proceedings.

## **82. Power to require that relative grounds be raised in opposition proceedings.**

The Secretary of State<sup>1</sup> may by order provide that in any case a trade mark<sup>2</sup> must not be refused registration on relative grounds for refusal<sup>3</sup> unless objection on that ground is raised in opposition proceedings<sup>4</sup> by the proprietor of the earlier trade mark<sup>5</sup> or other earlier right<sup>6</sup>. The order may make such consequential provision as appears to the Secretary of State appropriate<sup>7</sup>:

- 144 (1) with respect to the carrying out by the registrar<sup>8</sup> of searches of earlier trade marks<sup>9</sup>; and
- 145 (2) as to the persons by whom an application for a declaration of invalidity may be made<sup>10</sup> on relative grounds<sup>11</sup>.

Such an order must be made by statutory instrument; and no order may be made unless a draft of it has been laid before and approved by a resolution of each House of Parliament<sup>12</sup>. Such an order may contain such transitional provisions as appear to the Secretary of State to be appropriate<sup>13</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 Is a ground mentioned in the Trade Marks Act 1994 s 5 (as amended): see PARAS 71-78 ante.

4 As to opposition proceedings see PARA 384 et seq post.

5 For the meaning of 'earlier trade mark' see PARA 70 ante.

6 Trade Marks Act 1994 s 8(1). As from 1 October 2007 the Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, makes such provision: arts 1, 2 (not yet in force).

It is arguable that the Trade Marks Act 1994 s 8(1) and the Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, are inconsistent with EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 4 on the basis that they restrict opposition to the proprietor of the earlier trade mark or earlier right in question, assuming that this is not required by the Directive. For the meaning of 'earlier right' see PARA 77 ante. The Trade Marks Act 1994 s 7 (see PARAS 80-81 ante) does not apply where there is an order in force under s 8: s 7(5).

7 Ibid s 8(2).

8 As to the registrar see PARA 17 ante.

9 Trade Marks Act 1994 s 8(2)(a). An order making such provision as is mentioned in s 8(2)(a) may direct that so much of s 37 (see PARA 372 post) as requires a search to be carried out is to cease to have effect: s 8(3). As from 1 October 2007 the Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, arts 3, 4 (not yet in force) make such provision: see PARA 372 note 5 post. As to searches of earlier trade marks in relation to the examination of applications see the Trade Marks Act 1994 s 37(1), (2); and PARA 372 post.

10 Is made on the grounds specified in ibid s 47(2): see PARA 119 post.

11 Ibid s 8(2)(b). An order making such provision as is mentioned in s 8(2)(b) may provide that so much of s 47(3) (see PARAS 396, 458 post) as provides that any person may make an application for a declaration of

invalidity is to have effect subject to the provisions of the order: s 8(4). As from 1 October 2007 the Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, art 5 (not yet in force) will make such provision: see PARA 119 notes 5, 8 post.

12 Ibid s 8(5). No such draft of an order making such provision as is mentioned in s 8(1) (see the text to notes 1-6 supra) may be laid before Parliament until after the end of the period of ten years beginning with the day on which applications for Community trade marks may first be filed in pursuance of the Community Trade Mark Regulation: Trade Marks Act 1994 s 8(5). For the meaning of 'Community trade mark' see PARA 206 post. The 'Community Trade Mark Regulation' means EC Council Regulation 40/94 of 20 December 1993 (OJ L11, 14.1.94, p 1), on the Community trade mark (see PARA 176 post): Trade Marks Act 1994 s 51.

13 Ibid s 8(6).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(3) REQUIREMENTS FOR THE REGISTRATION OF UNITED KINGDOM TRADE MARKS AND FOR PROTECTION OF INTERNATIONAL MARKS/(iv) Registration subject to Disclaimer or Limitation/83. In general.

#### **(iv) Registration subject to Disclaimer or Limitation**

##### **83. In general.**

An applicant for registration<sup>1</sup> of a trade mark<sup>2</sup>, or the proprietor of a registered trade mark<sup>3</sup>, may:

- 146 (1) disclaim any right to the exclusive use<sup>4</sup> of any specified element of the trade mark<sup>5</sup>; or
- 147 (2) agree that the rights conferred by the registration are to be subject to a specified territorial or other limitation<sup>6</sup>.

Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by a registered trade mark<sup>7</sup> are restricted accordingly<sup>8</sup>. Disclaimers and limitations can similarly be made in relation to an international trade mark for which protection is sought or has been obtained in the United Kingdom<sup>9</sup>.

Where the applicant for registration of a trade mark or the proprietor by notice in writing sent to the registrar disclaims any right to the exclusive use of any specified element of the trade mark or agrees that the rights conferred by the registrations are to be subject to a specified territorial or other limitation, the registrar must make the appropriate entry in the register and must publish<sup>10</sup> such disclaimer or limitation<sup>11</sup>. In the case of international trade marks, such entries are placed in the supplemental register<sup>12</sup>.

There is no longer an explicit power in the registrar to call for a disclaimer or limitation<sup>13</sup>. Nevertheless it seems clear that, in determining the distinctiveness or otherwise of a mark, the registrar is able to take account of any offered disclaimer or limitation<sup>14</sup>. It is not certain whether or not the tribunal in proceedings for revocation or a declaration of invalidity of a registration could, as a matter of discretion, order that the relief be granted unless the proprietor made an appropriate disclaimer or limitation<sup>15</sup>.

1 For the meaning of 'registration' see PARA 19 note 2 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 As to the meaning of 'registered trade mark' see PARA 127 post.

4 For the meaning of 'use' see PARA 60 note 8 ante.

5 Trade Marks Act 1994 s 13(1)(a).

6 Ibid s 13(1)(b). It is not possible to amend the trade mark itself under s 13(1)(b) since such amendments are only permissible under s 39 (see PARAS 374-375 post): *Nestlé SA's Trade Mark Application*[2004] EWCA Civ 1008, [2005] RPC 77, sub nom *Société des Produits Nestlé SA v Mars UK Ltd*[2005] IP & T 551 (in which it was held that it was not permissible to specify the colour and size of a shape mark under the Trade Marks Act s 13 or s 39). It may, however, be possible to specify more precisely a colour which has not been sufficiently clearly identified: *Ty Nant Spring Water Ltd's Trade Mark Application*[2000] RPC 55, [1999] ETMR 981, Appointed Person; *Robert McBride Ltd's Trade Mark Application*[2003] RPC 343, Appointed Person; and see PARA 366 note 6 post.

It is not permissible to limit the goods or services in respect of which the trade mark is registered by reference to the absence of a particular characteristic: see PARA 363 note 7 post.

7 le the rights conferred by the Trade Marks Act 1994 s 9: see PARAS 84-85 post.

8 Ibid s 13(1); and see PARA 98 post. There is no reference to disclaimers or limitations in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks.

Provision must be made by rules as to the publication and entry in the register of a disclaimer or limitation: Trade Marks Act 1994 s 13(2). In exercise of the power so conferred the Secretary of State has made the Trade Marks Rules 2000, SI 2000/136, r 24: see the text to notes 10-11 infra. As to the Secretary of State see PARA 14 ante. As to the making of rules generally see PARA 15 ante. As to the register see PARA 19 ante.

A disclaimer or limitation entered on the former register in relation to an existing registered mark immediately before 31 October 1994 had to be transferred to the new register and has effect as if entered on the register in pursuance of the Trade Marks Act 1994 s 13: s 105, Sch 3 para 3(2). For the meaning of 'existing registered mark' see PARA 4 note 2 ante. The system of conditions on registration is no longer continued: see Sch 3 para 3(1); and PARA 19 ante.

9 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(4), (5) (art 4(4) amended, and art 4(5) substituted, by SI 2002/692).

10 For the meaning of 'publish' see PARA 17 note 10 ante.

11 Trade Marks Rules 2000, SI 2000/136, r 24.

12 See the Trade Marks (International Registration) Order 1996, SI 1996/714, arts 4(4), 24; and PARA 19 ante.

13 le as there was under the Trade Marks Act 1938 s 17(2) (repealed).

14 See *Nestlé SA's Trade Mark Application*[2004] EWCA Civ 1008, [2005] RPC 77, sub nom *Société des Produits Nestlé SA v Mars UK Ltd*[2005] IP & T 551.

15 Under the former law a disclaimer could be ordered: *Re Trade Marks Nos 39, 759 and 247, 273, J Wigfull & Sons Ltd v J Jackson & Son Ltd*[1916] 1 Ch 213, 33 RPC 97.

## UPDATE

### 83 In general

NOTES 9, 12--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

TEXT AND NOTES 10, 11--SI 2000/136 r 24 now Trade Marks Rules 2008, SI 2008/1797, r 31.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(i) Nature of Infringement/84. Rights conferred by registered trade mark.

## **(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)**

### **(i) Nature of Infringement**

#### **84. Rights conferred by registered trade mark.**

The proprietor of a registered trade mark<sup>1</sup> has exclusive rights in the trade mark which are infringed by use<sup>2</sup> of the trade mark in the United Kingdom<sup>3</sup> without his consent<sup>4</sup>. The same rights are enjoyed by the holder of a protected international trade mark (UK)<sup>5</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 post.

2 For the meaning of 'use' for the purposes of infringement see PARA 89 post; and for the meaning of 'use' generally see PARA 60 note 8 ante.

3 Use of a trade mark abroad may 'spill over' into the United Kingdom (eg where a person advertises on the internet or in publications which have international circulations: see *Euromarket Designs Inc v Peters*[2000] IP & T 1290, [2001] FSR 288). The test as to whether the use is use within the jurisdiction is whether a reasonable trader would regard the use concerned as in the course of trade in relation to goods or services within the jurisdiction: *Euromarket Designs Inc v Peters* supra; *800-FLOWERS Trade Mark Application, 1-800 Flowers Inc v Phonenames Ltd* [2000] FSR 697, [2000] ETMR 369 (affd [2001] EWCA Civ 721, [2001] IP & T 839, [2002] FSR 191). See also *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd*[1999] IP & T 59, [2000] FSR 267 (manufacture of packaging in the United Kingdom for use on goods overseas). For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

4 Trade Marks Act 1994 s 9(1) (part of which is derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 5(1), first sentence). The acts amounting to infringement, if done without the consent of the proprietor, are specified in the Trade Marks Act 1994 s 10 (as amended) (see PARA 86 et seq post): s 9(1). References in the Trade Marks Act 1994 to infringement of a registered trade mark are to any such infringement of the rights of the proprietor: s 9(2).

Section 9(1) has been described as a 'chatty introduction' to the infringement provisions in s 10, adding no more than that the acts concerned must be done without consent: *British Sugar plc v James Robertson & Sons Ltd*[1996] RPC 281 at 291, [1996-97] ETMR 118 at 122 per Jacob J; and see also *Euromarket Designs Inc v Peters*[2000] IP & T 1290, [2001] FSR 288.

For the meaning of references to doing anything with or without the consent of the proprietor of a registered trade mark see further the Trade Marks Act 1994 s 28(3); and PARA 136 post. As to what may constitute consent see *Mastercigars Direct Ltd v Hunters & Frankau Ltd*[2007] EWCA Civ 176, [2007] RPC 565, [2007] ETMR 44.

Where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by the Trade Marks Act 1994 s 9 are restricted accordingly: see s 13(1); and PARA 98 post.

The exclusive rights conferred by s 9(1) do not override another's passing off rights: *Inter Lotto (UK) Ltd v Camelot Group plc*[2003] EWCA Civ 1132, [2003] 4 All ER 575, [2004] 1 WLR 955.

The Trade Marks Act 1994 s 9 applies in relation to an existing registered mark as from 31 October 1994, subject to s 105, Sch 3 para 4(2) (see PARA 97 post): Sch 3 para 4(1). The old law continues to apply in relation to infringements committed before that date: Sch 3 para 4(1). For the meaning of 'existing registered mark' see PARA 4 note 2 ante; and for the meaning of 'the old law' see PARA 4 note 3 ante.

As to the registrar's power to suspend trade mark rights of an enemy or enemy subject see PARA 108 post.

5 Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(1). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

**UPDATE**

**84 Rights conferred by registered trade mark**

NOTE 5--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(i) Nature of Infringement/85. Date from which rights run.

## **85. Date from which rights run.**

The rights of the proprietor of a registered trade mark<sup>1</sup> have effect from the date of registration, that is to say<sup>2</sup>, the date of filing of the application for registration<sup>3</sup>, provided that:

148 (1) no infringement proceedings<sup>4</sup> may be begun before the date on which the trade mark is in fact registered<sup>5</sup>; and

149 (2) no offence of the unauthorised use of a trade mark etc in relation to goods<sup>6</sup> is committed by anything done before the date of publication of the registration<sup>7</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 post. As to such rights see PARA 84 ante. As to the date of registration of a protected international trade mark (UK) see PARA 21 ante. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 Ie in accordance with the Trade Marks Act 1994 s 40(3): see PARA 21 ante.

3 Ibid s 9(3). For transitional provisions see PARA 86 note 7 post. In relation to a protected international trade mark (UK), the rights of the proprietor have effect for the purposes of s 9 as of the date on which it is to be treated as registered under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 12 (as amended) (see PARA 13 ante) or art 21 (see PARA 21 ante): art 4(2)(a).

4 For these purposes, 'infringement proceedings', in relation to a registered trade mark, includes proceedings under the Trade Marks Act 1994 s 16 (order for delivery up of infringing goods etc: see PARA 461 post): s 103(1).

5 Ibid s 9(3) proviso (a). As to procedure on application see PARA 352 et seq post. In the case of a protected international trade mark (UK) this is the date on which it achieves the status of being a protected mark under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 12 (as amended) (see PARA 389 post): art 4(2)(b); and see PARA 13 ante.

6 Ie under the Trade Marks Act 1994 s 92: see PARAS 141-144 post.

7 Ibid s 9(3) proviso (b). In the case of a protected international trade mark (UK), no offence is committed by anything done before the date of publication by the registrar of the particulars of the international registration: Trade Marks (International Registration) Order 1996, SI 1996/714, art 17(3). As to the publication of the particulars see PARA 13 text to note 15 ante.

## **UPDATE**

### **85 Date from which rights run**

NOTES 3, 5, 7--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(i) Nature of Infringement/86. Identical sign for identical goods or services.

## **86. Identical sign for identical goods or services.**

A person infringes a registered trade mark<sup>1</sup> if he uses<sup>2</sup> in the course of trade<sup>3</sup> a sign<sup>4</sup> which is identical<sup>5</sup> with the trade mark in relation to goods or services which are identical<sup>6</sup> with those for which it is registered<sup>7</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' for the purposes of infringement see PARA 89 post. In order to constitute infringement, the acts must be done without the consent of the proprietor: see the Trade Marks Act 1994 s 9(1); and PARA 84 ante. For the meaning of 'use' generally see PARA 60 note 8 ante.

3 Use is 'in the course of trade' when it takes place in the context of commercial activity with a view to economic advantage and not as a private matter: Case C-206/01 *Arsenal Football Club plc v Reed* [2003] Ch 454, [2002] ECR I-10273, [2003] All ER (EC) 1, ECJ. As to the meaning of 'trade' see PARA 60 note 4 ante.

4 In order to decide whether the sign is identical or similar to the registered trade mark, the court must first ascertain what sign the defendant is using: Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799 at [49], [2003] IP & T 994 at [49] per the opinion of Jacobs AG; *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049. As to the meaning of 'sign' see PARA 57 note 1 ante.

5 As to the meaning of 'identical' in this context see PARA 71 note 3 ante.

6 As to the meaning of 'identical' in this context see PARA 71 note 5 ante.

7 Trade Marks Act 1994 s 10(1) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 5(1)(a)). Cf the corresponding relative ground of refusal: see the Trade Marks Act 1994 s 5(1); and PARA 71 ante. This provision applies to use of the trade mark in relation to the proprietor's own goods or services, which is therefore an infringing act unless the user has a defence by virtue of other provisions of the Trade Marks Act 1994, in particular s 11(2)(b), (c) (see PARAS 94-95 post) and s 12 (see PARAS 102-103 post): Case C-63/97 *Bayerische Motorenwerke AG (BMW) v Deenik* [1999] ECR I-905, [1999] All ER (EC) 235, ECJ; *British Airways plc v Ryanair Ltd* [2001] IP & T 373, [2001] FSR 541; but cf Case C-48/05 *Adam Opel AG v Autec AG* [2007] IP & T 408, [2007] ETMR 33, [2007] All ER (D) 193 (Jan); and see *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] EWCA Civ 1656, [2007] RPC 407, [2007] ETMR 19 (questions referred to the ECJ). As to the limits on the effect of a registered trade mark see PARA 91 et seq post; and as to the exhaustion of rights conferred by a registered trade mark see PARA 103 post.

The Trade Marks Act 1994 s 10 applies in relation to an existing registered mark as from 31 October 1994, subject to s 105, Sch 3 para 4(2) (see PARA 97 post): Sch 3 para 4(1). The old law continues to apply in relation to infringements committed before that date: Sch 3 para 4(1). For the meaning of 'existing registered mark' see PARA 4 note 2 ante; and for the meaning of 'the old law' see PARA 4 note 3 ante.

## **UPDATE**

## **86 Identical sign for identical goods or services**

NOTE 7--For ECJ decision in *O2 Holdings*, cited, see Case C-533/06 *O2 Holdings Ltd v Hutchison 3G UK Ltd* [2008] 3 CMLR 397, [2008] All ER (D) 155 (Jun).

NOTE 10--See Case C-17/06 *Céline Sàrl v Céline SA* [2008] IP & T 684, ECJ (use was 'in relation to goods' where sign used in way that established link between it and the goods marketed by third party).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(i) Nature of Infringement/87. Identical sign for similar goods or services; similar sign for identical goods or services.

**87. Identical sign for similar goods or services; similar sign for identical goods or services.**

A person infringes a registered trade mark<sup>1</sup> if he uses<sup>2</sup> in the course of trade<sup>3</sup> a sign<sup>4</sup> where because:

150 (1) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered<sup>5</sup>; or

151 (2) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered<sup>6</sup>,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark<sup>7</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' for the purposes of infringement see PARA 89 post. In order to constitute infringement, the acts must be done without the consent of the proprietor: see the Trade Marks Act 1994 s 9(1); and PARA 84 ante. For the meaning of 'use' generally see PARA 60 note 8 ante.

3 As to the meaning of 'in the course of trade' see PARA 86 note 3 ante.

4 As to the sign see PARA 86 note 4 ante. As to the meaning of 'sign' see PARA 57 note 1 ante.

5 Trade Marks Act 1994 s 10(2)(a).

6 Ibid s 10(2)(b). For the meaning of 'similar goods and services' see PARA 73 ante.

7 Trade Marks Act 1994 s 10(2) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 5(1)(b)). Cf the corresponding relative ground for refusal of registration: see the Trade Marks Act 1994 s 5(2); and PARA 72 ante. As to the likelihood of confusion see PARA 74 ante. As to the limits on the effect of a registered trade mark see PARA 91 et seq post; and as to the exhaustion of rights conferred by a registered trade mark see PARA 103 post. For transitional provisions see PARA 86 note 7 ante.

Actual confusion is not required for infringement, only a risk that the public will be misled: *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32, [2003] IP & T 299; *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch), [2004] RPC 809, [2004] 17 LS Gaz R 32 (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 9(1)(b) (see PARA 227 post)).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(i) Nature of Infringement/88. Identical or similar mark taking unfair advantage of, or being detrimental to, distinctive character or repute of earlier mark.

**88. Identical or similar mark taking unfair advantage of, or being detrimental to, distinctive character or repute of earlier mark.**

A person infringes a registered trade mark<sup>1</sup> if he uses<sup>2</sup> in the course of trade<sup>3</sup> in relation to goods or services a sign<sup>4</sup> which is identical with or similar to the trade mark where the trade mark has a reputation in the United Kingdom<sup>5</sup> and the use of the sign, being without due cause<sup>6</sup>, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark<sup>7</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' for the purposes of infringement see PARA 89 post. In order to constitute infringement, the acts must be done without the consent of the proprietor: see the Trade Marks Act 1994 s 9(1); and PARA 84 ante. For the meaning of 'use' generally see PARA 60 note 8 ante.

3 As to the meaning of 'in the course of trade' see PARA 86 note 3 ante.

4 As to the sign see PARA 86 note 4 ante. As to the meaning of 'sign' see PARA 57 note 1 ante.

5 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

6 As to the concept of use without due cause see PARA 75 note 9 ante.

7 Trade Marks Act 1994 s 10(3) (amended by the Trade Marks (Proof of Use, etc) Regulations 2004, SI 2004/946, regs 3, 7(2)) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 5(2)). The amendment made by the Trade Marks (Proof of Use, etc) Regulations 2004, SI 2004/946, gives effect to the rulings of the European Court of Justice that EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 5(2) is to be interpreted as applying where the sign is used in relation to identical or similar goods or services to those in respect of which the earlier trade mark is registered as well as in relation to goods or services which are not similar (Case C-292/00 *Davidoff et Cie SA v Gofkid Ltd* [2003] ECR I-389, [2003] All ER (EC) 1029, ECJ; Case C-408/01 *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120, [2003] ECR I-12537, ECJ). Cf the corresponding relative ground of refusal: see the Trade Marks Act 1994 s 5(3) (as amended); and PARA 75 ante. As to the tests of unfair advantage and detriment see PARA 76 ante. As to the limits on the effect of a registered trade mark see PARA 91 et seq post; and as to the exhaustion of rights conferred by a registered trade mark see PARA 103 post. For transitional provisions see PARA 86 note 7 ante.

**UPDATE**

**88 Identical or similar mark taking unfair advantage of, or being detrimental to, distinctive character or repute of earlier mark**

NOTE 7--See *Miss World Ltd v Channel Four Television Corp* [2007] EWHC 982 (Pat), [2007] FSR 754 (use of words 'Mr Miss World' amounted to infringement under the 1994 Act s 10(3); principal function of title was to take unfair advantage of distinctive character, repute and goodwill of 'Miss World' trade mark).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(i) Nature of Infringement/89. Meaning of 'use' for the purposes of infringement.

### 89. Meaning of 'use' for the purposes of infringement.

For the purposes of the statutory provisions relating to the infringement of a registered trade mark<sup>1</sup>, a person uses a sign<sup>2</sup> if, in particular, he:

- 152 (1) affixes it to goods or the packaging thereof<sup>3</sup>;
- 153 (2) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign<sup>4</sup>;
- 154 (3) imports<sup>5</sup> or exports goods under the sign<sup>6</sup>; or
- 155 (4) uses<sup>7</sup> the sign on business<sup>8</sup> papers<sup>9</sup> or in advertising<sup>10</sup>.

1     le for the purposes of the Trade Marks Act 1994 s 10 (as amended) (see PARAS 86-88 ante, 90 post): s 10(4) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 5(3)). The provisions also apply to infringement of a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2     Infringing use for these purposes must be trade mark use, that is to say, use which jeopardises or is liable to jeopardise one of the functions of the trade mark: *R v Johnstone* [2003] UKHL 28, [2003] 3 All ER 884, [2003] 1 WLR 1736; Case C-63/97 *Bayerische Motorenwerke AG v Deenik* [1999] ECR I-905, [1999] 1 All ER (EC) 235, ECJ; Case C-206/01 *Arsenal Football Club plc v Reed* [2003] Ch 454, [2002] ECR I-10273, [2003] All ER (EC) 1, ECJ; Case C-245/02 *Anheuser-Busch Inc v Budejovický Budvar NP* [2004] ECR I-10989, [2007] IP & T 348, [2004] All ER (D) 271 (Nov), ECJ; Case C-48/05 *Adam Opel AG v Autec AG* [2007] IP & T 408, [2007] ETMR 33, [2007] All ER (D) 193 (Jan), ECJ. In certain circumstances purely descriptive use is not trade mark use: Case C-2/00 *Hölterhoff v Freiesleben* [2002] ECR I-4187, [2002] All ER (EC) 665, ECJ; and see *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] EWCA Civ 1656, [2007] RPC 407, [2007] ETMR 19 (questions referred to the ECJ). Use purely as a company or trade name is not trade mark use: *Anheuser-Busch Inc v Budejovický Budvar NP* supra.

Furthermore, the infringing use must be use in relation to particular goods or services: see *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 293, [1996-97] ETMR 118 at 124 per Jacob J, explaining *Bravado Merchandising Services Ltd v Mainstream Publishing Ltd* [1996] FSR 205, 1996 SLT 597, Ct of Sess; *Trebor Bassett Ltd v The Football Association* [1997] FSR 211 (trade mark on jersey of footballers not used in relation to photographs of those footballers); *Avnet Ltd v Isoact Ltd* [1998] FSR 16. If the use of the sign is infringing use, it is not a defence that the defendant has distinguished his goods or services from those of the registered proprietor by something outside the sign itself; extraneous matter and circumstances are to be disregarded: *Origin Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280 at 284 per Jacob J, corrected in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 293 per Jacob J; *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218; *Aktiebolaget Volvo v Heritage (Leicester) Ltd* [2000] FSR 253, [1999] All ER (D) 478; *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293, (2001) Times, 28 February; *BP Amoco plc v Kelly* [2001] IP & T 787, [2002] FSR 87, NI CA; *Julius Sämann Ltd v Tetrosyl Ltd* [2006] EWHC 529 (Ch), [2006] ETMR 75, [2006] All ER (D) 274 (Mar); Case IZR 304/01 *Rolex Internet Auction* [2005] ETMR 25; cf *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] EWCA Civ 1656, [2007] RPC 407, [2007] ETMR 19 (questions referred to the ECJ).

It is not clear whether 'invisible' use of a trade mark, in particular in internet metatags, counts as use for this purpose: see *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049; cf *Road Tech Computer Systems Ltd v Mandata (Management and Data Services) Ltd* [2000] IP & T 1029.

3     Trade Marks Act 1994 s 10(4)(a). The sign must be affixed to the goods in the United Kingdom to amount to an infringing use; it is not an infringement to order, manufacture or export packaging bearing the sign for the purposes of affixing it to the goods overseas: *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [1999] IP & T 59, [2000] FSR 267.

4     Trade Marks Act 1994 s 10(4)(b). Offering and putting on the market include the offering and sale of goods bearing a trade mark and having the customs status of non-Community goods, when the offering and/or sale is

effected while the goods are placed under the customs external transit procedure or the customs warehousing procedure if the offering or sale necessarily entails putting the goods on the market in the Community: Case C-405/03 *Class International BV v Colgate-Palmolive Co* [2006] Ch 154, sub nom *Class International BV v Unilever NV* [2005] ECR I-8735, ECJ.

A mark may be used notwithstanding that it is not visible to the consumer until after the sale (eg where the goods are sold over the internet); the obliteration of the mark before delivery does not mean that the mark has not been used: *Kabushiki Kaisha Sony Computer Entertainment v Nuplayer Ltd* [2005] EWHC 1522 (Ch), [2006] FSR 9, [2005] All ER (D) 188 (Jul).

5 Mere entry of goods into the Community under the external transit procedure or the customs warehousing procedure is not sufficient to amount to importation so as to make this an infringement if the goods have not already been placed on the market in the Community by the trade mark proprietor or with his consent: Case C-405/03 *Class International BV v Colgate-Palmolive Co* [2006] Ch 154, sub nom *Class International BV v Unilever NV* [2005] ECR I-8735, ECJ. See also Case C-281/05 *Montex Holdings Ltd v Diesel SpA* [2007] IP & T 387, 2006 All ER (D) 105 (Nov), ECJ.

6 Trade Marks Act 1994 s 10(4)(c).

7 For the meaning of 'use' see PARA 60 note 8 ante. Since, by virtue of *ibid* s 103(2), use of a sign includes use otherwise than by means of a graphic representation, oral use of a trade mark may amount to infringement, reversing the position under the Trade Marks Act 1938 under which only visual use of a trade mark was capable of amounting to infringement.

8 For the meaning of 'business' see PARA 32 note 3 ante.

9 See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [1999] IP & T 59, [2000] FSR 267 (use on invoices).

10 Trade Marks Act 1994 s 10(4)(d). As to the limits on the effect of a registered trade mark see PARA 91 et seq post; and as to the exhaustion of rights conferred by a registered trade mark see PARA 103 post. For transitional provisions see PARA 86 note 7 ante.

## UPDATE

### 89 Meaning of 'use' for the purposes of infringement

NOTE 5--See also *Eli Lilly and Co v 8PM Chemist Ltd* [2008] EWCA Civ 24, [2008] IP & T 730; and *Nokia Corp v Revenue and Customs Comrs* [2009] EWHC 1903 (Ch), [2010] FSR 185, [2009] All ER (D) 341 (Jul).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(i) Nature of Infringement/90. Application of mark to material for labelling or packaging.

## **90. Application of mark to material for labelling or packaging.**

A person who applies a registered trade mark<sup>1</sup> to material intended to be used for labelling or packaging goods, as a business<sup>2</sup> paper, or for advertising goods or services, is to be treated as a party to any use<sup>3</sup> of the material which infringes the registered trade mark if, when he applied the mark, he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee<sup>4</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'business' see PARA 32 note 3 ante.

3 For the meaning of 'use' for the purposes of infringement see PARA 89 ante. In order to constitute infringement, the acts must be done without the consent of the proprietor: see the Trade Marks Act 1994 s 9(1); and PARA 84 ante. For the meaning of 'use' generally see PARA 60 note 8 ante.

4 Trade Marks Act 1994 s 10(5). Cf the more restricted liability of printers etc under the common law in passing off: see *Paterson Zochonis & Co Ltd v Merfarken Packaging Ltd* [1986] 3 All ER 522, [1983] FSR 273, CA (where a printer was not liable for the passing off achieved by his customer notwithstanding the suspicious circumstances in which printing was commissioned). As to knowing or having reason to believe see *LA Gear Inc v Hi-Tec Sports plc* [1992] FSR 121, CA (which deals with the concept in the context of the Copyright, Designs and Patents Act 1988: see COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 334); *ZYX Music GmbH v King* [1997] 2 All ER 129, [1997] EMLR 319, CA. As to the granting of licences see PARAS 136-137 post. As to the rights of an exclusive licensee see the Trade Marks Act 1994 s 31(1), (2); and PARA 419 post. As to the limits on the effect of a registered trade mark see PARA 91 et seq post; and as to the exhaustion of rights conferred by a registered trade mark see PARA 103 post. For transitional provisions see PARA 86 note 7 ante.

Section 10(5) applies in relation to an authorised user of a registered collective mark or a registered certification mark as in relation to a licensee of a trade mark: see ss 49(2), 50(2), Sch 1 para 11(a), Sch 2 para 13(a); and PARAS 162, 173 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/91. Use for identifying goods or services of the proprietor or licensee.

## (ii) Limits on Effects of Registered Trade Marks

### 91. Use for identifying goods or services of the proprietor or licensee.

Nothing in the statutory provisions relating to infringement of registered trade marks<sup>1</sup> is to be construed as preventing the use<sup>2</sup> of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee<sup>3</sup>; but any such use otherwise than in accordance with honest practices in industrial or commercial matters<sup>4</sup> is to be treated as infringing the registered trade mark if the use without due cause<sup>5</sup> takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark<sup>6</sup>.

1 The Trade Marks Act 1994 s 10(1)-(5) (s 10(3) as amended); see PARAS 86-90 ante. The same provisions apply to infringement of a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' for the purposes of infringement see PARA 89 ante. For the meaning of 'use' generally see PARA 60 note 8 ante.

3 As to the granting of licences see PARAS 136-137 post. As to the rights of an exclusive licensee see the Trade Marks Act 1994 s 31(1), (2); and PARA 419 post.

4 As to the meaning of 'honest practices' see PARA 96 post.

5 As to the concept of use without due cause see PARA 75 note 9 ante.

6 Trade Marks Act 1994 s 10(6). This provision is not derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks. It has been suggested that it implements art 5(5) of the Directive, but art 5(5) permits member states to confer an additional right on trade mark proprietors to the rights conferred by art 5(1)-(4), not to provide additional defences to those provided by arts 6 and 7: see Case C-23/01 *Robelco NV v Robelco Groep NV* [2002] ECR I-10913, [2002] All ER (D) 311 (Nov), ECJ. It is arguable that the Trade Marks Act 1994 s 10(6) is incompatible with the Directive since the European Court of Justice has ruled that arts 5-7 form a complete code and it is not open to national laws to provide other defences: Case C-355/96 *Silhouette International Schmied GmbH & Co KG v Hartlauer Handelsgesellschaft mbH* [1999] Ch 77, [1998] ECR I-4799, ECJ; Cases C-414/99 to C-416/99 *Zino Davidoff SA v A & G Imports Ltd* [2002] Ch 109, [2001] ECR I-8691, ECJ; Case C-244/00 *Van Doren + Q GmbH v Lifestyle sports + sportswear Handelsgesellschaft mbH* [2003] ECR I-3051, [2004] All ER (EC) 912, ECJ; Case C-16/03 *Peak Holding AB v Axolin-Elinor AB* [2005] Ch 261, [2004] ECR I-11313, ECJ; *British Airways plc v Ryanair Ltd* [2001] IP & T 373, [2001] FSR 541; but see *Levi Strauss & Co v Tesco Stores Ltd* [2002] EWHC 1625 (Ch), [2003] RPC 319, [2003] IP & T 117 (the Trade Marks Act 1994 s 10(6) is not inconsistent if interpreted in the same way as s 11(2)(b) (see PARA 94 post)). For a discussion of the origins of this provision, and its defects, see *Barclays Bank plc v RBS Advanta* [1996] RPC 307 at 312-314, [1997] ETMR 199 at 204-206 per Laddie J. It has been said that it is a pointless provision which should be repealed: *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] EWCA Civ 1656 at [56], [2007] RPC 407 at [56], [2007] ETMR 19 at [56] per Jacob J.

So far as use of the trade mark in relation to the proprietor's own goods is concerned, the Trade Marks Act 1994 s 10(6) is probably unnecessary since such use is protected by s 12(1): see PARAS 102-103 post. It appears that s 12(1) should also be interpreted as applying to services. For the goods to be the proprietor's own goods it is not enough that they have been manufactured to his specification; they must have been adopted by him: *Primark Stores Ltd v Lollypop Clothing Ltd* [2001] FSR 637, [2000] All ER (D) 2099. Similarly, the goods will no longer be the proprietor's own goods if their condition has been changed: *PAG Ltd v Hawk-Woods Ltd* [2002] FSR 723, [2001] All ER (D) 252 (Oct).

The primary objective of the Trade Marks Act 1994 s 10(6) is to allow comparative advertising provided that it is honest: see *Barclays Bank plc v RBS Advanta* supra at 312-313, 315, and at 204-205, 207-208 per Laddie J; *Vodafone Group plc v Orange Personal Communications Services Ltd* [1997] FSR 34, [1997] EMLR 84; *Cable &*

*Wireless plc v British Telecommunications plc* [1998] FSR 383; *Emaco Ltd and Aktiebolaget Electrolux v Dyson Appliances Ltd* [1999] ETMR 903, (1999) Times, 8 February; *British Airways plc v Ryanair Ltd* supra. However, honest use of a registered trade mark for comparative advertising is also permitted by the Trade Marks Act 1994 s 11(2)(b) (see PARA 94 post): *O2 Holdings Ltd v Hutchison 3G Ltd* supra. In any event comparative advertising must now comply with EEC Council Directive 84/450 (OJ L250, 10.9.84, p 17) relating to the approximation of the laws, regulations and administrative provisions of the member states concerning misleading advertising, art 3a (added by EEC Parliament and Council Directive 97/55 (OJ L290, 6.10.97, p 18) art 1(4)). Use of a trade mark (or possibly a sign confusingly similar thereto) in comparative advertising which complies with EEC Council Directive 84/450 (OJ L250, 10.9.84, p 17) art 3a does not infringe, while use of a trade mark (or possibly a sign confusingly similar thereto) in comparative advertising which does not comply with art 3a does infringe: Case C-44/01 *Pippig Augenoptik GmbH v Hartlauer Handelgesellschaft mbH* [2003] ECR I-3095, [2004] All ER (EC) 1156, ECJ; *O2 Holdings Ltd v Hutchison 3G Ltd* supra.

For transitional provisions see PARA 86 note 7 ante.

## **UPDATE**

### **91 Use for identifying goods or services of the proprietor or licensee**

NOTE 6--EEC Council Directive 84/450 replaced by European Parliament and EC Council Directive 2006/114: see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 393 NOTE 6.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/92. Use of another registered trade mark.

## **92. Use of another registered trade mark.**

A registered trade mark<sup>1</sup> is not infringed by the use<sup>2</sup> of another registered trade mark in relation to goods or services for which the latter is registered<sup>3</sup>. Nor is it infringed by the use of a protected international trade mark (UK) in relation to goods or services within the scope of the protection conferred by that mark in the United Kingdom<sup>4</sup>.

The defence relates only to use for which the defendant's mark is registered or protected<sup>5</sup>. A defendant may claim that the mark complained of could be validly registered and seek a stay of the action pending determination of his application for registration<sup>6</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' see PARA 60 note 8 ante.

3 Trade Marks Act 1994 s 11(1). This provision is not derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, and it is arguable that it is incompatible with the Directive since the European Court of Justice has ruled that arts 5-7 form a complete code and it is not open to national laws to provide other defences: Case C-355/96 *Silhouette International Schmied GmbH & Co KG v Hartlauer Handelsgesellschaft mbH* [1999] Ch 77, [1998] ECR I-4799, ECJ; Cases C-414/99 to C-416/99 *Zino Davidoff SA v A & G Imports Ltd* [2002] Ch 109, [2001] ECR I-8691, ECJ; Case C-244/00 *Van Doren + Q GmbH v Lifestyle sports + sportswear Handelsgesellschaft mbH* [2003] ECR I-3051, [2004] All ER (EC) 912, ECJ; Case C-16/03 *Peak Holding AB v Axolin-Elinor AB* [2005] Ch 261, [2004] ECR I-11313, ECJ. EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark contains no such provision, indeed art 106(1) implies the opposite. See *Intel Corp Inc v CPM United Kingdom Ltd* [2007] EWCA Civ 431 at [6], [2007] All ER (D) 218 (May) at [6] per Jacob LJ.

The Trade Marks Act 1994 s 11(1) corresponds in general effect, though not in language, to the Trade Marks Act 1938 s 4(4) (repealed). See, however, the Trade Marks Act 1994 s 47(6) (effect of declaration of invalidity of registration); and PARA 112 post. Thus, if a defence of use of a registered trade mark is raised, it can be countered by a claim for a declaration that that mark is invalid.

Section 11 applies in relation to an existing registered mark as from 31 October 1994, subject to s 105, Sch 3 para 4(2) (see PARA 97 post): Sch 3 para 4(1). The old law continues to apply in relation to infringements committed before that date: Sch 3 para 4(1). For the meaning of 'existing registered mark' see PARA 4 note 2 ante; and for the meaning of 'the old law' see PARA 4 note 3 ante.

It would seem that, as under the Trade Marks Act 1938, the defendant's use must be of the mark as registered, not some variant: see *Eli Lilly & Co Ltd v Chelsea Drug Chemical Co Ltd* [1966] RPC 14.

4 Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(3). As to the scope of such protection see PARA 13 ante.

5 Ie only to goods and services falling within the specification for which the mark is registered, not to similar goods or services.

6 See PARA 423 post.

## **UPDATE**

## **92 Use of another registered trade mark**

NOTE 3--Regulation 40/94 ('the Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); see PARA 176. See also Case C-324/08 *Marko Zelfbedieningsgroothandel CV v Diesel SpA* [2010] Bus LR 608, ECJ (consent of proprietor of trade mark to marketing of goods bearing that mark carried out directly in EEA by third party who had no economic link to proprietor might be implied simultaneous with or subsequent to placing of goods on market in that area which unequivocally demonstrated that proprietor had renounced exclusive rights).

NOTE 4--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/93. Use of own name or address.

### 93. Use of own name or address.

A registered trade mark<sup>1</sup> is not infringed by the use<sup>2</sup> by a person<sup>3</sup> of his own name<sup>4</sup> or address<sup>5</sup>, provided the use is in accordance with honest practices in industrial or commercial matters<sup>6</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' see PARA 60 note 8 ante.

3 The 'own name' defence applies to corporations as well as natural persons: Case C-245/02 *Anheuser-Busch Inc v Budejovicky Budvar NP* [2004] ECR I-10989, [2007] IP & T 348, [2004] All ER (D) 271 (Nov), ECJ; *Scandecor Development AB v Scandecor Marketing AB* [2001] UKHL 21, [2001] IP & T 676, [2002] FSR 122; *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049.

4 A person's 'own name' is the name that he is known by, so that it is not an infringement to use a name by which a person is commonly known: *Scandecor Development AB v Scandecor Marketing AB* [1998] FSR 500 at 521 per Lloyd J; revsd on other grounds [1999] FSR 26, CA; on appeal [2001] UKHL 21, [2001] IP & T 676, [2002] FSR 122 (questions referred to European Court of Justice but case settled prior to ruling). See also *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 at 860-862 per Laddie J (a case under the Trade Marks Act 1938 s 8 (repealed)). Most commonly, this principle entitles companies to drop suffixes such as 'limited', 'plc' and so on (*Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049; *Euromarket Designs Inc v Peters and Crate & Barrel Ltd* [2000] IP & T 1290, [2001] FSR 288; *International Business Machines Corp v Web-Sphere Ltd* [2004] EWHC 529 (Ch), [2004] All ER (D) 328 (Mar), sub nom *WEBSPIHERE Trade Mark* [2004] FSR 39); but further abbreviations are not protected (*Premier Luggage and Bags Ltd v Premier Co (UK) Ltd* [2002] EWCA Civ 387, [2003] FSR 796).

5 Trade Marks Act 1994 s 11(2)(a) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 6(1)(a)). This provision extends to use of the name as a trade mark: *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049. For transitional provisions see PARA 92 note 3 ante.

6 Trade Marks Act 1994 s 11(2) proviso (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 6(1) proviso). For the meaning of 'honest practices' see PARA 96 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/94. Use of descriptions.

#### 94. Use of descriptions.

A registered trade mark<sup>1</sup> is not infringed by the use<sup>2</sup> of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services<sup>3</sup>, provided the use is in accordance with honest practices in industrial or commercial matters<sup>4</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' see PARA 60 note 8 ante.

3 Trade Marks Act 1994 s 11(2)(b) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 6(1)(b)). At least in some circumstances, it is sufficient for this provision to apply that the indication has descriptive significance even if it also has trade mark significance: Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* [2004] ECR I-691, [2004] RPC 761, ECJ (indication of geographical origin used as trade mark); *Bravado Merchandising Services Ltd v Mainstream Publishing (Edinburgh) Ltd* [1996] FSR 205, 1996 SLT 597, Ct of Sess (use of the name of a pop group in the title of a book about that group); *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049 (an 'own name' case). If, on the other hand, the sign complained of is being used primarily as a trade mark for the defendant's goods or services rather than as a description it seems that this provision does not apply: Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber* [2000] Ch 523, [1999] ECR I-2779, [1999] ETMR 585, ECJ; *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281, [1996-97] ETMR 118; *Philips Electronics BV v Remington Consumer Products Ltd* [1998] RPC 283 (affd [1999] RPC 809, [1999] All ER (D) 465, CA; referred to ECJ sub nom C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ); *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* [1999] IP & T 59, [2000] FSR 267; *The European Ltd v The Economist Newspapers Ltd* [1996] FSR 431 at 446 per Rattee J (on appeal [1998] FSR 283 at 291-292, [1998] ETMR 307 at 316, CA, per Millet LJ); *D Green & Co (Stoke Newington) Ltd v Regalzone Ltd* [2001] EWCA Civ 639, [2001] IP & T 1071, [2002] ETMR 22; *PAG Ltd v Hawk-Woods Ltd* [2002] FSR 723, [2001] All ER (D) 252 (Oct).

Honest use of a registered trade mark for comparative advertising is permitted by the Trade Marks Act 1994 s 11(2)(b): *O2 Holdings Ltd v Hutchison 3G Ltd* [2006] EWCA Civ 1656, [2007] RPC 407, [2007] ETMR 19.

In certain circumstances, purely descriptive use of a trade mark does not constitute infringing use at all and therefore it is not necessary to invoke this defence: Case C-2/00 *Hölterhoff v Freiesleben* [2002] ECR I-4187, [2002] All ER (EC) 665, ECJ; and see PARA 89 ante. Affixing a sign identical to a trade mark registered in respect of vehicles to scale models of that make of vehicle does not constitute use of an indication concerning the characteristics of such models: Case C-48/05 *Adam Opel AG v Autec AG* [2007] IP & T 408, [2007] ETMR 33, [2007] All ER (D) 193 (Jan), ECJ.

As to the registration of marks consisting exclusively of indications etc see the Trade Marks Act 1994 s 3(1); and PARAS 59-60 ante.

For transitional provisions see PARA 92 note 3 ante.

4 Ibid s 11(2) proviso (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 6(1) proviso). For the meaning of 'honest practices' see PARA 96 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/95. Use necessary to indicate intended purpose, particularly accessories and spares.

**95. Use necessary to indicate intended purpose, particularly accessories and spares.**

A registered trade mark<sup>1</sup> is not infringed by the use<sup>2</sup> of the trade mark where it is necessary<sup>3</sup> to indicate the intended purpose of a product or service (in particular, as accessories or spare parts)<sup>4</sup>, provided the use is in accordance with honest practices in industrial or commercial matters<sup>5</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' see PARA 60 note 8 ante.

3 In order to be necessary, the use must in practice constitute the only means of providing the public with comprehensible and complete information on the intended purpose in order to preserve the undistorted system of competition in the market for that product: Case C-228/03 *Gillette Co v LA-Laboratories Ltd Oy* [2005] All ER (EC) 940, [2005] IP & T 1003, ECJ. See also *Philips Electronics BV v Remington Consumer Products Ltd* [1999] RPC 809, [1999] All ER (D) 465, CA (referred to EC) sub nom C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ); *PAG Ltd v Hawk-Woods Ltd* [2002] FSR 723, [2001] All ER (D) 252 (Oct).

4 Trade Marks Act 1994 s 11(2)(c) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 6(1)(c)). The defence is not limited to accessories or spare parts: Case C-228/03 *Gillette Co v LA-Laboratories Ltd Oy* [2005] All ER (EC) 940, [2005] IP & T 1003, ECJ. For transitional provisions see PARA 92 note 3 ante.

5 Trade Marks Act 1994 s 11(2) proviso (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 6(1) proviso). For the meaning of 'honest practices' see PARA 96 post. Thus a registered trade mark cannot be used to prevent another from using the mark for the purpose of informing the public that he carries out, or is a specialist, in the repair and maintenance of goods put on the market under that mark by the proprietor; unless the mark is used in a way that may create an impression that there is a commercial connection between that person and the proprietor (eg that he is part of the proprietor's approved distribution network): Case C-63/97 *Bayerische Motorenwerke AG v Deenik* [1999] ECR I-905, [1999] 1 All ER (EC) 235, ECJ; *Aktiebolaget Volvo v Heritage (Leicester) Ltd* [2000] FSR 253, [1999] All ER (D) 478 (manner of use of mark calculated to cause confusion and therefore not protected).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/96. Honest practices in industrial and commercial matters.

## **96. Honest practices in industrial and commercial matters.**

Several of the statutory exemptions<sup>1</sup> from infringement<sup>2</sup> of a registered trade mark<sup>3</sup> are subject to the proviso that the use of the mark complained of must be 'in accordance with honest practices in industrial and commercial matters.' It is established that this is an objective test which constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor<sup>4</sup>. The court must carry out an overall assessment of all the relevant circumstances, and in particular assess whether the defendant might be regarded as competing unfairly with the proprietor of the trade mark<sup>5</sup>.

Relevant factors in an 'own name' case include: the extent to which use of the defendant's name is understood by the public or a section of it as indicating a link between the defendant's goods and the trade mark proprietor or a person authorised to use the trade mark; the extent to which the defendant ought to have been aware of this; and whether the trade mark enjoys a certain reputation from which the defendant may profit in selling his goods<sup>6</sup>.

Relevant factors in an 'intended purpose' case include: the overall presentation of the products marketed by the defendant, particularly the circumstances in which the trade mark is displayed in that presentation; the circumstances in which a distinction is made between the trade mark and the mark or sign of the defendant; the effort made by the defendant to ensure that customers distinguish its products from those of the trade mark proprietor; and whether the products marketed by the defendant have been represented as having the same quality as, or equivalent properties to, those of the trade mark proprietor<sup>7</sup>.

Use of a trade mark will not be in accordance with honest practices if, for example<sup>8</sup>:

- 156 (1) it is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner<sup>9</sup>;
- 157 (2) it takes unfair advantage of the distinctive character or repute of the trade mark<sup>10</sup>;
- 158 (3) it entails the discrediting or denigration of the trade mark<sup>11</sup>; or
- 159 (4) the third party presents its goods as imitations or replicas of the products bearing the trade mark.
- 160 However, the mere fact that there exists a likelihood of aural confusion between an indication of geographical origin and a registered trade mark is insufficient to conclude that use of that indication in the course of trade is not in accordance with honest practices<sup>12</sup>.

1    I.e. the Trade Marks Act 1994 s 10(6) (use for identifying goods or services of the proprietor: see PARA 91 ante), s 11(2)(a) (use of own name or address: see PARA 93 ante), s 11(2)(b) (use of specified descriptions: see PARA 94 ante), s 11(2)(c) (use necessary to indicate intended purpose: see PARA 95 ante). The concept of honest practices in industrial and commercial matters is also incorporated into several of the defences to infringement of the Olympics association right (see PARA 492 et seq post): see the Olympic Symbol etc (Protection) Act 1995 s 4; and PARA 494 post.

2    As to the meaning of 'infringement' see PARA 84 note 4 ante.

3    The same provisions apply to infringement of a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

4 Case C-63/97 *Bayersische Motorenwerke AG v Deenik* [1999] ECR I-905, [1999] 1 All ER (EC) 235, ECJ; Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* [2004] ECR I-691, [2004] RPC 761, ECJ; Case C-245/02 *Anheuser-Busch Inc v Budejovicky Budvar NP* [2004] ECR I-10989, [2007] IP & T 348, [2004] All ER (D) 271 (Nov), ECJ; Case C-228/03 *Gillette Co v LA-Laboratories Ltd Oy* [2005] All ER (EC) 940, [2005] IP & T 1003, ECJ.

5 Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* [2004] ECR I-691, [2004] RPC 761, ECJ. Thus it appears that use which amounts to passing off will generally not be in accordance with honest practices: *Asprey & Garrard Ltd v WRA (Guns) Ltd* [2001] EWCA Civ 1499, [2002] IP & T 38; *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049. See, however, the text and note 12 infra.

6 Case C-245/02 *Anheuser-Busch Inc v Budejovicky Budvar NP* [2004] ECR I-10989, [2007] IP & T 348, [2004] All ER (D) 271 (Nov), ECJ.

7 Case C-228/03 *Gillette Co v LA-Laboratories Ltd Oy* [2005] All ER (EC) 940, [2005] IP & T 1003, ECJ.

8 Case C-228/03 *Gillette Co v LA-Laboratories Ltd Oy* [2005] All ER (EC) 940 at [49], [2005] IP & T 1003 at [49], ECJ. These conditions are based on EEC Council Directive 84/450 (OJ L250, 10.9.84, p 17) relating to the approximation of the laws, regulations and administrative provisions of the member states concerning misleading advertising, art 3a(1)(d)-(h) (added by EEC Parliament and Council Directive 97/55 (OJ L290, 6.10.97, p 18), art 1(4)): see *L'Oréal SA v Bellure NV* [2006] EWHC 2355 (Ch), [2007] RPC 328, [2007] ETMR 1. Earlier English cases on honest practices in the context of comparative advertising must now be viewed with some caution: see PARA 91 note 6 ante.

9 Case C-63/97 *Bayersische Motorenwerke AG v Deenik* [1999] ECR I-905, [1999] 1 All ER (EC) 235, ECJ; *Aktiebolaget Volvo v Heritage (Leicester) Ltd* [2000] FSR 253, [1999] All ER (D) 478.

10 *Tesco Stores Ltd v Elogicom Ltd* [2006] EWHC 403 (Ch), [2007] FSR 83; *L'Oréal SA v Bellure NV* [2006] EWHC 2355 (Ch), [2007] RPC 328, [2007] ETMR 1. As to the concept of taking unfair advantage of the distinctive character or repute of a trade mark see PARA 76 ante.

11 It is not clear whether, and if so how, this test differs from that of causing detriment to the distinctive character or repute of the trade mark (as to which see PARA 76 ante). The advertisement complained of in *British Airways plc v Ryanair Ltd* [2001] IP & T 373, [2001] FSR 541 is an example of what might be regarded as denigration.

12 Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* [2004] ECR I-691, [2004] RPC 761, ECJ. It appears that the amount of confusion that can be tolerated before the defence is lost is a question of degree: *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049.

## UPDATE

### 96 Honest practices in industrial and commercial matters

NOTE 6--See also Case C-17/06 *Céline Sàrl v Céline SA* [2008] IP & T 684, ECJ.

NOTE 8--EC Council Directive 84/450 replaced by European Parliament and EC Council Directive 2006/114: see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 393 NOTE 6.

In comparative advertising, a statement by an advertiser that a product is an imitation of a product bearing a well-known trade mark amounts to unlawful comparative advertising which can be prevented by the proprietor of the mark: Case C-487/07 *L'Oréal SA v Bellure NV* [2010] All ER (EC) 28, ECJ.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/97. Prior use; use lawful under the old law.

## **97. Prior use; use lawful under the old law.**

A registered trade mark<sup>1</sup> is not infringed by the use<sup>2</sup> in the course of trade<sup>3</sup> in a particular locality of an earlier right<sup>4</sup> which applies only in that locality<sup>5</sup>.

It is not an infringement of an existing registered mark or a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services to continue on and after 31 October 1994 any use<sup>6</sup> which did not amount to infringement of the existing registered mark under the old law<sup>7</sup>.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' see PARA 60 note 8 ante.

3 As to the meaning of 'trade' see PARA 60 note 4 ante.

4 For these purposes, an 'earlier right' means an unregistered trade mark or other sign continuously used in relation to goods or services by a person or a predecessor in title of his from a date prior to whichever is the earlier of: (1) the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or (2) the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his, and an earlier right is to be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by virtue of any rule of law (in particular, the law of passing off): Trade Marks Act 1994 s 11(3). As to passing off see PARA 304 et seq post.

5 Trade Marks Act 1994 s 11(3) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 6(2)). What amounts to a 'particular locality' for this purpose is somewhat uncertain, in particular whether it could compass the whole of the United Kingdom or the whole of England and Wales: see *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch), [2004] RPC 809, [2004] 17 LS Gaz R 32 (where a broad view was taken of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 107 and hence a narrow view of art 8(4) (the equivalent provisions of the Regulation)); but compare Decision 2149/2000 *McCann-Erickson Advertising Ltd's Application* [2001] ETMR 52, OHIM Opposition Division (where a broader view was taken of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(4)). The latter decision and other OHIM decisions to similar effect were not cited in *Compass Publishing BV v Compass Logistics Ltd* supra. For transitional provisions see PARA 92 note 3 ante.

6 The use referred to in the text is use which would be regarded commercially as continued use: *Northern & Shell plc v Condé Nast & National Magazine Distributors Ltd* [1995] RPC 117.

7 Trade Marks Act 1994 s 105, Sch 3 para 4(2). This could be important eg where a competitor of the proprietor of a trade mark uses the same mark in relation to goods and services which are similar to, but do not fall within, the goods or services in respect of which a mark is registered. Such use could not amount to infringement of a registered trade mark under the Trade Marks Act 1938 but could, in the absence of the provisions of the Trade Marks Act 1994 Sch 3 para 4(2), amount to infringement of a registered trade mark under that Act: see PARAS 87-88 ante.

For the meaning of 'the old law' see PARA 4 note 3 ante.

## **UPDATE**

### **97 Prior use; use lawful under the old law**

NOTE 5--Regulation 40/94 ('the Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); see PARA 176.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/98. Acts within scope of a disclaimer or limitation.

## **98. Acts within scope of a disclaimer or limitation.**

Where the registration of a trade mark<sup>1</sup> is subject to a disclaimer or limitation<sup>2</sup>, the rights conferred by a registered trade mark<sup>3</sup> are restricted accordingly<sup>4</sup>. Disclaimers and limitations apply in the same way to protected international trade marks (UK)<sup>5</sup>.

1 For the meaning of 'registration' see PARA 19 note 2 ante. For the meaning of 'trade mark' see PARA 57 ante.

2 As to registration subject to disclaimer or limitation see PARA 83 ante.

3 As to the meaning of 'registered trade mark' see PARA 127 post.

4 Trade Marks Act 1994 s 13(1). There is no reference to disclaimers or limitations in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks.

Where a trade mark is subject to a limitation, the mark cannot be infringed by use of a sign outside the field so limited: *Phones4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244, [2007] RPC 83 (mark limited as to colour not infringed by sign in different colour); and see also *Nestlé SA's Trade Mark Application* [2004] EWCA Civ 1008, [2005] RPC 77, sub nom *Société des Produits Nestlé SA v Mars UK Ltd* [2005] IP & T 551. A claim, such as a claim to a particular colour or combination of colours, is not a limitation: *L'Oréal SA v Bellure NV* [2006] EWHC 2355 (Ch), [2007] RPC 328, [2007] ETMR 1.

A contention by the proprietor that a word, which was disclaimed on its own, was the essential feature of the trade mark would lead to the very monopoly which he disclaimed, and will not therefore be accepted: *The European Ltd v The Economist Newspapers Ltd* [1998] FSR 283, [1998] ETMR 307, CA.

Nothing in this provision affects the proprietor's rights in passing off: see the Trade Marks Act 1994 s 2(2); and PARA 416 post.

5 Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(5) (substituted by SI 2002/692). See PARA 83 ante.

## **UPDATE**

## **98 Acts within scope of a disclaimer or limitation**

NOTE 4--For European Court of Justice ruling in *L'Oréal SA v Bellure NV*, cited, see Case C-487/07 *L'Oréal SA v Bellure NV* [2010] All ER (EC) 28, ECJ; and PARA 96 NOTE 8.

NOTE 5--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/99. Statutory acquiescence.

## 99. Statutory acquiescence.

Where the proprietor of an earlier trade mark<sup>1</sup> or other earlier right<sup>2</sup> has acquiesced<sup>3</sup> for a continuous period of five years in the use<sup>4</sup> of a registered trade mark<sup>5</sup> in the United Kingdom<sup>6</sup>, being aware of that use, there ceases to be any entitlement on the basis of that earlier trade mark or other right:

- 161 (1) to apply for a declaration that the registration of the later trade mark is invalid; or
- 162 (2) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith<sup>7</sup>.

Where the above provisions apply, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark<sup>8</sup>.

These provisions apply in the same way if the earlier trade mark, or the later trade mark, or both, are protected international trade marks (UK) rather than United Kingdom registered trade marks<sup>9</sup>.

1 For the meaning of 'earlier trade mark' see PARA 70 ante.

2 For the meaning of 'earlier right' see PARA 77 ante.

3 It is not clear where, in the scale commencing with merely standing by with knowledge to some form of positive inducement, the word 'acquiesce' comes. Given the context of the use of the word in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, it is unlikely that it would be interpreted in the technical sense given to it by English case law.

4 For the meaning of 'use' see PARA 60 note 8 ante.

5 As to the meaning of 'registered trade mark' see PARA 127 post. In order for the Trade Marks Act 1994 s 48 to apply the later trade mark must have actually been on the register for five years (*Sunrider Corp'n (t/a Sunrider International) v Vitasoy International Holdings Ltd* [2007] EWHC 37 (Ch), (2007) Times, 27 February); cf the position under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 53(2) (see PARA 233 note 9 post).

6 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

7 Trade Marks Act 1994 s 48(1) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 9(1), (2)). As to trade mark registrations applied for in bad faith see PARA 69 ante.

8 Trade Marks Act 1994 s 48(2) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 9(3)). It is not clear whether this would prevent a complaint based on passing off having regard to the Trade Marks Act 1994 s 2(2) (see PARA 416 post), although such a complaint might be barred by common law or equitable acquiescence.

9 Trade Marks (International Registration) Order 1996, SI 1996/714, art 14. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

## **UPDATE**

### **99 Statutory acquiescence**

NOTE 5--See also *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [2008] EWHC 263 (Ch), [2008] All ER (D) 274 (Feb).

NOTE 9--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/100. Consent, acquiescence and delay.

### 100. Consent, acquiescence and delay.

A claimant's right of action for the infringement of a trade mark may become barred by consent, acquiescence or inordinate delay<sup>1</sup>. Clearly, consent is a bar to an action<sup>2</sup>. Where there has been an express terminable licence, consent may be withdrawn<sup>3</sup>. A gratuitous licence will normally be revocable upon reasonable notice<sup>4</sup>. Acquiescence may bar a claim where the proprietor has in some way allowed or encouraged the infringer to assume that no objection will be taken to the acts in question so that the subsequent enforcement of the right would be unconscionable<sup>5</sup>. Mere delay on the claimant's part, even with knowledge of the defendant's activities, does not amount to acquiescence<sup>6</sup>; but inordinate delay may give rise to a defence if other factors are present<sup>7</sup>. Delay may also affect a claimant's right to damages<sup>8</sup> or delivery up<sup>9</sup> or other remedies<sup>10</sup>.

1 As to acquiescence and delay generally see CIVIL PROCEDURE vol 11 (2009) PARAS 373-375; EQUITY vol 16(2) (Reissue) PARA 909 et seq.

2 This is in any event explicit: see the Trade Marks Act 1994 s 9(1); and PARA 84 ante.

3 See eg *Bostitch Trade Mark* [1963] RPC 183.

4 *Edwardes v Cotton* (1902) 19 TLR 34 (a copyright case); *Hart v Hyman* (1916) MacG Cop Cas (1911-16) 301 (a copyright case).

5 The extent to which acquiescence under English common law co-exists with the new statutory acquiescence (see PARA 99 ante) is not clear. For the common law see *Habib Bank Ltd v Habib Bank AG Zurich* [1981] 2 All ER 650, [1981] 1 WLR 1265, [1982] RPC 1, CA. In judging acquiescence, regard must be had to the date when the facts came to the claimant's knowledge: *Barlow and Jones v Johnson, Jabez & Co* (1890) 7 RPC 395, CA; *Re Rowland's Trade Mark, Rowland v Mitchell* [1897] 1 Ch 71, 14 RPC 37, CA; *GH Gledhill & Sons Ltd v British Perforated Toilet Paper Co* (1911) 28 RPC 429 at 451. See also *Lee v Haley* (1869) 5 Ch App 155.

6 *Farmers Build Ltd v Carier Bulk Materials Handling Ltd* [1999] RPC 461, [2000] IP & T 49, CA (a design right case); *Jones v Stones* [1999] 1 WLR 1739, 78 P & CR 293, CA; *Re Loftus, Green v Gaul* [2006] EWCA Civ 1124, [2006] 4 All ER 1110, [2007] 1 WLR 591.

7 In *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79, CA, 20 years' delay did not suffice for a defence; but in *Vine Products Ltd v Mackenzie & Co Ltd* [1969] RPC 1, 100 years sufficed. In *Cluett Peabody & Co Inc v McIntyre Hogg Marsh & Co Ltd* [1958] RPC 335, the plaintiff was estopped by reason of laches, acquiescence and delays over a period of about 40 years. Cf *Electrolux Ltd v Electrix Ltd* (1954) 71 RPC 23, CA (where a delay of ten years in starting proceedings did not amount to acquiescence).

8 See LIMITATION PERIODS vol 68 (2008) PARA 915 et seq.

9 See the Trade Marks Act 1994 s 18; and PARA 462 post.

10 Eg the claimant's right to an account: see PARAS 442, 444 post. As to injunctions see PARA 437 et seq post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(ii) Limits on Effects of Registered Trade Marks/101. Effect of fraudulent trading or misrepresentation by the claimant.

### **101. Effect of fraudulent trading or misrepresentation by the claimant.**

Neither law nor equity assists a wholly fraudulent trade; both adopt the maxim 'ex turpi causa non oritur actio'<sup>1</sup>. Thus, if it is shown that the claimant's trade is of a fraudulent nature, he cannot succeed in any action for the use of his trade name or trade mark, or for passing off<sup>2</sup>. Normally, any fraudulent or deceptive use of his mark by a claimant will not only be a defence but will found an application for revocation of the registration<sup>3</sup>. Even where the claimant's trade is not wholly fraudulent, it seems that he is disentitled to equitable relief<sup>4</sup> if, in relation to the name or mark which he seeks to protect, he has been guilty of a material misrepresentation<sup>5</sup> calculated to mislead the public<sup>6</sup>. Whenever a mark is deceptive or used in a deceptive way, the modern practice is to dispute the validity of the registration, though these equitable defences would still, it seems, continue to be available<sup>7</sup>. Where the claimant is a company, it is not necessarily a defence that the claimant has failed to fulfil statutory requirements relating to the use of its name<sup>8</sup>.

<sup>1</sup> There is no right of action arising from a bad cause: see EQUITY vol 16(2) (Reissue) PARA 560.

<sup>2</sup> *Lee v Haley* (1869) 5 Ch App 155; *Ford v Foster* (1872) 7 Ch App 611 at 631; *Newman v Pinto* (1887) 4 RPC 508, CA; *Bile Bean Manufacturing Co v Davidson* (1906) 23 RPC 725, Ct of Sess; cf *California Fig Syrup Co v Taylor's Drug Co Ltd* (1897) 14 RPC 341 at 347 (on appeal 14 RPC 564, CA). There are difficulties in determining the scope of this principle: *Inter Lotto (UK) Ltd v Camelot Group plc* [2003] EWCA Civ 1132 at [33], [2003] 4 All ER 575 at [33], [2004] RPC 186 at [33] per Carnwath LJ. In relation to passing off see also PARA 348 post. As to the prohibition of the registration of immoral, deceptive and illegal marks see PARAS 63-65 ante.

<sup>3</sup> See under the Trade Marks Act 1994 s 46(1)(d): see PARA 116 post.

<sup>4</sup> The practice of the former Court of Chancery was not necessarily to refuse an injunction absolutely in a case where there had been misrepresentation but to refuse it unless and until the plaintiff had established a title at law: *Pidding v How* (1837) 8 Sim 477; *Perry v Truefitt* (1842) 6 Beav 66; *Flavel v Harrison* (1853) 10 Hare 467 at 473. It has been suggested that a misrepresentation which would be a good objection to affording equitable relief may not be an answer to a common law action for damages: *Jamieson & Co v Jamieson* (1898) 15 RPC 169 at 191, CA; and see *Wolff & Son v Nopitsch* (1900) 18 RPC 27 at 32, CA (possible distinction between action to enforce property right or right given by statute and action for passing off); cf *Ford v Foster* (1872) 7 Ch App 611 at 630 (explaining *Sykes v Sykes* (1824) 3 B & C 541).

<sup>5</sup> Under the old law a representation that an article was patented was such a misrepresentation (*Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at 543) if there had never been such a patent (*Flavel v Harrison* (1853) 10 Hare 467), or where the patent had expired (*Cheavin v Walker* (1877) 5 ChD 850 at 862, CA, overruling *Edelsten v Vick* (1853) 11 Hare 78). See also *Re A Boake, Roberts & Co Ltd's Trade Marks* (1909) 26 RPC 251. Where, however, 'patent' had become part of the name of the article, this rule would not apply: *Marshall v Ross* (1869) LR 8 Eq 651. See also *Gridley v Swimborne* (1888) 5 TLR 71, DC; *Cochrane v Macnish* [1896] AC 225, 13 RPC 100, PC. The same rule applied to a representation that a design (*Winsor v Armstrong & Co* (1899) 16 RPC 167 at 172) or trade mark (*Lewis v Goodbody* (1892) 67 LT 194) was registered, but the use of 'Trade Mark' was not necessarily such a representation (*Sen Sen Co v Britten* [1899] 1 Ch 692, 16 RPC 137). Misrepresentations made by the plaintiff after the action was brought were not a bar to his right of action: *Siebert v Findlater* (1878) 7 ChD 801 at 811.

<sup>6</sup> *Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at 542-543. Cf *Ford v Foster* (1872) 7 Ch App 611 (where a misrepresentation that the plaintiff was a patentee contained in invoices and advertisements was treated as a collateral misrepresentation not disentitling him to an injunction although affecting his right to an account). See also the cases cited in note 5 supra. For further cases where misrepresentations have been held not to affect the plaintiff's rights see *Mrs Pomeroy Ltd v Scalé* (1906) 24 RPC 177 at 192 (representation that defendant was plaintiff's business manager after defendant had ceased to be

such); *Plotzker v Lucas* (1907) 24 RPC 551 at 562, Ct of Sess (misrepresentation that plaintiffs were actual manufacturers).

7 It is not clear, however, whether to permit an equitable defence to a claim for infringement in circumstances where the trade mark was not liable to revocation would be consistent with EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks.

8 *Pearks, Gunston and Tee Ltd v Thompson, Talmey & Co* (1901) 18 RPC 185, CA; *HE Randall Ltd v British and American Shoe Co* [1902] 2 Ch 354 at 357, 19 RPC 393 at 402. See COMPANIES vol 14 (2009) PARA 220 et seq. Cf *Re Albert Baker & Co's Application* [1908] 2 Ch 86 at 103, 25 RPC 513 at 524; *Re Mann's Trade Marks* (1919) 36 RPC 189.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(iii) Exhaustion of Rights and Related Defences/102. Parallel trade; general position.

### **(iii) Exhaustion of Rights and Related Defences**

#### **102. Parallel trade; general position.**

A topic of particular importance arises where the proprietor of a registered trade mark<sup>1</sup> in the United Kingdom<sup>2</sup>, or a related party, markets goods under that trade mark, or another trade mark, in other countries: namely, in what circumstances other parties may, possibly in opposition to the wishes of the proprietor<sup>3</sup>, acquire the proprietor's goods in one country and import them into another country (so-called 'parallel trade' or 'parallel importation'). This question can arise in the context both of importation to, and export from, the United Kingdom. Frequently there will be parallel trade mark rights in the two countries; and in current commercial conditions this question may be complicated by the fact that in practice it is quite likely that such parallel trade mark rights will be vested in different corporate entities within a multinational group of companies<sup>4</sup>. A further potential complication is that the trade mark rights in one or other or both of those countries may be exploited by a local licensee or distributor, rather than by the proprietor himself<sup>5</sup>.

The position differs markedly, depending upon whether or not the countries of export and import are within the European Economic Area ('EEA')<sup>6</sup>. In the case of goods imported into the United Kingdom which were marketed in another country of the EEA, or vice versa, there is a wide-ranging statutory defence against infringement provided by the Trade Marks Act 1994<sup>7</sup>; and in addition there are defences arising under directly applicable provisions of the EC Treaty<sup>8</sup>. In the case of importation of goods into the United Kingdom from a country outside the EEA importation is likely to be an infringement<sup>9</sup>.

The export from the United Kingdom of goods placed on the market here by the proprietor of the trade mark will not in general amount to infringement of the trade mark registered in the United Kingdom, even if done without his consent or contrary to his express wishes<sup>10</sup>, unless there exist legitimate reasons for the proprietor to oppose such export<sup>11</sup>. The export of goods in such circumstances may, however, result in liabilities arising from contravention of the laws of the country of importation<sup>12</sup>.

In the context of parallel rights, the position under the law of passing off will also need to be considered<sup>13</sup>.

1 This also applies to a protected international trade mark (UK) or a Community trade mark. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante. As to Community trade marks see PARA 176 et seq post.

2 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

3 The proprietor may wish to prevent such cross-border trade for a variety of reasons: to maintain price differentials between national markets; to preserve good relations with distributors or retailers; or to prevent goods of differing qualities or characteristics from passing from one market to another.

4 See eg the complex company and trade mark ownership structure considered in *Revlon Inc v Cripps and Lee Ltd* [1980] FSR 85, 124 Sol Jo 184, CA.

5 The licensing of registered trade marks has in general become easier under the Trade Marks Act 1994, which explicitly countenances both non-exclusive and exclusive licences (see PARAS 136-137 post), as compared with the position under the Trade Marks Act 1938.

6 The EEA was created by the Agreement on the European Economic Area (Oporto, 2 May 1992; Cm 2073; OJ L1, 3.1.94, p 3) (the 'EEA Agreement'). The EEA Agreement was between the European Community and its member states and the then states of the European Free Trade Association, namely Austria, Finland, Iceland, Liechtenstein, Norway, Switzerland and Sweden, and was intended to create an area of 19 countries throughout which the 'four freedoms' of the European Community (the free movement of goods, capital, services and people) would apply. The Protocol adjusting that Agreement (Brussels, 17 March 1993 OJ L1, 3.1.94, p 572) had the effect of excluding Switzerland, which chose on 1 December 1992 not to participate, and Liechtenstein; enabled the EEA Agreement to enter into force without being ratified by those two countries; and allowed for Liechtenstein to join the EEA Agreement at a future date: see 230 HC Official Report (6th series), cols 414, 463. Austria, Finland and Sweden, who were member states of the EEA, moved on to become full members of the European Community on 1 January 1995. In the same year Liechtenstein joined the EEA. At the date at which this volume states the law the EEA thus comprises the European Community together with Norway, Iceland and Liechtenstein. The EEA Agreement was implemented in the United Kingdom by the European Economic Area Act 1993 which came into force on 5 November 1993. As to the aims and provisions of the EEA Agreement see 539 HL Official Report (5th series), col 1315 et seq.

7 See the Trade Marks Act 1994 s 12(1); and PARA 103 post.

8 See the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179). See PARAS 105-106 post.

9 See PARA 107 post.

10 Although the Trade Marks Act 1994 s 10(4)(c) (see PARA 89 head (3) ante) makes the export of goods under the trade mark an infringing use, that provision is subject to s 12(1) (see PARA 103 post). Once the goods have been placed on the market by the proprietor or with his consent within the EEA (which includes placing on the market within the United Kingdom itself), s 12(1) shields subsequent use of the trade mark in relation to those goods from being an infringement. It is not necessary, for s 12(1) to apply, that the goods should have crossed an intra-EEA frontier, and use of the mark by export (defined to amount to use by s 10(4)(c)) appears to be shielded by s 12(1) in the same way as would be use of the mark in the course of eg a resale of the goods internally within the United Kingdom.

11 See *ibid* s 12(2); and PARA 103 post. Such legitimate reasons include in particular where the condition of the goods has been changed or impaired after they have been put on the market: see s 12(2). Whether the desire of the proprietor of the trade mark not to undermine the market in the country to which the goods are being exported, or a difference in the quality of the goods sold there under the mark, could itself amount to a 'legitimate reason' in such a context is for the courts to decide. These would plainly not amount to legitimate reasons in an intra-EEA context: see PARA 103 post.

12 Whether any such liability would arise would depend upon the law of the country of importation. As to whether any action could be taken in the English courts in respect of the exporter's involvement in a possible infringement of the trade mark laws of the country of importation see CONFLICT OF LAWS vol 8(3) (Reissue). In the case of passing off, as distinct from statutory trade mark infringement, a trader in England can be sued in England for exporting goods to foreign markets where the goods are calculated to be used as instruments of deception in that market, or for becoming a joint tortfeasor with persons abroad who use such goods or other materials for the purpose of passing off in foreign markets: see PARAS 331-332 post.

13 See PARA 347 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(iii) Exhaustion of Rights and Related Defences/103. Statutory exhaustion of rights where goods marketed within the European Economic Area.

### **103. Statutory exhaustion of rights where goods marketed within the European Economic Area.**

A registered trade mark<sup>1</sup> is not infringed by the use<sup>2</sup> of the trade mark in relation to goods<sup>3</sup> which have been put on the market in the European Economic Area('EEA')<sup>4</sup> under that trade mark<sup>5</sup> by the proprietor or with his consent<sup>6</sup>; but this provision does not apply where there exist legitimate reasons for the proprietor to oppose further dealings in the goods, in particular, where the condition of the goods has been changed or impaired after they have been put on the market<sup>7</sup>. Corresponding provisions apply to Community trade marks<sup>8</sup>.

The above provision broadly corresponds to the position established under the case law of the European Court of Justice<sup>9</sup> in the context of trade between member states within the European Community. However, in some respects it may provide a defence in circumstances where the provisions of the EC Treaty would not do so<sup>10</sup>. There are in some circumstances defences other than 'exhaustion' available under the EC Treaty<sup>11</sup>; and there would seem to be no reason why the introduction of the above statutory defence should curtail the ambit of the defences under the EC Treaty in circumstances to which in the past they have been held to apply.

1 This also applies to a protected international trade mark (UK): see PARA 84 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 For the meaning of 'use' see PARA 60 note 8 ante.

3 Although on its face this provision only applies to goods, it is arguable that it should be interpreted as applying also to services in appropriate circumstances.

4 Importation of goods into the EEA does not amount to putting them on the market: Case C-296/00 *Prefetto Provincia di Cuneo v Carbone* [2002] ECR I-4657, [2002] All ER (D) 480 (May), ECJ. Nor does offering goods for sale but not selling them; goods are put on the market in the EEA when they have been sold to an independent third party who acquires the right of disposal of the goods: Case C-16/03 *Peak Holding AB v Axolin-Elinor AB* [2005] Ch 261, [2004] ECR I-11313, ECJ. Where goods have been put on the market in the EEA, territorial restrictions on the purchaser's right to resell the goods do not preclude exhaustion of the proprietor's trade mark rights: Case C-16/03 *Peak Holding AB v Axolin-Elinor AB* supra. It is immaterial that the goods were manufactured in a non-EEA country if they have been put on the market in the EEA by the proprietor or with his consent: Case C-352/95 *Phytherion International SA v Jean Bourdon SA* [1997] ECR I-1729, [1997] FSR 936, ECJ. As to the EEA see PARA 102 note 6 ante.

5 Where the goods are put on the market in a country other than the United Kingdom, it is immaterial whether or not the trade mark is registered in that country; all that matters is whether the goods are put on the market by or with the consent of the proprietor of the United Kingdom registration: cf Case C-187/80 *Merck & Co Inc v Stephar BV* [1981] ECR 2063, [1982] FSR 57, ECJ (a patent case). It seems likely that this provision will apply if the goods are put on the market under a sign which is 'identical' with the trade mark within the meaning of the Trade Marks Act 1994 s 10(1) (see PARAS 71 note 3, 86 ante): cf Case C-313/94 *Fratelli Graffione SNC v Ditta Fransa* [1996] ECR I-6039, [1997] 1 CMLR 925, ECJ (COTONELLE/COTTONELLE).

6 Trade Marks Act 1994 s 12(1) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 7(1)). For the meaning of references to doing anything with or without the consent of the proprietor of a registered trade mark see the Trade Marks Act 1994 s 28(3); and PARA 136 post.

For the purposes of s 12(1), marketing within the EEA by or with the consent of an economically-linked undertaking is deemed to be marketing by or with the consent of the proprietor: Case 9/93 *IHT Internationale*



*Heiztechnik GmbH v Ideal Standard GmbH* [1994] ECR I-2789, [1995] FSR 59, ECJ. This principle does not apply to goods put on the market outside the EEA: *Roche Products Ltd v Kent Pharmaceuticals Ltd* [2006] EWCA Civ 1775, [2007] ETMR 27, [2006] All ER (D) 318 (Dec); and see *Mastercigars Direct Ltd v Hunters & Frankau Ltd* [2007] EWCA Civ 176, [2007] RPC 565, [2007] ETMR 44.

The Trade Marks Act 1994 s 12 applies in relation to an existing registered mark as from 31 October 1994, subject to s 105, Sch 3 para 4(2) (see PARA 97 ante); Sch 3 para 4(1). The old law continues to apply in relation to infringements committed before that date: Sch 3 para 4(1). For the meaning of 'existing registered mark' see PARA 4 note 2 ante; and for the meaning of 'the old law' see PARA 4 note 3 ante.

7 Ibid s 12(2) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 7(2)). As to what can amount to such legitimate reasons see PARA 104 post.

8 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 13(1); and PARA 234 post.

9 Ie under the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') arts 28-30 (formerly arts 30-36; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ). As to the case law on free movement of goods see PARA 105 post.

10 Eg, unlike the defences under the EC Treaty, it appears to extend both to export from the United Kingdom to a non-EEA country (see PARA 102 ante) and also to purely internal transactions within the United Kingdom which involve no inter-state trade element. All that is required for the Trade Marks Act 1994 s 12(1) to operate is that the goods shall have been placed on the market within the EEA, which on the face of it includes placing them on the market within the United Kingdom.

11 See PARA 105 post. See eg the case where the trade mark owner uses different trade marks in the different markets and the parallel importer substitutes one mark for the other (see PARA 105 text and note 5 post).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(iii) Exhaustion of Rights and Related Defences/104. Legitimate reasons for the proprietor to oppose further dealings in the goods.

#### **104. Legitimate reasons for the proprietor to oppose further dealings in the goods.**

This exception to the statutory defence of exhaustion of rights under the Trade Marks Act 1994<sup>1</sup> is based upon<sup>2</sup> an exception to the rules on free movement of goods developed in the earlier case law<sup>3</sup> of the European Court of Justice. It was there established that the guarantee of origin provided by the presence of the trade mark means that the consumer or end user can be certain that the product has not been subject at a previous stage of marketing to interference by a third party, without the authorisation of the trade mark proprietor, in such a way as to affect the original condition of the product<sup>4</sup>. Accordingly, operations which interfere with or put at risk the original condition of the goods or which alter or interfere with their packaging may potentially give rise to legitimate reasons for the proprietor to oppose use of the mark on the affected goods<sup>5</sup>.

A trade mark owner may legitimately oppose the further marketing of a pharmaceutical product where a third party has repackaged it and re-affixed the trade mark<sup>6</sup>, unless the following five conditions are met<sup>7</sup>:

- 163 (1) it is established that the enforcement of the trade mark rights by the owner would contribute to the artificial partitioning of the markets between the member states<sup>8</sup>;
- 164 (2) it is shown that the repackaging cannot adversely affect the original condition of the product inside the packaging<sup>9</sup>;
- 165 (3) the new packaging clearly states who repackaged the product and the name of the manufacturer<sup>10</sup>;
- 166 (4) the presentation of the repackaged product is not such as to be liable to damage the reputation of the trade mark and of its owner; and in particular the packaging must not be defective, of poor quality or untidy; and
- 167 (5) the importer gives notice to the trade mark owner before the repackaged product is put on sale, and on demand supplies him with a specimen of the repackaged product<sup>11</sup>.

The same conditions apply where the third party has affixed an additional external label<sup>12</sup>.

Similar conditions apply to other types of goods<sup>13</sup>. Similar conditions also apply if, rather than repackaging the product, the parallel importer either removes and re-affixes or replaces labels bearing the trade mark<sup>14</sup>.

In general, the reseller of trade marked goods must not act unfairly in relation to the legitimate interests of the trade mark owner, in particular in a way which damages the reputation of the trade mark<sup>15</sup>; however, the trade mark owner cannot object to the resale of his goods in a physically unaltered state merely because he objects to the 'down market' nature of the trade channels through which they are sold or the mode of advertising used in the sector of the retail trade concerned, unless it is established that, given the specific circumstances of the case, the use of the trade mark for this purpose seriously damages the reputation of the trade mark<sup>16</sup>.

Where a trade mark is used in advertising genuine goods of the trade mark owner in a way to which he takes objection, the considerations which relate to the question of whether the trade mark owner has legitimate reasons to oppose that use are very similar to those relating to the

question of whether other permitted uses of a trade mark are in accordance with honest practices in industrial and commercial matters<sup>17</sup>.

A number of situations have been recognised by the courts in the past where the marketing of genuine goods originating from the owner of a trade mark can nonetheless give rise to an action for passing off, for example where secondhand or used goods are sold as new, or where old deteriorated goods are sold as fresh, or where outmoded or superseded goods are sold as current production. In all these situations previously recognised by the law of passing off, it is likely that the courts will hold that the proprietor of a registered trade mark has legitimate reasons for opposing use of his trade mark in relation to the goods concerned<sup>18</sup>.

The trade mark owner is not entitled to oppose the importation and resale of his goods unaltered from the state in which they were put on the market by him in one member state, because their quality differs from that of the goods sold by him under the mark in the market of importation<sup>19</sup>.

1    Ie the exception contained in the Trade Marks Act 1994 s 12(2) to the defence against infringement provided by s 12(1), which provisions are in turn based upon EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 7. As to this defence see PARA 103 ante.

2    Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* [1996] ECR I-3457, [1997] FSR 102, ECJ. In this case, the court stated that EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 7 reiterates the case law of the ECJ, and that it must be interpreted in the same way: see Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* supra at [31], [40].

3    Ie the rules on free movement of goods developed by the European Court of Justice under the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') arts 28-30 (formerly arts 30-36; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ): see PARA 105 post.

4    Case 102/77 *F Hoffman-La Roche & Co AG v Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH* [1978] ECR 1139, [1978] 3 CMLR 217, ECJ; Case 1/81 *Pfizer Inc v Eurim-Pharm GmbH* [1981] ECR 2913, [1982] 1 CMLR 406, ECJ. This function of the guarantee of origin has been reiterated by the European Court of Justice as applicable in the context of EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 7: see Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* [1996] ECR I-3457 at [47], [1997] FSR 102 at [47], ECJ; Case C-143/00 *Boehringer Ingelheim KG v Swingward Ltd* [2003] Ch 27 at [12], [2002] ECR I-3759 at [12], ECJ.

5    See Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* [1996] ECR I-3457, [1997] FSR 102, ECJ; Case C-379/97 *Pharmacia & Upjohn SA v Paranova A/S* [2000] Ch 571, [1999] ECR I-6927, ECJ; Case C-143/00 *Boehringer Ingelheim KG v Swingward Ltd* [2003] Ch 27, [2002] ECR I-3759, ECJ.

6    The position is the same if the parallel importer repackages the product in new external packaging which does not bear the trade mark but leaves intact the original internal packaging to which the trade mark was affixed by the proprietor (or which contains tablets or capsules to which the trade mark was affixed by the proprietor ('partial debranding')); but it appears that the position is otherwise if the parallel importer repackages the product in a manner which removes all traces of the trade mark ('complete debranding'), in which case there is no infringement: *Boehringer Ingelheim KG and Boehringer Ingelheim Pharma GmbH v Swingward Ltd* [2004] EWCA Civ 757, [2004] IP & T 1026, [2004] ETMR 65; but see note 7 infra.

7    Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* [1996] ECR I-3457 at [49], [1997] FSR 102 at [49], ECJ (restating the conditions stated in Case 102/77 *Hoffmann-La Roche v Centrafarm* [1978] ECR 1139 at [7], ECJ). The conditions have been refined in the subsequent cases of Case C-379/97 *Pharmacia & Upjohn SA (formerly Upjohn SA) v Paranova A/S* [2000] Ch 571, [1999] ECR I-6927, [1999] All ER (EC) 880, [2000] FSR 621, ECJ; Case C-143/00 *Boehringer Ingelheim KG v Swingward Ltd* [2003] Ch 27, [2002] ECR I-3759, ECJ; Case C-348/04 *Boehringer Ingelheim KG v Swingward Ltd (No 2)* [2007] All ER (D) 240 (Apr), ECJ; and see also Case E-3/02 *Paranova A/S v Merck & Co Inc* [2004] ETMR 1, EFTA Ct. The burden of proving compliance with conditions lies with the third party, but the burden with regard to conditions (2) and (4) in the text is only evidential: Case C-348/04 *Boehringer Ingelheim KG v Swingward Ltd (No 2)* supra.

8    This condition does not mean that it must be established that the trade mark owner deliberately sought to partition markets between member states: Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* [1996] ECR I-3457, [1997] FSR 102, ECJ. Instead, it means that it must be objectively necessary to replace the trade mark; the condition of necessity is satisfied if the prohibition on replacing the trade mark

hinders effective access to the markets of the importing member states. By contrast it is not satisfied if replacement of the trade mark is explicable solely by the parallel importer's desire to obtain a commercial advantage: Case C-379/97 *Pharmacia & Upjohn SA (formerly Upjohn SA) v Paranova A/S* [2000] Ch 571, [1999] ECR I-6927, [1999] All ER (EC) 880, [2000] FSR 621, ECJ. Repackaging is objectively necessary if, without such repackaging, effective access to the market concerned, or a substantial part of that market, must be considered to be hindered as a result of strong resistance from a significant proportion of consumers to overstickered pharmaceutical products: Case C-143/00 *Boehringer Ingelheim KG v Swingward Ltd* [2003] Ch 27, [2002] ECR I-3759, ECJ. The condition that repackaging must be necessary is directed solely at the fact of repackaging, not the manner and style: Case C-348/04 *Boehringer Ingelheim KG v Swingward Ltd (No 2)* [2007] All ER (D) 240 (Apr), ECJ. See also Case C-433/00 *Aventis Pharma Deutschland GmbH v Kohlpharma GmbH* [2002] ECR I-7761, [2003] All ER (EC) 78, ECJ (EEC regulations precluded bundling two packs of product together; it was for the national court to decide whether that made it necessary to repackage contents of two packs into one).

9 This is the case, in particular, where the importer has merely carried out operations involving no risk of the product being affected, eg the removal of blister packs, flasks, ampoules or inhalers from their original external packaging and their replacement in new external packaging, the fixing of stickers on the inner packaging, the addition of new user information or the insertion of an extra article; but the original condition of the product must not be indirectly affected, eg by the omission of important information or the provision of inaccurate information or by the fact that an extra article inserted by the parallel importer does not comply with the method of use and doses envisaged by the manufacturer: Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* [1996] ECR I-3457, [1997] FSR 102, ECJ.

10 This information must be stated in print such that a person with normal eyesight, exercising a normal degree of attentiveness, would be in a position to understand; similarly the origin of a extra article from a source other than the trade mark owner must be indicated in such a way as to dispel any impression that the trade mark owner is responsible for it; but it is not necessary to indicate the repackaging was carried out without the authorisation of the trade mark owner: Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb v Paranova A/S* [1996] ECR I-3457, [1997] FSR 102, ECJ.

11 Notice must be given by the importer, it being immaterial whether the trade mark owner is aware of the repackaging by other means; the period of notice depends on the circumstances but in general 15 working days is a reasonable infringement; if notice is not given that alone is sufficient for the importation to be an infringement: Case C-143/00 *Boehringer Ingelheim KG v Swingward Ltd* [2003] Ch 27, [2002] ECR I-3759, ECJ. Where a parallel importer has failed to give notice, every subsequent importation infringes; damages for such infringements may be claimed on the same basis as if the goods were spurious depending on the extent of the damage to the trade mark proprietor and the principle of proportionality: Case C-348/04 *Boehringer Ingelheim KG v Swingward Ltd (No 2)* [2007] All ER (D) 240 (Apr), ECJ.

12 Case C-348/04 *Boehringer Ingelheim KG v Swingward Ltd (No 2)* [2007] All ER (D) 240 (Apr), ECJ; but cf Case C-352/95 *Phytherion International SA v Jean Bourdon SA* [1997] ECR I-1729, [1997] FSR 936, ECJ.

13 Case C-349/95 *Frits Loendersloot (t/a F Loendersloot Internationale Expeditie) v George Ballantine & Son Ltd* [1997] ECR I-6227, [1998] 1 CMLR 1015, ECJ; *Sony Computer Entertainments Inc v Tesco Stores Ltd* [2000] ETMR 102.

14 Case C-349/95 *Frits Loendersloot (t/a F Loendersloot Internationale Expeditie) v George Ballantine & Son Ltd* [1997] ECR I-6227, [1998] 1 CMLR 1015, ECJ. In such a case the person carrying out the relabelling must use the means which make parallel trade feasible while causing as little prejudice as possible to the 'specific subject matter' of the trade mark right; thus if the original labels comply with the rules on labelling in the member state of importation, but those rules require additional information to be given, relabelling is not necessary since the mere application of a sticker with the additional information will suffice: *Loendersloot (t/a F Loendersloot Internationale Expeditie) v George Ballantine & Son Ltd* supra.

15 Case C-337/95 *Parfums Christian Dior SA v Evora BV* [1997] ECR I-6013, [1998] 1 CMLR 737 at [45], ECJ.

16 Case C-337/95 *Parfums Christian Dior SA v Evora BV* [1997] ECR I-6013, [1998] 1 CMLR 737 at [46]-[47], ECJ.

17 Case C-228/03 *Gillette Co v LA-Laboratories Ltd Oy* [2005] All ER (EC) 940, [2005] IP & T 1003, ECJ. As to such permitted uses and what amounts to honest practices see PARAS 93-96 ante.

18 For these situations under the law of passing off see PARA 317 heads (1), (3)-(7) post, together with the cases cited; but not para 317 head (2) post (as to which see note 19 infra).

19 Having chosen to put goods of different qualities out in different parts of the European Community single market, the trade mark owner must then face the consequence of goods of different qualities circulating round the market: Case 58/80 *Dansk Supermarked A/S v A/S Imerco* [1981] ECR 181, [1981] 3 CMLR 590, ECJ. See also EC Commission Decision 74/432 [1974] 2 CMLR D79 (Re Advocaat Zwarte Kip).

## UPDATE

### **104 Legitimate reasons for the proprietor to oppose further dealings in the goods**

TEXT AND NOTES--See Case C-348/04 *Boehringer Ingelheim KG v Swingward Ltd* [2008] All ER (EC) 411.

NOTES 9-12--A trade mark is not damaged by its removal from the product; whether a trade mark is damaged by repackaging or relabelling is a matter of fact for the court: *Glaxo Group Ltd v Dowelhurst Ltd (Nos 2 and 3)* [2008] EWCA Civ 83, [2008] IP & T 806.

NOTE 15--See also Case C-59/08 *Copad SA v Christian Dior Couture SA* [2009] Bus LR 1571, [2009] All ER (D) 193 (Apr), ECJ.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(iii) Exhaustion of Rights and Related Defences/105. Defence of free circulation of goods under the EC Treaty.

### **105. Defence of free circulation of goods under the EC Treaty.**

Apart from the statutory defence of exhaustion of rights under the Trade Marks Act 1994<sup>1</sup>, the case law of the European Court of Justice has established that, once goods bearing a particular trade mark have been placed on the market somewhere in the European Community with the proprietor's consent, he cannot use trade mark rights to prevent the free circulation in the single market of those goods under the trade mark applied to them<sup>2</sup>. This rule applies even where the quality of the goods sold by the proprietor under the trade mark differs between the national markets concerned<sup>3</sup>. It is legitimate for a third party to repackage or relabel the goods and to re-affix the trade mark in some circumstances<sup>4</sup>. Where the trade mark owner puts the same goods on the market in different member states under different trade marks, it is legitimate for the parallel importer to substitute the trade mark used in the state of importation in place of the trade mark which was applied to the goods by the trade mark owner in the country where they were placed on the market, if it is objectively necessary to replace the original trade mark in order that the product in question can be effectively marketed in that state by the parallel importer<sup>5</sup>.

This defence has no application to cases where the same or similar trade marks are used by unconnected proprietors in different member states, notwithstanding that the existence of such national rights may result in the effective partitioning of the single market<sup>6</sup>. In such cases it is for the national court to apply its ordinary rules in assessing the question of confusing similarity between the marks; and the European Court of Justice cannot interfere with such findings of fact which are in the exclusive jurisdiction of the national court<sup>7</sup>. However, for the purposes of European Community law, different corporate entities within a group of companies are generally treated as part of a single undertaking, together with economically linked entities such as licensees. Thus the rules stated above regarding free movement of goods apply regardless of whether the trade mark rights in different member states are vested in the same corporate entity or in economically-linked undertakings<sup>8</sup>. It is permissible, however, to assign trade marks in some, but not all, member states to an economically unconnected undertaking and in those member states the assigned marks may be enforceable against goods of the assignor and vice versa<sup>9</sup>. The former rule that trade mark rights were unenforceable in respect of the use of the same mark upon goods imported from another member state where the mark on the imported goods had a common origin with that of the proprietor has been departed from by the European Court of Justice<sup>10</sup>.

The rules stated above apply in general to the other member countries of the European Economic Area ('EEA')<sup>11</sup> in the same way as to countries of the European Community<sup>12</sup>. Those rules do not, however, apply in the same way to countries which merely have association agreements with the European Community<sup>13</sup>, despite the fact that the wording of the relevant association agreement may be similar or identical to the provisions of the EC Treaty mentioned above<sup>14</sup>.

The rules stated above do not apply in relation to goods first marketed outside the European Community or the EEA<sup>15</sup>.

1    Ie the Trade Marks Act 1994 s 12: see PARA 103 ante.

2     In applying the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') arts 28-30 (formerly arts 30-36; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ) on the free circulation of goods, which have direct effect within member states. See eg Case 119/75 *Terrapin (Overseas) Ltd v Terranova Industrie CA Kapferer & Co* [1976] ECR 1039 at 1061, [1976] 2 CMLR 482 at 505-506, ECJ (trade mark case); Case 187/80 *Merck & Co Inc v Stephar BV* [1981] ECR 2063, [1981] 3 CMLR 463, ECJ (a patent case).

3     See PARA 104 note 19 ante.

4     He may need to do this eg to comply with different labelling or packaging regulations or different market expectations in the country of importation. As to the circumstances in which repackaging or relabelling and re-affixing of the trade mark may be undertaken see PARA 104 ante.

5     Case C-379/97 *Pharmacia & Upjohn SA (formerly Upjohn SA) v Paranova A/S* [2000] Ch 571, [1999] ECR I-6927, [1999] All ER (EC) 880, [2000] FSR 621, ECJ; see PARA 104 note 8 ante. This situation is outside the defence provided by the Trade Marks Act 1994 s 12 and EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 7, since those provisions only cover the further use (or re-affixing) of the same mark as that put on the goods by the trade mark owner, not the substitution of a different mark of the same owner: Case C-379/97 *Pharmacia & Upjohn SA (formerly Upjohn SA) v Paranova A/S* supra at [27]-[28]. For the statutory defence see PARAS 103-104 ante.

6     Case 119/75 *Terrapin (Overseas) Ltd v Terranova Industrie CA Kapferer & Co* [1976] ECR 1039 at 1061, [1976] 2 CMLR 482 at 505-506, ECJ (trade mark case).

7     Case C-317/91 *Deutsche Renault AG v Audi AG* [1993] ECR I-6227, [1995] 1 CMLR 461, ECJ. However, such national rules have been harmonised by EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 5 and the European Court of Justice does have jurisdiction to interpret this.

8     Case C-9/93 *IHT Internationale Heiztechnik GmbH v Ideal-Standard GmbH* [1995] FSR 59, [1994] 3 CMLR 377, ECJ.

9     Case C-9/93 *IHT Internationale Heiztechnik GmbH v Ideal-Standard GmbH* [1995] FSR 59, [1994] 3 CMLR 377, ECJ. It appears that a further reference to the European Court of Justice may be required to elucidate the dividing line between ownership of trade marks by economically-linked parties and ownership of trade marks by independent parties as a result of assignment: *Doncaster Pharmaceuticals Ltd v Bolton Pharmaceutical Co 100 Ltd* [2006] EWCA Civ 661, [2006] ETMR 65.

10    Case C-10/89 *SA CNL-Sucal NV v Hag GF AG* [1990] ECR I-3711, [1990] 3 CMLR 571, [1991] FSR 99, ECJ (overruling Case 192/73 *Van Zuylen Frères v Hag AG* [1974] ECR 731, [1974] 2 CMLR 127).

11    As to the EEA see PARA 102 note 6 ante.

12    The Agreement on the European Economic Area (Oporto, 2 May 1992; Cm 2073; OJ L1, 3.1.94, p 3) (the 'EEA Agreement') arts 10-13 correspond to the EC Treaty arts 28-30 (formerly arts 30-36; as renumbered: see note 2 supra). The provisions of the EEA Agreement which correspond substantially to provisions of the EC Treaty are to be interpreted in conformity with the relevant rulings of the European Court of Justice given prior to 2 May 1992: Agreement on the European Economic Area art 6.

13    Eg Switzerland.

14    Case 270/80 *Polydor Ltd v Harlequin Record Shops Ltd* [1982] ECR 329, [1982] 1 CMLR 677, ECJ (where the association agreement between the European Community and Portugal was interpreted as not giving rise to a right to parallel import, despite the similarity of its wording with that of the EC Treaty arts 28, 30 (formerly arts 30, 36; as renumbered: see note 2 supra), having regard to the different objects and purposes of the association agreement from the EC Treaty).

15    Case 51/75 *EMI Records Ltd v CBS United Kingdom Ltd* [1976] ECR 811, [1976] 2 CMLR 235, ECJ. See PARA 107 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(iii) Exhaustion of Rights and Related Defences/106. Other defences under the EC Treaty.

#### **106. Other defences under the EC Treaty.**

The enforcement of trade mark rights so as to discriminate between imports from different member states may not be permissible as amounting<sup>1</sup> to an 'arbitrary discrimination'<sup>2</sup>. A deliberate decision to use different trade marks in different member states so as to achieve a partition is probably a disguised restriction on trade between member states and the enforcement of the trade mark rights would not be permitted<sup>3</sup>. It is not permissible to use trade mark rights as a means to achieve market sharing or partitioning of the single market<sup>4</sup>. It is not clear whether any of the reasoning in the earlier cases<sup>5</sup> survives, though it is likely that an exclusive right may not be relied upon if it is connected with an agreement or practice in restraint of competition within the European Community<sup>6</sup>.

1     I.e. within the meaning of the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') art 30 (formerly art 36; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ).

2     Case 102/77 *Hoffmann-La Roche & Co AG v Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH* [1978] ECR 1139, [1978] 3 CMLR 217, [1978] FSR 598, ECJ.

3     Case 3/78 *Centrafarm BV v American Home Products Corp* [1978] ECR 1823, [1979] 1 CMLR 326, [1979] FSR 189, ECJ.

4     Case C-9/93 *IHT Internationale Heiztechnik GmbH v Ideal-Standard GmbH* [1995] FSR 59, [1994] 3 CMLR 377, ECJ (following the principles in Cases 56/64, 58/64 *Etablissements Consten Sarl and Grundig-Verkaufs-GmbH v EC Commission* [1966] ECR 299, [1966] CMLR 418, ECJ).

5     I.e. cases based on the EC Treaty art 81 (formerly art 85; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ). See in particular Case 40/70 *Sirena Srl v Eda Srl* [1971] ECR 69, [1971] CMLR 260, ECJ (which may perhaps be explained as a case based on some sort of continued market sharing conduct: see Case 86/75 *EMI Records Ltd v CBS Grammfon A/S* [1976] ECR 871, [1976] 2 CMLR 235, ECJ).

6     Case 144/81 *Keurkoop BV v Nancy Kean Gifts BV* [1982] ECR 2853, [1983] 2 CMLR 47, [1983] FSR 381, ECJ.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(iii) Exhaustion of Rights and Related Defences/107. Parallel imports from outside the European Community or the European Economic Area.

### **107. Parallel imports from outside the European Community or the European Economic Area.**

The European Court of Justice has held that the Trade Marks Directive<sup>1</sup> cannot be interpreted as leaving it open to the member states to provide in their domestic law for exhaustion of the rights conferred by a trade mark in respect of products put on the market in non-member countries; and that such exhaustion occurs only where the products have been put on the market<sup>2</sup> in the European Economic Area ('EEA')<sup>3</sup> by the proprietor or with his consent<sup>4</sup>. That consent must be to the placing on the market of the goods concerned<sup>5</sup>, not other similar goods of the trade mark owner<sup>6</sup>. Consent will normally be express, but it is conceivable that it may in some cases be inferred from facts and circumstances prior to, simultaneous with, or subsequent to, the placing of the goods on the market outside the EEA which unequivocally demonstrate that the proprietor has renounced his right to oppose the placing of the goods on the market within the EEA<sup>7</sup>. Consent cannot be inferred from:

- 168 (1) the fact that the proprietor has not communicated to all subsequent purchasers of the goods placed on the market outside the EEA his opposition to marketing within the EEA;
- 169 (2) the fact that the goods carry no warning of a prohibition on their being placed on the market within the EEA;
- 170 (3) the fact that the proprietor has transferred the ownership of the goods bearing the trade mark without imposing any contractual restrictions and that, according to the law governing the contract, the property right transferred includes, in the absence of such reservations, an unlimited right of resale or, at the very least, a right to market the goods subsequently within the EEA<sup>8</sup>.

It is consistent with the Trade Marks Directive for national law to provide that it is for the party relying upon the defence of exhaustion of rights to prove the conditions for such exhaustion<sup>9</sup>. Where, however, the defendant succeeds in establishing that there is a real risk of partitioning of national markets if he himself bears that burden of proof, particularly where the trade mark proprietor markets his products in the EEA using an exclusive distribution system, it is for the proprietor to establish that the products were initially placed on the market outside the EEA by him or with his consent; if such evidence is adduced, it is for the defendant to prove the consent of the trade mark proprietor to subsequent marketing of the products in the EEA<sup>10</sup>.

1    le EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks. As to the Trade Marks Directive see PARA 5 ante.

2    As to the meaning of 'put on the market' see PARA 103 note 4 ante.

3    As to the EEA see PARA 102 note 6 ante.

4    Case C-355/96 *Silhouette International Schmied GmbH & Co KG v Hartlauer Handelsgesellschaft mbH* [1999] Ch 77, [1998] ECR I-4799, [1998] All ER (EC) 769, [1998] FSR 729, ECJ. Consent by an economically-linked party is not sufficient for this purpose: *Honda Motor Co Ltd v Neesam* [2006] EWHC 1051 (Ch), [2006] All ER (D) 371 (Mar); and see *Mastercigars Direct Ltd v Hunters & Frankau Ltd* [2007] EWCA Civ 176, [2007] RPC 565, [2007] ETMR 44.

5 le the actual parallel imported goods themselves.

6 Case C-173/98 *Sebago Inc v GB-Unic SA* [1999] ECR I-4103, [2000] Ch 558, [1999] All ER (EC) 575, ECJ.

7 Joined Cases C-414/99 to C-416/99 *Zino Davidoff SA v A & G Imports Ltd* [2002] Ch 109, [2001] ECR I-8691, ECJ. This is a high hurdle: see *Quiksilver PTY Ltd v Charles Robertson (Developments) Ltd (t/a Trago Mills)* [2004] EWHC 2010 (Ch), [2005] FSR 139; *Kabushiki Kaisha Sony Entertainment v Nuplayer Ltd* [2005] EWHC 1522 (Ch), [2006] FSR 9, [2005] All ER (D) 188 (Jul); *Hewlett-Packard Development Co LP v Expansys United Kingdom Ltd* [2005] EWHC 1495 (Ch), [2005] All ER (D) 170 (Jul); *Kabushiki Kaisha Sony Computer Entertainment v Electricbirdland Ltd* [2005] EWHC 2296 (Ch), [2005] All ER (D) 73 (Aug); *Sun Microsystems Inc v Amtec Computer Corp Ltd* [2006] EWHC 62 (Ch), [2006] FSR 630; *Honda Motor Co Ltd v Neesam* [2006] EWHC 1051 (Ch), [2006] All ER (D) 371 (Mar); *Roche Products Ltd v Kent Pharmaceuticals Ltd* [2006] EWCA Civ 1775, [2007] ETMR 27, [2006] All ER (D) 318 (Dec); cf *Mastercigars Direct Ltd v Hunters & Frankau Ltd* [2007] EWCA Civ 176, [2007] RPC 565, [2007] ETMR 44.

8 Joined Cases C-414/99 to C-416/99 *Zino Davidoff SA v A & G Imports Ltd* [2002] Ch 109, [2001] ECR I-8691, ECJ.

9 Case C-244/00 *Van Doren + Q GmbH v Lifestyle sports + sportswear Handelgesellschaft mbH* [2003] ECR I-3051, [2004] All ER (EC) 912, ECJ.

10 Case C-244/00 *Van Doren + Q GmbH v Lifestyle sports + sportswear Handelgesellschaft mbH* [2003] ECR I-3051, [2004] All ER (EC) 912, ECJ.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(4) INFRINGEMENT OF REGISTERED TRADE MARKS AND PROTECTED INTERNATIONAL TRADE MARKS (UK)/(iv) Suspension of Trade Mark Rights of Enemy or Enemy Subject/108. In general.

#### **(iv) Suspension of Trade Mark Rights of Enemy or Enemy Subject**

##### **108. In general.**

Where, on application made by a person proposing to supply goods or services of any description, it is made to appear to the registrar<sup>1</sup>:

- 171 (1) that it is difficult or impracticable to describe or refer to the goods or services without the use of a registered trade mark; and
- 172 (2) that the proprietor of the registered trade mark, whether alone or jointly with another, is an enemy or an enemy subject,

the registrar may make an order suspending the rights given by the registered trade mark<sup>2</sup>. Such an order suspends those rights as regards the use of the trade mark:

- 173 (a) by the applicant; and
- 174 (b) by any person authorised by the applicant to do, for the purposes of or in connection with the supply by the applicant of the goods or services, things which would otherwise infringe the registered trade mark,

to such extent and for such period as the registrar considers necessary to enable the applicant to render well known and established some other means of describing or referring to the goods or services in question which does not involve the use of the trade mark<sup>3</sup>.

Where such an order has been made, no action for passing off<sup>4</sup> lies on the part of any person interested in the registered trade mark in respect of any use of it which by virtue of the order is not an infringement of the right conferred by it<sup>5</sup>. Such an order may be varied or revoked by a subsequent order made by the registrar<sup>6</sup>.

1 As to the registrar see PARA 17 ante.

2 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 3(1) (substituted by the Trade Marks Act 1994 s 106(1), Sch 4 para 3(1), (2)); Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 10(1) (amended by the Trade Marks Act 1994 Sch 4 para 3(1), (3)(d)).

3 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 3(2) (substituted by the Trade Marks Act 1994 Sch 4 para 3(1), (2)); Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 10(1) (as amended: see note 2 supra).

4 As to passing off see PARA 304 et seq post.

5 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 3(3) (substituted by the Trade Marks Act 1994 Sch 4 para 3(1), (2)).

6 Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 3(4) (substituted by the Trade Marks Act 1994 Sch 4 para 3(1), (2)); Patents, Designs, Copyright and Trade Marks (Emergency) Act 1939 s 10(1) (as amended: see note 2 supra).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(i) Introduction/109. Modes of extinction or modification of registered trade marks and protected international trade marks (UK).

## **(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION**

### **(i) Introduction**

#### **109. Modes of extinction or modification of registered trade marks and protected international trade marks (UK).**

The Trade Marks Act 1994 provides a number of ways in which the rights conferred by a registered trade mark may be cancelled or varied<sup>1</sup>. It uses the following terminology:

- 175 (1) 'surrender' for voluntary surrender by the proprietor<sup>2</sup>;
- 176 (2) 'revocation' for removal of a registration on grounds which have arisen since registration<sup>3</sup>;
- 177 (3) 'declaration of invalidity' for cases where the mark ought not to have been registered originally<sup>4</sup>;
- 178 (4) 'rectification' for corrections concerning errors or omissions from the register other than matters concerned with validity<sup>5</sup>;
- 179 (5) 'alteration'<sup>6</sup>; and
- 180 (6) 'disclaimer' and 'limitation'<sup>7</sup>.

Except where proceedings concerning the trade mark in question are pending in the court<sup>8</sup>, when the application must be made to the court, applications for revocation, declarations of invalidity or rectification may be made either to the registrar or to the court<sup>9</sup>. Applications for surrender, alteration, disclaimers or limitations can only be made to the registrar<sup>10</sup>.

These provisions also apply to protected international trade marks (UK)<sup>11</sup> although in some respects the terminology differs<sup>12</sup>.

1    le apart from lapse for failure to pay renewal fees: see PARA 29 ante.

2    See PARAS 113, 395 post.

3    See PARAS 114-117, 398-399, 458 post.

4    See PARAS 118-120, 400, 458-459 post.

5    See PARAS 121, 401, 458 post.

6    See PARAS 122, 393 post.

7    See PARAS 83, 98 ante, 394 post.

8    For the meaning of 'the court' see PARA 349 post.

9    See the Trade Marks Act 1994 ss 46(4), 47(3), 64(2); and PARA 396 post. See also the Community Trade Mark Regulations 2006, SI 2006/1027, reg 3(1); and PARA 288 post.

10 As to surrender see *ibid* s 45(2); the Trade Marks Rules 2000, SI 2000/136, r 26(1); and PARA 113 post. As to alteration see the Trade Marks Act 1994 s 44(2); and PARA 122 post. As to disclaimers or limitations see s 13(2); the Trade Marks Rules 2000, SI 2000/136, r 24; and PARA 83 ante.

11 For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

12 See PARAS 83 ante, 114 et seq post.

## **UPDATE**

### **109 Modes of extinction or modification of registered trade marks and protected international trade marks (UK)**

NOTE 10--SI 2000/136 rr 24, 26 now Trade Marks Rules 2008, SI 2008/1797, rr 31, 33.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(i) Introduction/110. Onus of proof; presumption of validity of original registration.

**110. Onus of proof; presumption of validity of original registration.**

Whenever a registered trade mark is under attack, then under normal principles the onus of proof will lie on the attacker<sup>1</sup>. In addition it is specifically provided that in all legal proceedings relating to a registered trade mark<sup>2</sup>, including proceedings for rectification of the register, the registration<sup>3</sup> of a person as proprietor of a trade mark is prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission<sup>4</sup> of it<sup>5</sup>.

In all legal proceedings relating to an international trade mark (UK)<sup>6</sup>, the registration of a person as holder of an international trade mark (UK) is prima facie evidence of the validity of the original international registration and of any subsequent assignment or other transaction of it<sup>7</sup>. There is however no statutory presumption of the validity of its protected status in the United Kingdom<sup>8</sup>.

1 Ie save for the exception that the onus of proof of use of a registered trade mark lies on the proprietor: see the Trade Marks Act 1994 s 100; and PARA 114 text and note 14 post.

2 As to the meaning of 'registered trade mark' see PARA 127 post.

3 For the meaning of 'registration' see PARA 19 note 2 ante.

4 As to assignment or other transmission of a registered trade mark see PARA 129 et seq post.

5 Trade Marks Act 1994 s 72.

6 For the meaning of 'international trade mark (UK)' see PARA 8 note 17 ante.

7 Trade Marks (International Registration) Order 1996, SI 1996/714, art 27(1). Provision is made for judicial notice to be taken of copies of entries in the international register: art 27(2). For the meaning of 'international register' see PARA 12 note 2 ante.

8 Ibid art 27(1) refers to the validity of only the original international registration; and the Trade Marks Act 1994 s 72 has not been applied to international trade marks by the Trade Marks (International Registration) Order 1996, SI 1996/714.

**UPDATE**

**110 Onus of proof; presumption of validity of original registration**

NOTES 7, 8--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(i) Introduction/111. Absence of discretion.

### **111. Absence of discretion.**

By contrast with the position under the Trade Marks Act 1938<sup>1</sup>, if an applicant for revocation of a trade mark (or, it would seem, for a declaration of invalidity<sup>2</sup> or for rectification) establishes that there are grounds for revocation (or invalidity or rectification) of the mark in whole or in part<sup>3</sup>, the registrar or the court<sup>4</sup> has no discretion to refuse the order sought even though the relevant statutory provisions<sup>5</sup> use the word 'may'<sup>6</sup>.

1 See *Re Magneta Time Co Ltd's Trade Mark* (1927) 44 RPC 169; cf *Re Somerlite Ltd's Trade Mark* (No 520,004), *Somerlite Ltd v Brown* (1934) 51 RPC 205, CA.

2 Mandatory words are used in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, arts 3, 4 (from which the Trade Marks Act 1994 s 47 is derived). However, see also *Associated Newspapers Ltd v Express Newspapers* [2003] EWHC 1322 (Ch), [2004] IP & T 378, [2003] FSR 909.

3 As to the grounds for revocation generally see PARA 114 et seq post; as to the grounds for a declaration of invalidity generally see PARA 118 et seq post; and as to the grounds for rectification generally see PARA 121 post. As to the additional grounds for revocation or invalidity of a collective mark see PARAS 163-164 post; and as to the additional grounds for revocation or invalidity of a certification mark see PARAS 174-175 post.

4 As to the registrar see PARA 17 ante. For the meaning of 'the court' see PARA 349 post.

5 The relevant statutory provisions are the Trade Marks Act 1994 s 46(1) (see PARA 114 post), s 47(1), (2) (see PARA 118 post) and s 64(1) (see PARA 121 post).

6 *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] IP & T 218, [2000] FSR 767; *Scandecor Development AB v Scandecor Marketing AB* [2001] UKHL 21, [2001] IP & T 676, [2002] FSR 122 (question referred to European Court of Justice for ruling but case settled before ruling given). Cf the corresponding provision in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (the 'Community Trade Mark Regulation'): see PARA 238 note 2 post.

## **UPDATE**

### **111 Absence of discretion**

NOTE 6--However, the court has discretion to delay the grant of a declaration pending an appeal or an application for invalidity or revocation: *Rousselon Freres et Cie v Horwood Homewares* [2008] EWHC 1660 (Ch), [2009] IP & T 625.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(i) Introduction/112. Effective date of revocation, declaration of invalidity or rectification.

### **112. Effective date of revocation, declaration of invalidity or rectification.**

Where the registration of a trade mark is revoked to any extent<sup>1</sup>, the rights of the proprietor are deemed to have ceased to that extent as from the date of the application for registration<sup>2</sup> or, if the registrar or the court<sup>3</sup> is satisfied that the grounds for revocation existed at an earlier date, that date<sup>4</sup>. Where the protection of an international trade mark (UK)<sup>5</sup> is revoked, the rights of the proprietor are deemed to have ceased to exist as from the date on which the revocation is recorded in the international register<sup>6</sup>.

Where the registration of a trade mark is declared invalid to any extent<sup>7</sup>, the registration is to that extent deemed never to have been made; but this provision does not affect transactions past and closed<sup>8</sup>. The same obtains when the protection of an international trade mark (UK) is declared invalid<sup>9</sup>.

Except where the registrar or the court directs otherwise, the effect of rectification of the register<sup>10</sup> is that the error or omission in question is deemed never to have been made<sup>11</sup>.

1 As to the grounds for revocation generally see PARA 114 et seq post; as to the additional grounds for revocation of a collective mark see PARA 163 post; and as to the additional grounds for revocation of a certification mark see PARA 174 post.

2 For the meaning of 'registration' see PARA 19 note 2 ante.

3 As to the registrar see PARA 17 ante. For the meaning of 'the court' see PARA 349 post.

4 Trade Marks Act 1994 s 46(6) (which has no antecedent in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks). It is not appropriate to grant an injunction prohibiting use of an infringing sign if the trade mark has been revoked: Case C-145/05 *Levi Strauss & Co v Casucci Spa* [2007] FSR 170, [2006] ETMR 71, ECJ. If the applicant for revocation seeks to revoke the trade mark from a date earlier than the application date he must plead the date as of which revocation is sought and explicitly allege that grounds for revocation existed at that date: see PARA 398 note 4 post.

5 For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

6 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13(5)(a). For the meaning of 'international register' see PARA 12 note 2 ante.

7 As to the grounds for a declaration of invalidity see PARA 118 et seq post; as to the additional grounds for invalidity of a collective mark see PARA 164 post; and as to the additional grounds for invalidity of a certification mark see PARA 175 post.

8 Trade Marks Act 1994 s 47(6) (which has no antecedent in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1)).

9 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13(5)(b).

10 As to the grounds for rectification generally see PARA 121 post.

11 Trade Marks Act 1994 s 64(3).

## **UPDATE**

### **112 Effective date of revocation, declaration of invalidity or rectification**



NOTES 6, 9--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/ (ii) Surrender/113. In general.

## **(ii) Surrender**

### **113. In general.**

A registered trade mark<sup>1</sup> may be surrendered by the proprietor<sup>2</sup> in respect of some or all of the goods or services for which it is registered<sup>3</sup>. Surrender has effect from the date on which the registrar<sup>4</sup> makes and publishes the appropriate entry in the register<sup>5</sup>.

The person in whose name an international trade mark registration stands may at any time remove protection in one or more contracting countries<sup>6</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 post.

2 For the meaning of 'proprietor' see PARA 22 note 8 ante.

3 See the Trade Marks Act 1994 s 45; the Trade Marks Rules 2000, SI 2000/136, r 26; and PARA 395 post.

4 As to the registrar see PARA 17 ante.

5 See the Trade Marks Rules 2000, SI 2000/136, r 26(3); and PARA 395 post. See also *RAPIER Trade Mark* (O/170/07), Appointed Person. Surrender does not render a pending application for revocation or invalidity moot or academic: see *RAPIER Trade Mark* supra. Cf the position in proceedings before the Office for Harmonisation in the Internal Market: see PARA 236 text and note 5 post. If notice of surrender is given during rectification proceedings affecting proprietorship, the registrar or the court will determine those first before considering whether to accept the surrender: *Skaga AB's Trade Mark Application* (O/134/03), Trade Marks Registry.

6 Madrid Agreement Concerning the International Registration of Marks (Madrid, 14 April 1891; TS 71 (1970); Cmnd 4437), as revised at Stockholm in 1967 and as amended in 1979, art 8 (bis). As to the Madrid Agreement see PARA 8 ante. A declaration is filed at the office in his home country for commutation to the International Bureau of the World Intellectual Property Organisation ('WIPO'), which in turn notifies the countries where protection has been removed. As to the International Bureau see PARA 8 text and note 2 ante.

## **UPDATE**

### **113 In general**

NOTES 3, 5--SI 2000/136 r 26 now Trade Marks Rules 2008, SI 2008/1797, r 33.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(iii) Revocation/114. Non-use.

### (iii) Revocation

#### 114. Non-use.

The registration of a trade mark<sup>1</sup> may<sup>2</sup> be revoked on either of the following grounds<sup>3</sup>:

- 181 (1) that within the period of five years<sup>4</sup> following the date of completion of the registration procedure<sup>5</sup> it has not been put to genuine<sup>6</sup> use<sup>7</sup> in the United Kingdom, by the proprietor or with his consent<sup>8</sup>, in relation to the goods or services for which it is registered<sup>9</sup>, and there are no proper reasons<sup>10</sup> for non-use<sup>11</sup>;
- 182 (2) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use<sup>12</sup>.

These grounds also apply to the revocation of protection of a protected international trade mark (UK)<sup>13</sup>.

The registration of a trade mark may not, however, be revoked on the grounds mentioned in head (1) or head (2) above if such use as is there referred to is commenced or resumed after the expiry of the five year period and before the application for revocation is made<sup>14</sup>; but any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application is to be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made<sup>15</sup>.

If in any civil proceedings under the Trade Marks Act 1994 a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it<sup>16</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 As to the absence of discretion see PARA 111 ante.

3 Trade Marks Act 1994 s 46(1).

4 The correct approach to calculating this period is that not less than five complete years must elapse during which the trade mark is registered but not genuinely used. It follows that the five year period cannot start until the day after the date on which the registration procedure is completed and must have ended not later than the day before the date on which the application is filed: *BSA BY R2 Trade Mark* (O/144/07), Appointed Person; Tribunal Practice Notice (TPN 1/2007).

5 The date of completion of the registration procedure must be determined in accordance with national procedural rules: Case C-246/05 *Hauptl v Lidl Stiftung & Co KG* [2007] All ER (D) 140 (Jun), ECJ. In the United Kingdom this is the date on which the registrar enters the registration on the register: see the Trade Marks Act 1994 s 40; the Trade Marks Rules 2000, SI 2000/136, r 16; and PARA 388 post.

6 There is 'genuine use' of a trade mark where the trade mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2005] Ch 97, [2003] ECR I-2439, ECJ; Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159, [2004] FSR 785, ECJ (and for the Court of Appeal decision implementing this ruling see *LABORATOIRE DE LA MER Trade Mark* [2005] EWCA Civ 978, [2006] FSR 49). When assessing whether use of the

trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of the use of the mark: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* supra; Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* supra. Classification of use of the mark as genuine use depends on consideration of the circumstances which pertain during the relevant period, but account may be taken of circumstances subsequent to that period which make it possible to better assess the extent to which the trade mark was used during that period and the real intentions of the proprietor during that period: Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* supra.

Genuine use of the mark entails use on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned; use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are underway, particularly in the form of advertising campaigns: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* supra; Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* supra.

Use of the mark may in some cases be sufficient to establish genuine use even if that use is not quantitatively significant; even minimal use can therefore be sufficient to qualify as genuine; a de minimis rule cannot be laid down: Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* supra; Case C-416/04P *The Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, [2006] All ER (D) 178 (May), ECJ (this case considered the question of genuine use under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 43(2), (3) (see PARA 282 post)). Use of the mark by a single client which imports the products for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark: Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* supra; *LABORATOIRE DE LA MER Trade Mark* supra (held importation of small quantities of product by one importer was genuine use); Case C-416/04P *The Sunrider Corp v Office for Harmonisation in the Internal Market* supra.

In assessing whether use is genuine the territorial scope of the use is a relevant factor: Case C-416/04P *The Sunrider Corp v Office for Harmonisation in the Internal Market* supra. Use of a trade mark on a foreign website is not sufficient to establish use in the United Kingdom: *CARTE BLEUE Trade Marks* [2002] RPC 599, Trade Marks Registry. The size of the proprietor's undertaking is also a relevant factor: *POLICE Trade Mark* [2004] RPC 693, Appointed Person.

There may be genuine use of mark even though it has been used in conjunction with other trade marks: Case T-29/04 *Castelblanch SA v Office for Harmonisation in the Internal Market* [2005] ECR II-5309, [2006] ETMR 61, CFI (this case considered the question of genuine use under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, ie art 43(2), (3) (see PARA 282 post)).

Use of the mark may be genuine even if the goods in respect of which it is registered are no longer available, eg if the proprietor makes use of the same mark for component parts of those goods or for goods and services directly connected with those goods: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* supra.

In considering case law on genuine use, care needs to be taken with decisions of the CFI on cases arising under EC Council Regulation (OJ L11, 14.1.94, p 1) art 43(2), (3) since EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 22 (as substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)) specifies with some precision the nature and form of the evidence that the trade mark proprietor is required to furnish in such cases: see *EXTREME Trade Mark* (O/161/07), Appointed Person; and PARA 282 post.

7 For these purposes (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered; and (2) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes: Trade Marks Act 1994 s 46(2) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 10(2)). Head (1) supra involves a two stage inquiry: first, identify the differences between the mark as used and the mark as registered; and, second, assess whether they alter the distinctive character of the mark as registered, which should be assessed in the usual way through the perception of the average consumer of the goods or services in question (see PARA 60 note 3 ante): *Anheuser-Busch Inc v Budejovický Budvar Narodní Podnik* [2002] EWCA Civ 1534, sub nom *BUD and BUDWEISER BUDBRÁU Trade Marks* [2003] RPC 477. Changes to non-distinctive elements of a complex mark do not alter its distinctive character: Case T-135/04 *GfK AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ETMR 58, [2005] All ER (D) 338 (Nov), CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) ie art 43(2), (3) (see PARA 282 post)); Case T-147/03 *Devinlec Développement Innovation Leclerc SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] IP & T 436, [2006] All ER (D) 36 (Jan), CFI (decided under the equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) ie art 43(2), (3) (see PARA 282 post)); *NIRVANA Trade Mark* (O/262/06), Appointed Person. This provision does not permit the proprietor to rely upon use of a similar mark covered by a separate registration: Case T-194/03 *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR II-445, CFI (decided under the

equivalent provision of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) ie art 43(2), (3) (see PARA 282 post)); but see Case C-353/03 *Société des Produits Nestlé SA v Mars UK Ltd* [2005] ECR I-6135, [2006] All ER (EC) 348, ECJ; and *NIRVANA Trade Mark* supra. For the meaning of 'use' generally see PARA 60 note 8 ante; and for the meaning of 'United Kingdom' see PARA 3 note 2 ante.

8 It is immaterial for this purpose whether the proprietor imposes quality control on users of the mark, although this may be relevant to an objection under the Trade Marks Act 1994 s 46(1)(d) (see PARA 116 post): *SAFARI Trade Mark* [2002] RPC 497, Trade Marks Registry; *EINSTEIN Trade Mark* [2007] RPC 539, Appointed Person. Mere acquiescence by the proprietor in use by a third party does not constitute use with the proprietor's consent: *NIRVANA Trade Mark* (O/030/06), Trade Marks Registry; affd on other grounds (O/262/06), Appointed Person.

9 The trade mark is used 'in relation to' goods if it conveys to members of the public that the proprietor of the mark is in some way responsible for the quality of the goods, even if the goods are promotional items: *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218 (use of famous mark for tea on tea-towels, utensils etc); *DaimlerChrysler AG v Alavi (t/a Merc)* [2001] RPC 42, [2002] IP & T 496 (use of famous mark for cars on items of clothing). See also *ELLE Trade Marks* [1997] FSR 529, sub nom *Safeways Stores plc v Hachette Filipachi Presse* [1996-97] ETMR 552 (promotion of cosmetics in a magazine not use of name of magazine in relation to those goods); *Trebor Bassett Ltd v The Football Association* [1997] FSR 211 (mark on jerseys of footballers not used in relation to photographs of those footballers).

10 Cf the Agreement on Trade-Related Aspects of Intellectual Property (TRIPs) (1994) (Cm 2557) art 19(1), which provides that circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other governmental requirements for goods or services protected by the trademark, are to be recognised as valid reasons for non-use. As to TRIPs generally see PARA 7 ante. Obstacles having a direct relationship with the trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of the trade mark constitute proper reasons for non-use: Case C-246/05 *Haupt v Lidl Stiftung & Co KG* [2007] All ER (D) 140 (Jun), ECJ. In order to establish 'proper reasons' for non-use, it is necessary for the tribunal to be satisfied that in the absence of the suggested impediments to use there could and would have been genuine use of the trade mark during the relevant five year period: *CERNIVET Trade Mark* [2002] RPC 585, Appointed Person.

For examples of 'proper reasons' which have been accepted see *WORTH Trade Marks* [1998] RPC 875, Trade Marks Registry (revocation proceedings frustrated attempts to license the mark); *MAGIC BALL Trade Mark* [2000] RPC 439 (delays in developing a new manufacturing technique).

Factors which are or have become a normal condition of trade cannot constitute proper reasons for non-use: *Philosophy Inc v Ferretti Studio Srl* [2002] EWCA Civ 921, sub nom *PHILOSOPHY DI ALBERTA FERRETTI Trade Mark* [2003] RPC 287 (proprietor did nothing for most of five year period then encountered ordinary commercial delays in producing new product bearing mark); *INVERMONT Trade Mark* [1997] RPC 125, sub nom *Glen Catrine Bonded Warehouse Ltd's Application for Revocation* [1996-97] ETMR 56, Trade Marks Registry (difficult to introduce new brand to the relevant market); *CABANAS HABANA (Device) Trade Mark* [2000] RPC 26, Trade Marks Registry (US trade embargo of Cuba said to have prevented use of the mark); and see also *K-2 Trade Mark* [2000] RPC 413, Trade Marks Registry (proprietor could have complied with EC regulations).

11 Trade Marks Act 1994 s 46(1)(a) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) arts 10(1), 12(1); and see 8th recital).

As to procedure on the application see PARA 396 et seq post; as to the date from which revocation takes effect see PARA 112 ante; as to the additional grounds for revocation of a collective mark see PARA 163 post; and as to the additional grounds for revocation of a certification mark see PARA 174 post.

An application under the Trade Marks Act 1938 s 26 (repealed) (removal from the register or imposition of a limitation on the ground of misuse) which was pending on 31 October 1994 must be dealt with under the old law and any necessary alteration made to the register: Trade Marks Act 1994 s 105, Sch 3 para 17(1). An application under s 46(1)(a) or s 46(1)(b) (see the text to note 10 infra) may be made in relation to an existing registered mark at any time on or after 31 October 1994; but no such application for the revocation of the registration of an existing registered mark registered by virtue of the Trade Marks Act 1938 s 27 (repealed) (defensive registration of well known trade marks) may be made until more than five years after 31 October 1994: Trade Marks Act 1994 Sch 3 para 17(2). As to the register see PARA 19 ante.

12 Ibid s 46(1)(b) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) arts 10(1), 12(1)). See also note 9 supra. As to procedure on the application see PARA 396 et seq post; as to the date from which revocation takes effect see PARA 112 ante; as to the additional grounds for revocation of a collective mark see PARA 163 post; and as to the additional grounds for revocation of a certification mark see PARA 174 post.

13 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13 (amended by SI 2000/138; SI 2004/948; SI 2006/763; SI 2006/1080). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

14 Trade Marks Act 1994 s 46(3) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 12(1)).

15 Trade Marks Act 1994 s 46(3) proviso (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 12(1)). This provides a period for negotiation during which the proprietor cannot steal a march on his opponent by putting his mark into use. The applicant does not have to wait, however, and can bring the application as soon as the five year period has elapsed: *Philosophy Inc v Ferretti Studio Srl* [2002] EWCA Civ 921, sub nom *PHILOSOPHY DI ALBERTA FERRETTI Trade Mark* [2003] RPC 287.

16 Trade Marks Act 1994 s 100. This provision abolishes the artificial position under the Trade Marks Act 1938 whereby the applicant for revocation had to produce a prima facie case of non-use (by showing that he had made reasonable searches) before the proprietor had to respond. The same provision is made in relation to protected international trade marks (UK) by the Trade Marks (International Registration) Order 1996, SI 1996/714, art 29. The effect is to place an evidential burden on the proprietor, while the legal burden of establishing the conditions for revocation lies on the applicant: *EXTREME Trade Mark* (O/161/07), Appointed Person. The standard of proof is on the balance of probabilities, and the tribunal is not entitled to disregard unchallenged evidence of use: *EXTREME Trade Mark* supra.

## **UPDATE**

### **114-117 Revocation**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

### **114 Non-use**

NOTE 5--SI 2000/136 r 16 now Trade Marks Rules 2008, SI 2008/1797, r 23.

NOTE 6--Case C-40/01 *Ansul BV*, cited, applied: *Crocodile International Private Ltd v La Chemise Lacoste* [2008] All ER (D) 92 (Oct).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(iii) Revocation/115. Mark becoming common name.

### **115. Mark becoming common name.**

The registration of a trade mark<sup>1</sup> may<sup>2</sup> be revoked on the ground that, in consequence<sup>3</sup> of acts<sup>4</sup> or inactivity<sup>5</sup> of the proprietor, it has become<sup>6</sup> the common name<sup>7</sup> in the trade<sup>8</sup> for a product or service for which it is registered<sup>9</sup>.

This ground also applies to the revocation of the protection of a protected international trade mark (UK)<sup>10</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 As to the absence of discretion see PARA 111 ante.

3 The acts or inactivity of the proprietor must be a cause of the mark becoming the common name, although they need not be the sole cause: *Hormel Foods Corpn v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822.

4 The acts concerned will clearly include descriptive use, including cases where the proprietor gives no name other than his trade mark to a new product. There is no longer any special provision concerning patented goods: cf the Trade Marks Act 1938 s 15(1)(b) (repealed).

5 The inactivity contemplated includes failure to take action against infringers: *Hormel Foods Corpn v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822.

6 Although the Trade Marks Act 1994 s 46(1)(c) is concerned with the situation where the mark has become generic after registration, the process may have started earlier.

7 It is sufficient for this purpose if the mark has become a common name; it does not have to be the only common name: *Hormel Foods Corpn v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822.

8 The relevant classes of person comprise principally consumers and end users, but depending on the product market concerned the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration: Case C-371/02 *Björnekulla Fruktindustrier AB v Procordia Food AB* [2004] ECR I-5791, [2004] RPC 912, ECJ.

9 Trade Marks Act 1994 s 46(1)(c) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 12(2)(a)). As to procedure on the application see PARA 396 et seq post; as to the date from which revocation takes effect see PARA 112 ante; as to the additional grounds for revocation of a collective mark see PARA 163 post; and as to the additional grounds for revocation of a certification mark see PARA 174 post.

10 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13 (amended by SI 2000/138; SI 2004/948; SI 2006/763; SI 2006/1080). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

## **UPDATE**

### **114-117 Revocation**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(iii) Revocation/116. Liability to mislead in consequence of use.

### **116. Liability to mislead in consequence of use.**

The registration of a trade mark<sup>1</sup> may<sup>2</sup> be revoked on the ground that, in consequence<sup>3</sup> of the use<sup>4</sup> made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services<sup>5</sup>.

This ground also applies to the revocation of the protection of a protected international trade mark (UK)<sup>6</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 As to the absence of discretion see PARA 111 ante.

3 It would appear that the use must be a cause of the mark becoming liable to mislead, although it need not be the sole cause: cf *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822.

4 For the meaning of 'use' generally see PARA 60 note 8 ante.

5 Trade Marks Act 1994 s 46(1)(d) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 12(2)(b)). This ground relates to events arising, as EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) says, 'after the date on which [the mark] was registered'. If the mark was misleading at the time it was registered, it will be liable to be declared invalid pursuant to the Trade Marks Act 1994 s 47(1) (see PARA 118 post), which includes any of the provisions of s 3 (absolute grounds for refusal: see PARA 59 et seq ante), including therefore s 3(3)(b) (mark of such a nature as to deceive the public: see PARA 64 ante). Otherwise, the conditions for revocation under s 46(1)(d) are the same as those for the refusal of registration under s 3(3)(b) (see PARA 64 ante): Case C-259/04 *Emanuel v Continental Shelf 128 Ltd* [2006] IP & T 887, sub nom *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* [2006] ETMR 56, ECJ. A trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark may not, by reason of that feature alone, be refused registration on this ground even where the goodwill associated with that trade mark has been assigned, together with the business making the goods to which the mark relates, to another person: Case C-259/04 *Emanuel v Continental Shelf 128 Ltd* supra.

It is unclear whether the Trade Marks Act 1994 s 46(1)(d) may be invoked where the proprietor allows another person to build up a goodwill in the mark so that the mark is liable to mislead the public as to trade origin: see *Scandecor Development AB v Scandecor Marketing AB* [1999] FSR 26, CA; on appeal [2001] UKHL 21, [2000] IP & T 218, [2002] FSR 122 (questions referred to European Court of Justice but case settled prior to ruling). However, the grant of a bare licence to use a trade mark (ie one with no quality control provisions), particularly if exclusive, will not, without more, render the trade mark deceptive: *EINSTEIN Trade Mark* [2007] RPC 539, Appointed Person.

As to procedure on the application see PARA 396 et seq post; as to the date from which revocation takes effect see PARA 112 ante; as to the additional grounds for revocation of a collective mark see PARA 163 post; and as to the additional grounds for revocation of a certification mark see PARA 174 post.

6 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13 (amended by SI 2000/138; SI 2004/948; SI 2006/763; SI 2006/1080). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

## **UPDATE**

### **114-117 Revocation**



SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(iii) Revocation/117. Partial revocation.

### 117. Partial revocation.

Where grounds for revocation<sup>1</sup> exist in respect of only some of the goods or services for which the trade mark<sup>2</sup> is registered<sup>3</sup>, revocation must relate to those goods or services only<sup>4</sup>. The same rule applies to the revocation of the protection in respect of part only of the goods and services in respect of which the international trade mark (UK) is protected<sup>5</sup>.

1 As to the grounds for revocation see PARAS 114-116 ante; as to the additional grounds for revocation of a collective mark see PARA 163 post; as to the additional grounds for revocation of a certification mark see PARA 174 post; and as to the date from which revocation takes effect see PARA 112 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 For the meaning of 'registered' see PARA 19 note 2 ante.

4 Trade Marks Act 1994 s 46(5) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 13). This most commonly arises in the context of revocation for non-use, where it is often the case that the proprietor has used the mark in relation to only certain goods and services within the specification for which the mark is registered. Where the existing specification is worded in broad terms, it is not appropriate simply to apply a blue pencil test to the specification; rather the tribunal should re-word the specification to correspond to the use that has been made. To do this the tribunal must first find as a fact what goods or services the mark has been used in relation to and secondly arrive at a fair specification of goods or services having regard to the use made; for this purpose the tribunal should decide how the average consumer would describe such use: *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 586, [2003] IP & T 299 ('arrangement of travel, tours and cruises' etc limited to 'all for package holidays'); see also *MINERVA Trade Mark* [2000] FSR 734 (registration for 'printed matter' limited to 'stationery'); *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293, (2001) Times, 28 February ('cleaning and decontaminating substances and preparations' limited to 'all for non-domestic use'); *DaimlerChrysler AG v Alavi (t/a Merc)* [2001] RPC 42, [2002] IP & T 496 ('articles of clothing' limited to 'sweaters, anoraks, polo-shirts, scarves, T-shirts and baseball caps'); *West (t/a Eastenders) v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 816, [2003] IP & T 768 ('beer' limited to 'bitter beer'); *Associated Newspapers Ltd v Express Newspapers* [2003] EWHC 1322 (Ch), [2004] IP & T 378, [2003] FSR 909 (mark registered for 'newspapers for sale in England and Wales only' not restricted even assuming only used for paid-for Sunday newspaper); *H Young (Operations) Ltd v Medici Ltd* [2003] EWHC 1589 (Ch), sub nom *ANIMAL Trade Mark* [2004] FSR 383 (mark registered for 'clothing' not restricted although only used for casual clothing of surfwear type); Case T-126/03 *Reckitt Benckiser (España) SL v Office for Harmonisation of the Internal Market (Trade Marks and Designs)* [2005] ECR II-2861, [2006] ETMR 50, [2005] All ER (D) 198 (Jul), CFI (mark registered for 'polish for metals' not restricted although only used for magic cotton); *WISI Trade Mark* [2006] RPC 580, [2006] ETMR 5, Appointed Person ('electrical and electronic apparatus and instruments' limited to 'apparatus and instruments for receiving, transmitting, amplifying, processing and measuring television signals etc'); *DATASPHERE Trade Mark* [2006] RPC 590, Appointed Person ('computer software and computer programmes' limited to 'all for use in or with banking or financial telecommunications systems'); Case T-256/04 *Mundipharma AG v Office for Harmonisation of the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 159 (Feb), CFI ('pharmaceutical and sanitary preparations; plasters' restricted to 'therapeutic preparations for respiratory illnesses'); *EXTREME Trade Mark* (O/161/07), Appointed Person (registration of 'luggage' maintained in view of use in relation to holdalls); cf *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 ('computer programs' too broad under the Trade Marks Act 1938 (repealed)). In arriving at a fair specification it is legitimate to take into account the fact that the goods are promoted as having additional uses: *NIRVANA Trade Mark* (O/262/06), Appointed Person.

As to procedure on the application see PARA 396 et seq post; and as to the date from which revocation takes effect see PARA 112 ante. Cf the similar provision relating to a partial declaration of invalidity: see the Trade Marks Act 1994 s 47(5) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 13); and PARA 120 post.

5 Trade Marks (International Registration) Order 1996, SI 1996/714, arts 4(3), 13 (art 13 amended by SI 2000/138; SI 2004/948; SI 2006/763; SI 2006/1080). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

**UPDATE**

**114-117 Revocation**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/ (iv) Declaration of Invalidity/118. Registration granted in breach of absolute grounds for refusal.

#### **(iv) Declaration of Invalidity**

##### **118. Registration granted in breach of absolute grounds for refusal.**

The registration of a trade mark<sup>1</sup> may<sup>2</sup> be declared invalid on the ground that the trade mark was registered in breach of the absolute grounds<sup>3</sup> for refusal of registration<sup>4</sup>. The protection of a protected international trade mark (UK) must be declared invalid on the same ground<sup>5</sup>.

Where the trade mark was registered even though it was devoid of any distinctive character<sup>6</sup> or consisted exclusively of signs or indications which might serve, in trade<sup>7</sup>, to designate the kind etc of goods or services<sup>8</sup> or consisted exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade<sup>9</sup>, it must not be declared invalid if, in consequence of the use<sup>10</sup> which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered<sup>11</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 As to the absence of discretion see PARA 111 ante.

3 Ie on the ground that the trade mark was registered in breach of the Trade Marks Act 1994 s 3 (see PARA 59 et seq ante) or any of the provisions referred to therein.

4 Ibid s 47(1) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p1) to approximate the laws of the member states relating to trade marks, art 3). As to the additional ground of invalidity of a collective mark see PARA 164 post; and as to the additional ground of invalidity of a certification mark see PARA 175 post.

5 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13 (amended by SI 2000/138; SI 2004/948; SI 2006/763; SI 2006/1080). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

6 Ie in breach of the Trade Marks Act 1994 s 3(1)(b): see PARA 60 head (1) ante.

7 As to the meaning of 'trade' see PARA 60 note 4 ante.

8 Ie in breach of the Trade Marks Act 1994 s 3(1)(c): see PARA 60 head (2) ante.

9 Ie in breach of ibid s 3(1)(d): see PARA 60 head (3) ante.

10 For the meaning of 'use' see PARA 60 note 8 ante.

11 Trade Marks Act 1994 s 47(1) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 3(3), second sentence). As to acquiring distinctive character as a result of use see PARA 61 ante.

As to procedure on the application see PARA 396 et seq post; and as to the effect of a declaration of invalidity see PARA 112 ante. For the purposes of proceedings under the Trade Marks Act 1994 s 47, as it applies in relation to an existing registered mark, the provisions of the Trade Marks Act 1994 are deemed to have been in force at all material times; but no objection to the validity of the registration of an existing registered mark may be taken on the ground specified in s 5(3) (see PARA 75 ante): s 105, Sch 3 para 18(2). For the meaning of 'existing registered mark' see PARA 4 note 2 ante.

#### **UPDATE**

##### **118-120 Declaration of invalidity**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/ (iv) Declaration of Invalidity/119. Registration granted in breach of relative grounds for refusal.

**119. Registration granted in breach of relative grounds for refusal.**

The registration of a trade mark<sup>1</sup> may<sup>2</sup> be declared invalid on the ground:

- 183 (1) that there is an earlier trade mark<sup>3</sup> in relation to which the specified conditions for refusal<sup>4</sup> obtain<sup>5</sup>; or
- 184 (2) that there is an earlier right<sup>6</sup> in relation to which the specified condition for refusal<sup>7</sup> is satisfied<sup>8</sup>,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration<sup>9</sup>.

The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless<sup>10</sup>:

- 185 (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration<sup>11</sup>;
- 186 (d) the registration procedure for the earlier trade mark was not completed before that date<sup>12</sup>; or
- 187 (c) the 'use conditions' are met<sup>13</sup>.

The use conditions are met if:

- 188 (i) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine<sup>14</sup> use<sup>15</sup> in the United Kingdom<sup>16</sup> by the proprietor or with his consent in relation to the goods or services for which it is registered<sup>17</sup>; or
- 189 (ii) the earlier trade mark has not been so used, but there are proper reasons<sup>18</sup> for non-use<sup>19</sup>.

Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it must be treated for these purposes as if it were registered only in respect of those goods or services<sup>20</sup>.

The protection of a protected international trade mark (UK) may be declared invalid on the same ground<sup>21</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 As to the absence of discretion see PARA 111 ante.

3 For the meaning of 'earlier trade mark' see PARA 70 ante.

4 ie the conditions set out in the Trade Marks Act 1994 s 5(1), (2) or (3); see PARAS 71-75 ante.

5 Ibid s 47(2)(a). As from 1 October 2007 only the proprietor or a licensee of the earlier trade mark or, in the case of an earlier collective mark or certification mark, the proprietor or an authorised user of such collective

mark or certification mark may make an application for a declaration of invalidity on this ground: Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, art 5(1), (2)(a) (not yet in force).

6 For the meaning of 'earlier right' see PARA 77 ante.

7 le the condition set out in the Trade Marks Act 1994 s 5(4): see PARA 77 ante.

8 Ibid s 47(2)(b). As from 1 October 2007 only the proprietor of the earlier right may make an application for a declaration of invalidity on this ground: Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, art 5(1), (2)(b) (not yet in force).

9 Trade Marks Act 1994 s 47(2) (derived from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) art 4). See also PARA 118 note 11 ante. As to the date on which the proprietor must give such consent see PARA 78 text and note 5 ante; as to procedure on the application see PARA 396 et seq post; as to the effect of a declaration of invalidity see PARA 112 ante; as to statutory acquiescence see PARA 99 ante; as to the additional ground of invalidity of a collective mark see PARA 164 post; and as to the additional ground of invalidity of a certification mark see PARA 175 post.

10 Trade Marks Act 1994 s 47(2A) (added by the Trade Marks (Proof of Use etc) Regulations 2004, SI 2004/946, regs 3, 6).

11 Trade Marks Act 1994 s 47(2A)(a) (as added: see note 10 supra).

12 Ibid s 47(2A)(b) (as added: see note 10 supra).

13 Ibid s 47(2A)(c) (as added: see note 10 supra).

14 As to genuine use see PARA 114 note 6 ante.

15 For these purposes, use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered: Trade Marks Act 1994 s 47(2C)(a) (added by the Trade Marks (Proof of Use etc) Regulations 2004, SI 2004/946, regs 3, 6). Cf the Trade Marks Act 1994 s 46(2): see PARA 114 ante.

16 For these purposes, use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes: Trade Marks Act 1994 s 47(2C)(b) (added by the Trade Marks (Proof of Use etc) Regulations 2004, SI 2004/946, regs 3, 6). Cf the Trade Marks Act s 46(2): see PARA 114 post. In relation to a Community trade mark, reference to the United Kingdom must be construed as a reference to the European Community: s 47(2D) (added by the Trade Marks (Proof of Use etc) Regulations 2004, SI 2004/946, regs 3, 6). For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

17 Trade Marks Act 1994 s 47(2B)(a) (added by the Trade Marks (Proof of Use etc) Regulations 2004, SI 2004/946, regs 3, 6).

18 As to proper reasons see PARA 114 note 10 ante.

19 Trade Marks Act 1994 s 47(2B)(b) (added by the Trade Marks (Proof of Use etc) Regulations 2004, SI 2004/946, regs 3, 6).

20 Trade Marks Act 1994 s 47(2E) (added by the Trade Marks (Proof of Use etc) Regulations 2004, SI 2004/946, regs 3, 6).

21 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13 (amended by SI 2000/138; SI 2004/948; SI 2006/763; SI 2006/1080). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

## **UPDATE**

### **118-120 Declaration of invalidity**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

### **119 Registration granted in breach of relative grounds for refusal**

TEXT AND NOTES 10-13--Heads (a)-(c) do not apply where the earlier trade mark is a trade mark within the Trade Marks Act 1994 s 6(1)(c) (see PARA 70 head (4)): s 47(2F) (added by SI 2008/1067).

NOTE 16--Also in relation to an international trade mark (EC): Trade Marks Act 1994 s 47(2D) (amended by SI 2008/1067).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/ (iv) Declaration of Invalidity/120. Partial declaration of invalidity.

## **120. Partial declaration of invalidity.**

Where the grounds of invalidity<sup>1</sup> exist in respect of only some of the goods or services for which the trade mark<sup>2</sup> is registered<sup>3</sup>, the trade mark may be declared invalid as regards those goods or services only<sup>4</sup>. Likewise, a partial declaration of invalidity of the protection of a protected international trade mark (UK) may be made<sup>5</sup>.

1 As to the grounds of invalidity see PARAS 118-119 ante; as to the additional ground of invalidity of a collective mark see PARA 164 post; and as to the additional ground of invalidity of a certification mark see PARA 175 post.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 For the meaning of 'registered' see PARA 19 note 2 ante.

4 Trade Marks Act 1994 s 47(5). It would appear that in appropriate circumstances the same approach should be applied under s 47(5) as under s 46(5) (see PARA 117 text and note 4 ante). See also PARA 118 note 11 ante. As to procedure on the application see PARA 396 et seq post; and as to the effect of a declaration of invalidity see PARA 112 ante.

5 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13(5)(b). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

## **UPDATE**

### **118-120 Declaration of invalidity**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/ (v) Rectification of the Register/121. In general.

## **(v) Rectification of the Register**

### **121. In general.**

Any person having a sufficient interest<sup>1</sup> may apply for the rectification of an error or omission in the register<sup>2</sup>; but an application for rectification may not be made in respect of a matter affecting the validity<sup>3</sup> of the registration<sup>4</sup> of a trade mark<sup>5</sup>.

Except where the registrar<sup>6</sup> or the court<sup>7</sup> directs otherwise, the effect of rectification of the register is that the error or omission in question is deemed never to have been made<sup>8</sup>.

<sup>1</sup> Any person may apply; there is no need for the applicant to show that he is aggrieved by or otherwise interested in the registration: see PARA 396 text and note 3 post.

<sup>2</sup> Trade Marks Act 1994 s 64(1) (which has no antecedent in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks). As to the register see PARA 19 ante. An application under the Trade Marks Act 1938 s 32 (repealed) (rectification of register) or s 34 (repealed) (correction of register) which was pending on 31 October 1994 must be dealt with under the old law and any necessary alteration made to the new register: Trade Marks Act 1994 s 105, Sch 3 para 18(1). For the meaning of 'the old law' see PARA 4 note 3 ante.

<sup>3</sup> A broadening of the specification of goods affects the validity of the registration: *Andreas Stihl AG & Co's Trade Mark Application* [2001] RPC 215, Appointed Person; cf Case T-128/99 *Signal Communications Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2001] ECR II-3273, CFI (decided under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark).

<sup>4</sup> For the meaning of 'registration' see PARA 19 note 2 ante.

<sup>5</sup> Trade Marks Act 1994 s 64(1) proviso. Rectification may be ordered where a purported assignment of the trade mark has been recorded but the assignment was made without authority: *Dasema Trading Ltd's Trade Mark* [2007] ETMR 15, Trade Marks Registry. Rectification may also be ordered where the registered proprietor has sold the trade mark to another party after registration: *Skaga AB's Trade Mark* (O/134/03), Trade Marks Registry. It is not clear whether rectification may be ordered on the ground that the registered proprietor was not the rightful proprietor at the time of the registration, or whether this is a ground which affects the validity of the registration, but the latter appears more likely. For the meaning of 'trade mark' see PARA 57 ante. As to procedure on the application see PARA 396 et seq post; and as to the grounds on which a trade mark may be declared invalid see PARAS 118-119 ante.

The registration of a person as proprietor of a trade mark is prima facie evidence of the validity of the original registration: see s 72; and PARA 110 ante.

<sup>6</sup> As to the registrar see PARA 17 ante.

<sup>7</sup> For the meaning of 'the court' see PARA 349 post.

<sup>8</sup> Trade Marks Act 1994 s 64(3).

## **UPDATE**

### **121 In general**

NOTE 3--Regulation 40/94 ('the Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); see PARA 176.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND RECTIFICATION/(vi) Alteration of Registered Trade Mark/122. In general.

## **(vi) Alteration of Registered Trade Mark**

### **122. In general.**

A registered trade mark<sup>1</sup> may not be altered in the register<sup>2</sup> during the period of registration or on renewal<sup>3</sup>. Nevertheless the registrar<sup>4</sup> may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity<sup>5</sup> of the mark<sup>6</sup>.

Where, upon the request of the proprietor, the registrar proposes to allow such alteration, he must publish<sup>7</sup> the mark as altered<sup>8</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 post.

2 As to the register see PARA 19 ante.

3 Trade Marks Act 1994 s 44(1) (which has no antecedent in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks). This provision must be read subject to the Trade Marks Act 1994 s 13, which permits a disclaimer or limitation to be made to a registered trade mark: see PARA 83 ante. An application under the Trade Marks Act 1938 s 35 (repealed) (alteration of registered trade mark) which was pending on 31 October 1994 must be dealt with under the old law and any necessary alteration made to the new register: Trade Marks Act 1994 s 105, Sch 3 para 16. For the meaning of 'the old law' see PARA 4 note 3 ante.

4 As to the registrar see PARA 17 ante.

5 An alteration which affects the way a trade mark is or may be pronounced or its visual impact or the idea conveyed by the mark does substantially affect the identity of the mark: *Neutrogena Corpn v Golden Ltd* [1996] RPC 473 at 488-489, CA, per Jacob J (a case under the Trade Marks Act 1938 s 30 (repealed)). See also the Trade Marks Act 1994 s 41(2) (in which the same expression appears); and PARA 364 note 2 post.

6 Trade Marks Act 1994 s 44(2). As to procedure on the application see PARA 393 post.

7 For the meaning of 'publish' see PARA 17 note 10 ante.

8 Trade Marks Act 1994 s 44(3); Trade Marks Rules 2000, SI 2000/136, r 25(2).

### **UPDATE**

### **122 In general**

NOTE 8--SI 2000/136 r 25(2) now Trade Marks Rules 2008, SI 2008/1797, r 32(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (6) GROUNDLESS THREATS OF INFRINGEMENT PROCEEDINGS/123. In general.

## (6) GROUNDLESS THREATS OF INFRINGEMENT PROCEEDINGS

### 123. In general.

Where a person threatens<sup>1</sup> another with proceedings for infringement<sup>2</sup> of a registered trade mark<sup>3</sup> other than:

- 190 (1) the application of the mark to goods or their packaging<sup>4</sup>;
- 191 (2) the importation of goods to which, or to the packaging of which, the mark has been applied<sup>5</sup>; or
- 192 (3) the supply of services under the mark<sup>6</sup>,

any person aggrieved<sup>7</sup> may bring proceedings for relief<sup>8</sup>.

The mere notification that a trade mark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of the above provisions<sup>9</sup>. Since there is no equivalent provision in respect of a threat of passing-off proceedings, it is possible to threaten anyone with such proceedings<sup>10</sup>; but caution will be required where such a threat is made along with a notification of the existence of a registered trade mark<sup>11</sup>.

The same provisions apply to threats of infringement proceedings of a protected international trade mark (UK)<sup>12</sup>.

1 The test for whether a statement constitutes a threat is whether an ordinary recipient, in the position of the threatened person, would have understood it as a threat of proceedings: *Prince plc v Prince Sports plc* [1998] FSR 21 at 28 per Neuberger J; *L'Oréal (UK) Ltd v Johnson & Johnson* [2000] FSR 686, [2000] All ER (D) 290. Accordingly, implied threats are threats for these purposes: *Scandecor Development AB v Scandecor Marketing AB* [1999] FSR 26, CA (on appeal [2001] UKHL 21, [2000] IP & T 218, [2002] FSR 122 (questions referred to European Court of Justice but case settled prior to ruling)), applying *Bowden Controls Ltd v Acco Cable Control Ltd* [1990] RPC 427 at 431 per Aldous J to the Trade Marks Act 1994 s 21. In relation to patents the courts have consistently held that any communication containing even a hint of legal action amounts to a threat: see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 559. A statement which is not a threat cannot retrospectively constitute a threat as a result of subsequent events: *Prince plc v Prince Sports plc* supra (cannot use later correspondence to construe alleged 'threat'). If the threat was made at a 'without prejudice' meeting, it cannot be relied on and a claim based upon such a threat will be struck out as an abuse of process: *Unilever plc v Procter & Gamble Co* [2001] 1 All ER 783, [2000] 1 WLR 2436, CA (a patent case). A claim against a solicitor will not be permitted if it appears that the sole purpose of the claim is to create a conflict between the solicitor and his client: *Reckitt Benckiser (UK) v Home Pairfum Ltd* [2004] EWHC 302 (Pat), [2004] FSR 774.

2 For the meaning of 'infringement proceedings' see PARA 85 note 4 ante; and for the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see the Trade Marks Act 1994 s 10; and PARA 86 et seq ante.

3 As to the meaning of 'registered trade mark' see PARA 127 post. It appears that a threat of proceedings made in relation to an application for a trade mark is actionable: cf *Brain v Ingledew Brown Benison & Garrett* [1996] FSR 341, CA (a patent case). As to justification in such a case see *Brain v Ingledew Brown Benison & Garrett (No 2)* [1997] FSR 271.

4 Trade Marks Act 1994 s 21(1)(a). A threat in relation to subsequent dealings is actionable even if the person threatened has applied the mark: *Prince plc v Prince Sports plc* [1998] FSR 21; cf *Cavity Trays Ltd v RMC Panel Products Ltd* [1996] RPC 361, CA (a patent case).

5 Trade Marks Act 1994 s 21(1)(b).

6 Ibid s 21(1)(c). Where a threat is made to a person who supplies services, it is a question of construction whether the threat relates purely to supplying services under the mark: *Prince plc v Prince Sports plc* [1998] FSR 21; cf *Brain v Ingledew Brown Benison & Garrett* [1996] FSR 341, CA (a patent case).

7 The expression 'person aggrieved' must be construed liberally. It includes the person to whom the threats are made: *Prince plc v Prince Sports plc* [1998] FSR 21. Cf the Patents Act 1977 s 70(1) (see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 557), where it is explicitly made clear that the right of action accrues to a person 'whether or not he is the person to whom the threats are made'; but even without that provision it would seem to be the same in relation to trade marks.

8 Trade Marks Act 1994 s 21(1). Section 21 contains a provision new in trade marks law but is based upon the equivalent provisions relating to patents (see the Patents Act 1977 s 70 (as amended); and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 557 et seq) and registered designs (see the Registered Designs Act 1949 s 26 (as amended); and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 772). As to justification of threats see PARA 124 post; and as to the relief obtainable see PARA 125 post.

9 Trade Marks Act 1994 s 21(4) (following the Patents Act 1977 s 70(5) (as substituted): see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 559).

10 Ie subject to the law of malicious falsehood (see LIBEL AND SLANDER vol 28 (Reissue) PARA 274 et seq), for which it would, however, be necessary to prove that the person making the threat had no honest belief in his case.

11 See *Jaybeam Ltd v Abru Aluminium Ltd* [1976] RPC 308, [1975] FSR 334 (where a letter threatening proceedings for copyright infringement, and also mentioning the existence of a registered design, was held to contain an implicit threat to sue on the registered design).

12 Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(6). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

## UPDATE

### 123 In general

NOTE 12--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (6) GROUNDLESS THREATS OF INFRINGEMENT PROCEEDINGS/124. Justification of threats.

#### **124. Justification of threats.**

The claimant is entitled to relief against groundless threats of infringement proceedings<sup>1</sup> unless the defendant shows that the acts in respect of which proceedings were threatened constitute (or, if done, would constitute) an infringement of the registered trade mark<sup>2</sup> concerned<sup>3</sup>. If that is shown by the defendant, the claimant is nevertheless entitled to relief if he shows that the registration of the trade mark is invalid<sup>4</sup> or liable to be revoked<sup>5</sup> in a relevant respect<sup>6</sup>.

1 As to groundless threats of infringement proceedings see PARA 123 ante; and as to the relief obtainable see PARA 125 post. For the meaning of 'infringement proceedings' see PARA 85 note 4 ante; and for the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see the Trade Marks Act 1994 s 10; and PARA 86 et seq ante.

2 This provision also applies to a protected international trade mark (UK): see PARA 123 text and note 12 ante. As to the meaning of 'registered trade mark' see PARA 127 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

3 Trade Marks Act 1994 s 21(2).

4 Ie or that the protection of the protected international trade mark (UK) is invalid. As to the grounds for invalidity of registration see PARA 118 et seq ante.

5 As to the grounds for revocation of registration see PARA 114 et seq ante.

6 Trade Marks Act 1994 s 21(3); Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(6) (b).

#### **UPDATE**

#### **124 Justification of threats**

NOTE 6--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (6) GROUNDLESS THREATS OF INFRINGEMENT PROCEEDINGS/125. Relief obtainable.

### **125. Relief obtainable.**

The relief which may be applied for groundless threats of infringement proceedings<sup>1</sup> is any of the following<sup>2</sup>:

- 193 (1) a declaration that the threats are unjustifiable<sup>3</sup>;
- 194 (2) an injunction against the continuance of the threats<sup>4</sup>;
- 195 (3) damages in respect of any loss the claimant has sustained by the threats<sup>5</sup>.

1 As to groundless threats of infringement proceedings see PARA 123 ante; and as to justification of threats see PARA 124 ante. For the meaning of 'infringement proceedings' see PARA 85 note 4 ante; and for the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see the Trade Marks Act 1994 s 10; and PARA 86 et seq ante.

2 Ibid s 21(2). This includes an interim injunction: *Johnson Electric Industrial Manufactory Ltd v Mabuchi Motor KK* [1986] FSR 280 (a patent case).

3 Trade Marks Act 1994 s 21(2)(a). This encompasses a declaration of non-infringement: *L'Oréal (UK) Ltd v Johnson & Johnson* [2000] FSR 686, [2000] All ER (D) 290.

4 Trade Marks Act 1994 s 21(2)(b).

5 Ibid s 21(2)(c).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/(i) Introduction/126. In general.

## **(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING**

### **(i) Introduction**

#### **126. In general.**

The Trade Marks Act 1994 contains substantially new provisions relating to registered trade marks as objects of property, particularly in relation to their assignment, transmission and licensing<sup>1</sup>. These provisions also apply, with the necessary modifications, to applications for registration of trade marks<sup>2</sup>. Most of these provisions also apply to protected international trade marks (UK)<sup>3</sup>.

The new provisions in the Trade Marks Act 1994 in all these respects give a proprietor much greater freedom in principle than under the previous law<sup>4</sup>. It remains the case, however, that he must not allow his mark to become deceptive without risking revocation<sup>5</sup>. Subject to that, a registered trade mark has become more assimilated to other incorporeal rights as regards the freedom of its owner to deal with it<sup>6</sup>.

1 Under the Trade Marks Act 1938 both assignment and licensing were closely controlled with a view to preventing marks from becoming deceptive: see the Trade Marks Act 1938 s 22 (repealed) (assignment) and s 28 (repealed) (licensing).

Even the provisions of that Act represented a liberalisation of the position obtaining before that Act was passed: see the Trade Marks Act 1905 s 22 (repealed), whereby a registered trade mark could only be assigned along with the business ie effectively with the business (see eg *Re John Sinclair Ltd's Trade Mark*[1932] 1 Ch 598, 49 RPC 123, CA). There was no provision in the Trade Marks Act 1905 permitting licensing at all. A history of these matters was provided in *GE Trade Mark*[1969] RPC 418; revsd [1970] RPC 339, CA; affd [1973] RPC 297, HL.

2 Trade Marks Act 1994 s 27(1).

3 See the Trade Marks (International Registration) Order 1996, SI 1996/714, arts 5, 7.

4 Such was the intention: see the White Paper *Reform of Trade Marks Law* (Cm 1203) PARAS 4.34-4.39 (licensing), 4.44-4.47 (assignment).

5 See PARA 116 ante.

6 See *Scandecor Development AB v Scandecor Marketing AB*[2001] UKHL 21, [2000] IP & T 218, [2002] FSR 122 (referred to European Court of Justice but case settled prior to ruling).

### **UPDATE**

#### **126 In general**

NOTE 3--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (ii) Registered Trade Marks and Protected International Trade Marks (UK) as Objects of Property/127. Registered trade mark is property.

## **(ii) Registered Trade Marks and Protected International Trade Marks (UK) as Objects of Property**

### **127. Registered trade mark is property.**

A registered trade mark is a property right obtained by the registration<sup>1</sup> of the trade mark under the Trade Marks Act 1994; and the proprietor of a registered trade mark has the rights<sup>2</sup> and remedies<sup>3</sup> provided by that Act<sup>4</sup>. A registered trade mark is personal property<sup>5</sup>. Equities in respect of a registered trade mark may be enforced<sup>6</sup> in like manner as in respect of other personal or movable property<sup>7</sup>.

1 As to the meaning of 'registration' see PARA 19 note 2 ante.

2 As to the rights see PARA 84 ante.

3 As to the remedies see PARA 436 et seq post.

4 Trade Marks Act 1994 s 2(1).

5 Ibid s 22. The provisions of s 22 and s 26 (see the text and notes 6-7 infra) apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark: s 27(1). If the applicant company is dissolved prior to registration the application vests bona vacantia: *Joe Cool (Manchester) Ltd's Trade Mark Application*[2000] RPC 926, Trade Marks Registry. These provisions also apply in relation to a protected international trade mark (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 5. As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

6 Ie subject to the provisions of the Trade Marks Act 1994.

7 Ibid s 26(2). See also note 5 supra. As to trusts and equities generally see further PARA 23 ante.

## **UPDATE**

### **127-128 Registered trade marks and protected international trade marks (UK) as objects of property**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (ii) Registered Trade Marks and Protected International Trade Marks (UK) as Objects of Property/128. Co-ownership of registered trade mark.

## **128. Co-ownership of registered trade mark.**

Where a registered trade mark<sup>1</sup> is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark<sup>2</sup>. Where two or more persons are co-proprietors of a registered trade mark<sup>3</sup>, the following provisions apply<sup>4</sup>.

Subject to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent<sup>5</sup> of or the need to account to the other or others, any act which would otherwise amount to an infringement<sup>6</sup> of the registered trade mark<sup>7</sup>.

One co-proprietor may not, without the consent of the other or others, grant a licence<sup>8</sup> to use the registered trade mark or assign<sup>9</sup> or charge his share in the registered trade mark<sup>10</sup>.

Infringement proceedings<sup>11</sup> may be brought by any co-proprietor, but he may not, without the leave of the court<sup>12</sup>, proceed with the action unless the other, or each of the others, is either joined as a claimant or added as a defendant; a co-proprietor who is thus added as a defendant may not be made liable for any costs in the action unless he takes part in the proceedings<sup>13</sup>.

Nothing in the above provisions affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such<sup>14</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 ante.

2 Trade Marks Act 1994 s 23(1). The provisions of s 23 apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark: s 27(1). In s 23, as it applies in relation to an application for registration, the reference in s 23(1) to the granting of the registration is to be construed as a reference to the making of the application: s 27(2). These provisions also apply in relation to a protected international trade mark (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 5. As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

The provisions of the Trade Marks Act 1994 s 23 apply as from 31 October 1994 to an existing registered mark of which two or more persons were immediately before that date registered as joint proprietors: s 105, Sch 3 para 7. So long as the relations between the joint proprietors remain such as are described in the Trade Marks Act 1938 s 63 (repealed) (joint ownership) there is, however, taken to be an agreement to exclude the operation of the Trade Marks Act 1994 s 23(1), (3): Sch 3 paras 1(1), 7. Where the relations between two or more persons interested in a trade mark was such that no one of them was entitled as between himself and the other or others to use it except either on behalf of both or all of them or in relation to an article with which both or all of them were connected in the course of trade, those persons might be registered as joint proprietors of the trade mark; and the Trade Marks Act 1938 had effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person: s 63(1) (repealed). Subject thereto, nothing in the Trade Marks Act 1938 authorised the registration as joint proprietors of two or more persons who used, or propose to use, a trade mark independently: s 63(2) (repealed). As to the meaning of 'trade' see PARA 60 note 4 ante.

3 Ie whether by virtue of the Trade Marks Act 1994 s 23(1) (see the text to note 2 supra) or otherwise.

4 Ibid s 23(2). See also note 2 supra.

5 For the meaning of 'consent' see ibid s 28(3); and PARA 136 post.

6 For the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see *ibid* s 10; and PARA 86 et seq ante.

7 *Ibid* s 23(3). See also note 2 supra. This represents a relaxation of the position under the Trade Marks Act 1938 s 63 (repealed) (cited in note 2 supra).

8 As to the licensing of trade marks see PARAS 136-137 post.

9 As to assignment of a registered trade mark see PARA 129 post.

10 Trade Marks Act 1994 s 23(4). See also note 2 supra.

11 For the meaning of 'infringement proceedings' see PARA 85 note 4 ante.

12 For the meaning of 'the court' see PARA 349 post.

13 Trade Marks Act 1994 s 23(5). See also note 2 supra. Nothing in s 23(5) affects the granting of interim relief on the application of a single co-proprietor: s 23(5).

14 *Ibid* s 23(6). See also note 2 supra.

## **UPDATE**

### **127-128 Registered trade marks and protected international trade marks (UK) as objects of property**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iii) Assignment and Transmission/129. In general.

### **(iii) Assignment and Transmission**

#### **129. In general.**

A registered trade mark<sup>1</sup> is transmissible by assignment<sup>2</sup>, testamentary disposition or operation of law in the same way as other personal or movable property<sup>3</sup>. It is so transmissible either in connection with the goodwill of a business<sup>4</sup> or independently<sup>5</sup>.

An assignment or other transmission of a registered trade mark or protected international trade mark (UK) may be partial, that is, limited so as to apply in relation to some but not all of the goods or services for which the trade mark is registered<sup>6</sup>; an assignment or other transmission of a registered trade mark (but not a protected international trade mark (UK)<sup>7</sup>) may be limited in relation to use<sup>8</sup> of the trade mark in a particular manner or a particular locality<sup>9</sup>.

An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative; but, in a case where the assignor or personal representative is a body corporate, this requirement may be satisfied by the affixing of its seal<sup>10</sup>.

The above provisions apply to assignment by way of security as in relation to any other assignment<sup>11</sup>.

A registered trade mark may be the subject of a charge in the same way as other personal or movable property<sup>12</sup>.

With the exception of a partial assignment limited by particular manner or locality of use, the above provisions apply in relation to a protected international trade mark (UK) in the same way as to registered trade marks<sup>13</sup>.

Nothing in the Trade Marks Act 1994 is to be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business<sup>14</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 ante.

2 The assignment of a registered trade mark or any right in it is a registrable transaction: see the Trade Marks Act 1994 s 25(2); and PARA 130 post. The registration of a person as proprietor of a registered trade mark is prima facie evidence of the validity of any subsequent assignment or other transmission of it: see s 72; and PARA 110 ante.

3 Ibid s 24(1). The provisions of s 24 apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark: s 27(1). As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post.

Section 24 applies to transactions and events occurring on or after 31 October 1994 in relation to an existing registered mark; and the old law continues to apply in relation to transactions and events occurring before that date: s 105, Sch 3 para 8(1). For the meaning of 'existing registered mark' see PARA 4 note 2 ante; and for the meaning of 'the old law' see PARA 4 note 3 ante.

4 For the meaning of 'business' see PARA 32 note 3 ante.

5 Trade Marks Act 1994 s 24(1). As to the risk that an assignment without goodwill may render the trade mark deceptive see PARA 116 ante.

6 Ibid s 24(2)(a); Trade Marks (International Registration) Order 1996, SI 1996/714, art 5. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

7 Ibid art 5 excludes the Trade Marks Act 1994 s 24(2)(b) (see the text and note 9 infra) from applying to protected international trade marks (UK).

8 For the meaning of 'use' see PARA 60 note 8 ante.

9 Trade Marks Act 1994 s 24(2)(b). A partial assignment may have dangers in respect of validity. For example, assignment for some goods with retention for closely similar goods could lead to confusion. Under the Trade Marks Act 1938 this was not allowed: see *Phantom Trade Mark*[1978] RPC 245, CA.

10 Trade Marks Act 1994 s 24(3).

11 Ibid s 24(4).

12 Ibid s 24(5).

13 Trade Marks (International Registration) Order 1996, SI 1996/714, art 5.

14 Trade Marks Act s 24(6). See also PARAS 314-315 post.

## **UPDATE**

### **129 In general**

NOTES 6, 7, 13--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iii) Assignment and Transmission/130. Registration of transactions affecting registered trade mark.

### **130. Registration of transactions affecting registered trade mark.**

On application being made to the registrar<sup>1</sup> by:

- 196 (1) a person claiming to be entitled to an interest in or under a registered trade mark<sup>2</sup> by virtue of a registrable transaction<sup>3</sup>; or
- 197 (2) any other person claiming to be affected by such a transaction<sup>4</sup>,

the prescribed particulars<sup>5</sup> of the transaction must be entered in the register<sup>6</sup>.

The following are registrable transactions:

- 198 (a) an assignment of a registered trade mark or any right in it<sup>7</sup>;
- 199 (b) the grant of a licence under a registered trade mark<sup>8</sup>;
- 200 (c) the granting of any security interest, whether fixed or floating, over a registered trade mark or any right in or under it<sup>9</sup>;
- 201 (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it<sup>10</sup>;
- 202 (e) an order of a court or other competent authority transferring a registered trade mark or any right in or under it<sup>11</sup>.

Until an application has been made for registration of the prescribed particulars of a registrable transaction: (i) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it; and (ii) a person claiming to be a licensee<sup>12</sup> does not have the protection under the statutory provisions<sup>13</sup> relating to the rights and remedies of a licensee in relation to infringement<sup>14</sup>.

Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, and the mark is infringed before the prescribed particulars are registered, in proceedings for such an infringement the court<sup>15</sup> must not award him costs unless<sup>16</sup>:

- 203 (A) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date<sup>17</sup>; or
- 204 (B) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter<sup>18</sup>.

1 As to the registrar see PARA 17 ante.

2 As to the meaning of 'registered trade mark' see PARA 127 ante.

3 Trade Marks Act 1994 s 25(1)(a).

4 Ibid s 25(1)(b).

5 As to the prescribed particulars see PARA 131 post.

6 Trade Marks Act 1994 s 25(1). The provisions of s 25 apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark: s 27(1). In s 25, as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the register, and to the making of an application to register particulars, are to be construed as references to the giving of notice to the registrar of those particulars: s 27(3). As to the requirements for registration see PARA 55 et seq ante; as to the procedure on the application see PARA 352 et seq post; and as to the register see PARA 19 ante.

As to the power to make rules for the amendment and removal of registered particulars see PARA 134 post.

Existing entries under the Trade Marks Act 1938 s 25 (repealed) (registration of assignments and transmissions) had to be transferred on 31 October 1994 to the register kept under the Trade Marks Act 1994 and have effect as if made under s 25: s 105, Sch 3 para 8(2). Provision may be made by rules for putting such entries in the same form as is required for entries made under the Act: Sch 3 para 8(2).

An application for registration under the Trade Marks Act 1938 s 25 (repealed) which was pending before the registrar on 31 October 1994 must be treated as an application for registration under the Trade Marks Act 1994 s 25 and must proceed accordingly; and the registrar may require the applicant to amend his application so as to conform with the requirements of that Act: Sch 3 para 8(3).

An application under the Trade Marks Act 1938 s 25 (repealed) which has been determined by the registrar but not finally determined before 31 October 1994 must be dealt with under the old law; and the Trade Marks Act 1994 Sch 3 para 8(2) applies in relation to any resulting entry in the register: Sch 3 para 8(4). For the meaning of 'the old law' see PARA 4 note 3 ante.

Where before 31 October 1994 a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration on or after that date must be made under s 25: Sch 3 para 8(5). For the meaning of 'existing registered mark' see PARA 4 note 2 ante.

In cases to which Sch 3 para 8(3) or Sch 3 para 8(5) applies, the Trade Marks Act 1938 s 25(3) (repealed) continues to apply (and the Trade Marks Act 1994 s 25(3), (4) does not apply) as regards the consequences of failing to register: Sch 3 para 8(6).

7 Ibid s 25(2)(a). As to assignments see PARA 129 ante. The transfer of a trade mark by operation of law is not an assignment or other registrable transaction: cf *Tamglass Ltd OY v Luoyang North Glass Technology Co Ltd (No 3)* [2006] EWHC 445 (Pat), [2006] FSR 622 (a patent case).

8 Trade Marks Act 1994 s 25(2)(b). For the meaning of 'licence' see PARA 136 note 7 post.

9 Ibid s 25(2)(c).

10 Ibid s 25(2)(d).

11 Ibid s 25(2)(e).

12 For the meaning of 'licensee' see PARA 136 note 7 post.

13 Ie the Trade Marks Act 1994 s 30 (see PARA 418 post) or s 31 (see PARA 419 post).

14 Ibid s 25(3).

15 For the meaning of 'the court' see PARA 349 post.

16 Trade Marks Act 1994 s 25(4) (amended by the Intellectual Property (Enforcement etc) Regulations 2006, SI 2006/1028, reg 2(2), Sch 2 paras 15, 17). The Trade Marks Act 1994 s 25(4) (as amended) follows the similar provision in the Patents Act 1977 s 68 (as amended) (effect of non-registration on infringement proceedings: see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 553) with the important difference that it is the practicability of making the application for registration rather than the registration itself which matters: cf on the latter in relation to patents *Mölnlycke AB v Procter & Gamble Ltd (No 5)* [1994] RPC 49 at 110, CA.

17 Trade Marks Act 1994 s 25(4)(a) (as amended: see note 16 supra).

18 Ibid s 25(4)(b) (as amended: see note 16 supra).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iii) Assignment and Transmission/131. Particulars of registrable transactions.

### **131. Particulars of registrable transactions.**

Upon application made to the registrar<sup>1</sup> by a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction or any other person claiming to be affected by such a transaction<sup>2</sup>, there must be entered in the register<sup>3</sup> the following particulars of registrable transactions<sup>4</sup>, that is to say:

- 205 (1) in the case of an assignment<sup>5</sup> of a registered trade mark or any right in it: (a) the name and address of the assignee; (b) the date of the assignment; and (c) where the assignment is in respect of any right in the mark, a description of the right assigned<sup>6</sup>;
- 206 (2) in the case of the grant of a licence<sup>7</sup> under a registered trade mark: (a) the name and address of the licensee; (b) where the licence is an exclusive licence<sup>8</sup>, that fact; (c) where the licence is limited<sup>9</sup>, a description of the limitation; and (d) the duration of the licence if the same is or is ascertainable as a definite period<sup>10</sup>;
- 207 (3) in the case of the grant of any security interest over a registered trade mark or any right in or under it: (a) the name and address of the grantee; (b) the nature of the interest, whether fixed or floating; and (c) the extent of the security and the right in or under the mark secured<sup>11</sup>;
- 208 (4) in the case of the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it: (a) the name and address of the person in whom the mark or any right in or under it vests by virtue of the assent; and (b) the date of the assent<sup>12</sup>; and
- 209 (5) in the case of a court or other competent authority transferring a registered trade mark or any right in or under it: (a) the name and address of the transferee; (b) the date of the order; and (c) where the transfer is in respect of a right in the mark, a description of the right transferred<sup>13</sup>.

In each case, there must be entered the date on which the entry is made<sup>14</sup>.

<sup>1</sup> As to the registrar see PARA 17 ante.

<sup>2</sup> I.e. any such person as is mentioned in the Trade Marks Act 1994 s 25(1)(a) or s 25(1)(b): see PARA 130 heads (1), (2) ante.

<sup>3</sup> As to the register see PARA 19 ante.

<sup>4</sup> Trade Marks Rules 2000, SI 2000/136, r 40.

<sup>5</sup> As to assignments see PARA 129 ante.

<sup>6</sup> Trade Marks Rules 2000, SI 2000/136, r 40(a).

<sup>7</sup> As to licences see PARAS 136-137 post.

<sup>8</sup> As to exclusive licences see PARA 137 post.

<sup>9</sup> As to limited licences see PARA 136 post.

<sup>10</sup> Trade Marks Rules 2000, SI 2000/136, r 40(b).

- 11 Ibid r 40(c).
- 12 Ibid r 40(d).
- 13 Ibid r 40(e).
- 14 Ibid r 40. As to the application to register or give notice of a transaction see PARA 132 post.

## **UPDATE**

### **131 Particulars of registrable transactions**

TEXT AND NOTES--SI 2000/136 revoked: see now the Trade Marks Rules 2008, SI 2008/1797, r 47.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iii) Assignment and Transmission/132. Application to register or give notice of transaction.

### **132. Application to register or give notice of transaction.**

An application to register particulars of transactions affecting a registered trade mark<sup>1</sup> or to give notice to the registrar of particulars affecting an application for registration of a trade mark<sup>2</sup> must be made as follows<sup>3</sup>:

- 210 (1) in relation to an assignment<sup>4</sup> or transaction, other than a transaction referred to in heads (2) to (4) below, on Form TM16<sup>5</sup>;
- 211 (2) in relation to the grant of a licence<sup>6</sup>, on Form TM50<sup>7</sup>;
- 212 (3) in relation to an amendment to, or termination of, a licence, on Form TM51<sup>8</sup>;
- 213 (4) in relation to the grant, amendment or termination of any security interest, on Form TM24<sup>9</sup>; and
- 214 (5) in relation to the making by personal representatives of an assent or in relation to an order of a court or other competent authority, on Form TM24<sup>10</sup>.

Any such application must:

- 215 (a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment<sup>11</sup>;
- 216 (b) where the transaction falls within head (2), head (3) or head (4) above, be signed by or on behalf of the grantor of the licence or security interest<sup>12</sup>,

or be accompanied by such documentary evidence as suffices to establish the transaction<sup>13</sup>.

Where the transaction is effected by an instrument chargeable with duty, the application is subject to the registrar's being satisfied that the instrument has been duly stamped<sup>14</sup>.

Where an application to give notice to the registrar has been made of particulars relating to an application for registration of a trade mark, upon registration of the trade mark, the registrar must enter those particulars in the register<sup>15</sup>.

1    I.e a transaction to which the Trade Marks Act 1994 s 25 (see PARA 130 ante) applies.

2    I.e a transaction to which *ibid* s 27(3) (see PARA 130 note 6 ante) applies.

3    Trade Marks Rules 2000, SI 2000/136, r 41(1), which is expressed to be subject to r 41(2) (see the text to notes 11-13 *infra*).

4    As to assignments see PARA 129 ante.

5    Trade Marks Rules 2000, SI 2000/136, r 41(1)(a). As to the use of forms see PARA 353 post.

6    As to licences see PARAS 136-137 post.

7    Trade Marks Rules 2000, SI 2000/136, r 41(1)(b).

8    *Ibid* r 41(1)(c).

9    *Ibid* r 41(1)(d).

10 Ibid r 41(1)(e).

11 Ibid r 41(2)(a).

12 Ibid r 41(2)(b).

13 Ibid r 41(2).

14 Ibid r 41(3).

15 Ibid r 41(4).

## **UPDATE**

### **132 Application to register or give notice of transaction**

TEXT AND NOTES--SI 2000/136 r 41 now Trade Marks Rules 2008, SI 2008/1797, r 49.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iii) Assignment and Transmission/133. Sanctions for failure to register.

### **133. Sanctions for failure to register.**

The Trade Marks Act 1994 provides sanctions in the nature of deprivation of rights for failure to register any registrable transaction affecting a registered trade mark<sup>1</sup>. Thus, until an application has been made for registration of the prescribed particulars of a registrable transaction, the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it<sup>2</sup>; and a person claiming to be a licensee by virtue of the transaction does not have the protection of the provisions conferring rights and remedies on a licensee in relation to infringement<sup>3</sup>. Moreover, where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, and the mark is infringed before the prescribed particulars are registered, in proceedings for such an infringement the court<sup>4</sup> must not award him costs unless an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date or the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter<sup>5</sup>.

1 The sanctions, so far as may be relevant, will also apply to failure to register or apply to register a registrable transaction in respect of a trade mark application (see the Trade Marks Act 1994 s 27(1)), and failure to apply to register or request recordal of relevant transactions in the supplementary register or the international register (as appropriate) in respect of international trade marks (UK) (see the Trade Marks (International Registration) Order 1996, SI 1996/714, art 6(4), (5) (art 6(5) as substituted); and PARA 135 post).

2 See the Trade Marks Act 1994 s 25(1)(a); and PARA 130 ante.

3 See *ibid* s 25(3)(b); and PARA 130 ante.

4 For the meaning of 'the court' see PARA 349 post.

5 See the Trade Marks Act 1994 s 25(4) (as amended); and PARA 130 ante.

## **UPDATE**

### **133 Sanctions for failure to register**

NOTE 1--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iii) Assignment and Transmission/134. Amendment and removal of registered particulars.

#### **134. Amendment and removal of registered particulars.**

Provision may be made by rules<sup>1</sup> as to:

- 217 (1) the amendment of registered particulars<sup>2</sup> relating to a licence so as to reflect any alteration of the terms of the licence<sup>3</sup>; and
  - 218 (2) the removal of such particulars from the register<sup>4</sup>:
- 3
- 3. (a) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired<sup>5</sup>; or
  - 4. (b) where no such period is indicated and, after such period as may be prescribed, the registrar<sup>6</sup> has notified the parties of his intention to remove the particulars from the register<sup>7</sup>.
- 4

Provision may also be made by rules as to the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest<sup>8</sup>.

1 Trade Marks Act 1994 s 25(5). The provisions of s 25 apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark: s 27(1). See the Trade Marks Rules 2000, SI 2000/136, r 41 (made partly under the Trade Marks Act 1994 s 25); and PARA 132 ante. As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post.

2 As to registered particulars see PARA 131 ante.

3 Trade Marks Act 1994 s 25(5)(a). As to the licensing of trade marks see PARAS 136-137 post.

4 Ibid s 25(5)(b). As to the register see PARA 19 ante.

5 Ibid s 25(5)(b)(i).

6 As to the registrar see PARA 17 ante.

7 Trade Marks Act 1994 s 25(5)(b)(ii).

8 Ibid s 25(6). See also note 1 supra.

#### **UPDATE**

#### **134 Amendment and removal of registered particulars**

NOTE 1--SI 2000/136 r 41 now Trade Marks Rules 2008, SI 2008/1797, r 49.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iii) Assignment and Transmission/135. Notification of transactions affecting protected international trade marks (UK).

### **135. Notification of transactions affecting protected international trade marks (UK).**

The provisions pertaining to protected international trade marks (UK)<sup>1</sup> are different from the registration provisions which apply to transactions affecting registered trade marks<sup>2</sup>. Only one class of transactions affecting such marks is notifiable to the registry in the United Kingdom, namely the granting of any security interest (whether fixed or floating) over such a mark or any right in or under it<sup>3</sup>.

Particulars of notifiable transactions are entered in the supplementary register<sup>4</sup> in the same way as registration is effected of particulars of transactions relating to registered trade marks<sup>5</sup>. Apart from the special requirements relating to such notifiable transactions, transactions relating to international trade marks are recorded in the international register<sup>6</sup> rather than in the registry in the United Kingdom<sup>7</sup>.

Certain sanctions apply in a case of failure to register a registrable transaction relating to a registered trade mark<sup>8</sup>. These sanctions also apply on failure to notify to the registrar in the United Kingdom a notifiable transaction relating to a protected international trade mark (UK) as set out above<sup>9</sup>. The sanctions also apply when there is a failure to record in the international register certain relevant transactions, which are defined as:

- 219 (1) an assignment of an international trade mark (UK) or any right in it;
- 220 (2) the grant of a licence under an international trade mark (UK);
- 221 (3) the making by personal representatives of an assent in relation to an international trade mark (UK) or any right in or under it;
- 222 (4) an order of a court or other competent authority transferring the mark or any right in or under it<sup>10</sup>.

1 For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2 See PARA 130 et seq ante.

3 Trade Marks (International Registration) Order 1996, SI 1996/714, art 6(1) (substituted by SI 2002/692).

4 As to the supplementary register see PARA 19 ante.

5 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 6(2), (6) (art 6(6) substituted by SI 2000/138).

6 For the meaning of 'international register' see PARA 12 note 2 ante.

7 The entry of a person's name as proprietor in the international register is prima facie evidence of the validity of the assignment to him in any legal proceedings: see PARA 110 text and note 7 ante.

8 As to these sanctions see PARA 133 ante.

9 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 6(4), (5) (art 6(5) substituted by SI 2002/692).

10 Trade Marks (International Registration) Order 1996, SI 1996/714, art 6(3) (amended by SI 2002/692).

### **UPDATE**

**135 Notification of transactions affecting protected international trade marks (UK)**

TEXT AND NOTES--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iv) Licensing of Trade Marks/136. Freedom to license.

## **(iv) Licensing of Trade Marks**

### **136. Freedom to license.**

A licence<sup>1</sup> to use a registered trade mark<sup>2</sup> may be general or limited<sup>3</sup>.

A limited licence may, in particular, apply: (1) in relation to some but not all of the goods or services for which the trade mark is registered; or (2) in relation to use of the trade mark in a particular manner or a particular locality<sup>4</sup>.

A licence is not effective unless it is in writing signed by or on behalf of the grantor; and, where the grantor is a body corporate, this requirement may be satisfied by the affixing of its seal<sup>5</sup>.

Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest<sup>6</sup>.

Where the licence so provides, a sub-licence may be granted by the licensee<sup>7</sup>.

1 A licence to use a registered trade mark is a mere permission, and does not confer any proprietary right: *Northern & Shell plc v Condé Nast & National Magazines Distributors Ltd* [1995] RPC 117. The grant of a bare licence to use a trade mark (ie one with no quality control provisions), particularly if exclusive, will not, without more, render the trade mark deceptive: *EINSTEIN Trade Mark* [2007] RPC 539, Appointed Person; *Scandecor Development AB v Scandecor Marketing AB* [2001] UKHL 21, [2000] IP & T 218, [2002] FSR 122 (question referred to European Court of Justice for ruling but case settled before ruling given); cf *Case C-9/93 IHT Internationale Heiztechnik GmbH v Ideal Standard GmbH* [1994] ECR I-2789, [1995] FSR 59, ECJ; and see PARA 116 ante.

2 The Trade Marks Act 1994 s 28 also applies with the necessary modifications in relation to a protected international trade mark (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 7. As to the meaning of 'registered trade mark' see PARA 127 ante. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

3 Trade Marks Act 1994 s 28(1). The kind of licence here generally contemplated is a formal agreement rather than a mere informal consent to use the mark which suffices to provide the user with a defence to infringement (see PARA 84 ante). As to the general rights of a licensee in the case of infringement see PARA 418 post; and as to the rights of an exclusive licensee see PARA 419 post. The grant of a licence under a registered trade mark is a registrable transaction: see s 25(2); and PARA 130 ante. As to the amendment and removal of registered particulars see PARA 134 ante.

Sections 28, 29(2) (see PARA 137 post) apply only in relation to licences granted on or after 31 October 1994; and the old law continues to apply in relation to licences granted before that date: s 105, Sch 3 para 9(1). For the meaning of 'the old law' see PARA 4 note 3 ante. For the former system of approved licensing see the Trade Marks Act 1938 s 28 (repealed), whereby so-called 'registered user agreements' were vetted by the registrar to ensure sufficient connection with the licensor.

Existing entries under s 28 (repealed) (registered users) had to be transferred on 31 October 1994 to the register kept under the Trade Marks Act 1994 and have effect as if made under s 25 (see PARA 130 ante): Sch 3 para 9(2). Provision may be made by rules for putting such entries in the same form as is required under the Trade Marks Act 1994: Sch 3 para 9(2).

An application for registration as a registered user which was pending before the registrar on 31 October 1994 must be treated as an application for registration of a licence under s 25(1) (see PARA 130 ante) and must proceed accordingly: Sch 3 para 9(3). The registrar may require the applicant to amend his application so as to conform with the requirements of the Trade Marks Act 1994: Sch 3 para 9(3).

An application for registration as a registered user which has been determined by the registrar but not finally determined before 31 October 1994 is to be dealt with under the old law; and Sch 3 para 9(2) applies in relation to any resulting entry in the register: Sch 3 para 9(4).

Any proceedings pending on 31 October 1994 under the Trade Marks Act 1938 s 28(8) (repealed) or s 28(10) (repealed) (variation or cancellation of registration of registered user) is to be dealt with under the old law and any necessary alteration made to the new register: Trade Marks Act 1994 Sch 3 para 9(5).

4 Ibid s 28(1). See also note 3 supra.

5 Ibid s 28(2). See also note 3 supra.

6 Ibid s 28(3). References in the Trade Marks Act 1994 to doing anything with, or without, the consent of the proprietor of a registered trade mark is to be construed accordingly: s 28(3). See also note 3 supra.

7 Ibid s 28(4). References in the Trade Marks Act 1994 to a licence or licensee include a sub-licence or sub-licensee: s 28(4). See also note 3 supra.

## **UPDATE**

### **136 Freedom to license**

NOTE 2--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(7) REGISTERED TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/ (iv) Licensing of Trade Marks/137. Exclusive licences.

### **137. Exclusive licences.**

An 'exclusive licence' means a licence<sup>1</sup>, whether general or limited<sup>2</sup>, authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use<sup>3</sup> a registered trade mark<sup>4</sup> in the manner authorised by the licence; and the expression 'exclusive licensee' is to be construed accordingly<sup>5</sup>.

An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence<sup>6</sup>.

Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest<sup>7</sup>.

1 For the meaning of 'licence' see PARA 136 note 7 ante.

2 As to limited licences see PARA 136 ante.

3 For the meaning of 'use' see PARA 60 note 8 ante. As to the burden of proving use of a registered trade mark see the Trade Marks Act 1994 s 100; and PARA 114 ante.

4 Ibid s 29 also applies with the necessary modifications in relation to a protected international trade mark (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 7. As to the meaning of 'registered trade mark' see PARA 127 ante.

5 Trade Marks Act 1994 s 29(1). As to the general rights of a licensee in the case of infringement see PARA 418 post; and as to the rights and remedies of an exclusive licensee see PARA 419 post.

6 Ibid s 29(2).

7 Ibid s 28(3).

### **UPDATE**

### **137 Exclusive licences**

NOTE 4--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(i) Introduction/138. In general.

## **(8) OFFENCES**

### **(i) Introduction**

#### **138. In general.**

The Trade Marks Act 1994 provides for a number of offences<sup>1</sup>. In addition a power of forfeiture of goods and materials relating to infringement is conferred upon a criminal court<sup>2</sup>. The offences under the Act relate to:

- 223 (1) registered trade mark agents<sup>3</sup>;
- 224 (2) the unauthorised use of a registered trade mark<sup>4</sup>;
- 225 (3) falsification of the register<sup>5</sup>;
- 226 (4) falsely representing a trade mark as registered<sup>6</sup>; and
- 227 (5) the unauthorised use of the royal arms<sup>7</sup>.

The Olympic Symbol etc (Protection) Act 1995 provides for further offences relating to the unauthorised use of controlled representations<sup>8</sup>.

1 For the application of these offences to Community trade marks see PARA 268-269 post.

2 See the Trade Marks Act 1994 s 97; and PARA 140 post.

3 See *ibid* s 84; and PARA 32 ante.

4 See *ibid* s 92; and PARAS 141-144 post.

5 See *ibid* s 94; and PARA 147 post.

6 See *ibid* s 95; and PARA 148 post.

7 See *ibid* s 99; and PARA 488 post.

8 See the Olympic Symbol etc (Protection) Act 1995 s 8; and PARA 498 post. For the meaning of 'controlled representation' see PARA 493 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(i) Introduction/139. Offences committed by partnerships and bodies corporate.

### **139. Offences committed by partnerships and bodies corporate.**

Proceedings for an offence under the Trade Marks Act 1994 alleged to have been committed by a partnership must be brought against the partnership in the name of the firm and not in that of the partners<sup>1</sup>. A fine imposed on a partnership on its conviction in such proceedings must be paid out of the partnership assets<sup>2</sup>.

Where a partnership is guilty of an offence under the Trade Marks Act 1994, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is also guilty of the offence and liable to be proceeded against and punished accordingly<sup>3</sup>.

The following provisions apply for the purposes of proceedings under the Trade Marks Act 1994 against a partnership as in relation to a body corporate: (1) any rules of court relating to the service of documents; and (2) the statutory provisions<sup>4</sup> relating to procedure on charge of an offence<sup>5</sup>.

Where an offence under the Trade Marks Act 1994 committed by a body corporate is proved to have been committed with the consent or connivance of a director<sup>6</sup>, manager, secretary or other similar officer of the body, or a person purporting to act in any such capacity, he as well as the body corporate is guilty of the offence and liable to be proceeded against and punished accordingly<sup>7</sup>.

1 Trade Marks Act 1994 s 101(1), which is expressed to be without prejudice to s 101(4) (see the text and note 3 infra).

2 Ibid s 101(3).

3 Ibid s 101(4). It is not a requirement that the partnership has actually been convicted of the offence: *R v Wakefield and Purselove* [2004] EWCA Crim 2278, 168 JP 505 (partnership dissolved by time of trial).

4 I.e. the Magistrates' Courts Act 1980 s 46, Sch 3 (as amended): see MAGISTRATES vol 29(2) (Reissue) PARA 666.

5 Trade Marks Act 1994 s 101(2).

6 For the meaning of 'director' see PARA 32 note 11 ante.

7 Trade Marks Act 1994 s 101(5).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(i) Introduction/140. Forfeiture of counterfeit goods etc.

#### **140. Forfeiture of counterfeit goods etc.**

Where there has come into the possession of any person<sup>1</sup> in connection with the investigation or prosecution of a relevant offence<sup>2</sup>:

- 228 (1) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trade mark<sup>3</sup>;
- 229 (2) material bearing such a sign and intended to be used for labelling or packaging goods, as a business<sup>4</sup> paper in relation to goods, or for advertising goods<sup>5</sup>; or
- 230 (3) articles specifically designed or adapted for making copies of such a sign<sup>6</sup>,

that person may apply for an order for the forfeiture of the goods, material or articles<sup>7</sup>.

Such an application may be made: (a) where proceedings have been brought in any court for a relevant offence relating to some or all of the goods, material or articles, to that court; (b) where no application for the forfeiture of the goods, material or articles has been made under head (a) above, by way of complaint to a magistrates' court<sup>8</sup>.

On such an application the court must make an order for the forfeiture of any goods, material or articles only if it is satisfied that a relevant offence has been committed in relation to the goods, material or articles<sup>9</sup>. A court may infer for these purposes that such an offence has been committed in relation to any goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are representative of them, whether by reason of being of the same design or part of the same consignment or batch or otherwise<sup>10</sup>.

Any person aggrieved by an order so made by a magistrates' court, or by a decision of such a court not to make such an order, may appeal against that order or decision to the Crown Court; and an order so made may contain such provision as appears to the court to be appropriate for delaying the coming into force of the order pending the making and determination of any appeal, including any application<sup>11</sup> for a statement of case<sup>12</sup>.

Where any goods, material or articles are so forfeited, they must be destroyed in accordance with such directions as the court may give<sup>13</sup>; but, on so making an order, the court may, if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates must (instead of being destroyed) be released, to such person as the court may specify, on condition that that person causes the offending sign to be erased, removed or obliterated and complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture<sup>14</sup>.

<sup>1</sup> This includes a local weights and measures authority: see the Trade Marks Act 1994 s 93; and PARA 146 post.

<sup>2</sup> For these purposes, a 'relevant offence' means an offence under *ibid* s 92 (see PARAS 141-144 post) or under the Trade Descriptions Act 1968 (see *SALE OF GOODS AND SUPPLY OF SERVICES* vol 41 (2005 Reissue) PARA 475 et seq) or any offence involving dishonesty or deception: Trade Marks Act 1994 s 97(8).

<sup>3</sup> *Ibid* s 97(1)(a). Section 97 also applies to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 17. As to the application of this provision to

Community trade marks see PARA 268 post. As to the meaning of 'registered trade mark' see PARA 127 ante. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

4 For the meaning of 'business' see PARA 32 note 3 ante.

5 Trade Marks Act 1994 s 97(1)(b).

6 Ibid s 97(1)(c).

7 Ibid s 97(1). Forfeiture proceedings are civil proceedings, and as such fall within the Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial matters (Brussels, 27 September 1968; Cmnd 7395) (see PARA 250 post; and CONFLICT OF LAWS vol 8(3) (Reissue) PARA 65): *R v Crown Court at Harrow, ex p UNIC Centre Sarl* [2000] 2 All ER 449, [2000] 1 WLR 2112, sub nom *Unic Centre Sarl v Brent & Harrow Trading Standards Office* [2000] FSR 667.

As to the provisions permitting infringing goods, material or articles to be treated as prohibited goods see PARA 149 post.

8 Trade Marks Act 1994 s 97(2).

9 Ibid s 97(3).

10 Ibid s 97(4).

11 Ie under the Magistrates' Courts Act 1980 s 111: see MAGISTRATES vol 29(2) (Reissue) PARA 885 et seq.

12 Trade Marks Act 1994 s 97(5).

13 Ibid s 97(6).

14 Ibid s 97(7).

## UPDATE

### 140 Forfeiture of counterfeit goods etc

NOTE 2--Trade Marks Act 1994 s 97(8) amended: SI 2008/1277.

NOTE 3--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(ii) Unauthorised Use/141. Goods and packaging.

## (ii) Unauthorised Use

### 141. Goods and packaging.

A person commits an offence<sup>1</sup> who, with a view to<sup>2</sup> gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor<sup>3</sup>:

- 231 (1) applies to goods or their packaging a sign identical to, or likely to be mistaken for<sup>4</sup>, a registered trade mark<sup>5</sup>; or
- 232 (2) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign<sup>6</sup>; or
- 233 (3) has in his possession, custody or control in the course of a business<sup>7</sup> any such goods with a view to the doing of anything, by himself or another, which would be an offence under head (2) above<sup>8</sup>.

A person guilty of an offence under head (1), head (2), or head (3) above is liable on conviction to imprisonment or a fine or both<sup>9</sup>.

1 For an offence to be committed there must be civil infringement of the trade mark, and thus defences to infringement such as those under the Trade Marks Act 1994 s 11 (see PARAS 95-97 ante) are also defences under s 92: *R v Johnstone*[2003] UKHL 28, [2003] 3 All ER 884, [2003] 1 WLR 1736. Furthermore, infringement and the commission of an offence requires use of the sign in question as a trade mark: *R v Johnstone* supra; *R v Isaac*[2004] EWCA Crim 1082, 168 JP 417 (jury must be directed that offence is committed only when as a first element the offending sign is used as an indication of trade origin). The test as to whether a sign has been used as an indication of trade origin is how the use of the sign would be perceived by the average consumer of the type of goods in question: *R v Thompson*[2006] EWCA Crim 3058, [2006] All ER (D) 223 (Nov).

2 The words 'with a view to' encompass something that the defendant had in contemplation, not necessarily something he wanted or intended to happen but something which might realistically occur; they are to be contrasted with 'with intent to': *R v Zaman*[2002] EWCA Crim 1862, [2003] FSR 230.

3 Trade Marks Act 1994 s 92(1).

4 'Applies' should be given its ordinary meaning of placing the sign on the goods or causing it to be so placed, and not extended to include the sale or exposure for sale of goods: *Nottinghamshire County Council v Woolworths plc* [2007] FSR 489.

'Likely to be mistaken for' appears to be a narrower test than 'likelihood of confusion' under the Trade Marks Act 1994 s 10(2), since the latter compasses not only signs which the average consumer mistakes for a trade mark, but also those which he believes denote goods or services that come from the same or economically linked undertakings (see PARA 74 ante). Nevertheless surrounding circumstances must equally be discounted, since otherwise a vendor of counterfeit goods could escape liability by making it clear that they were not genuine: see *Akhtar v Grout*(1998) 162 JP 714, DC.

5 Trade Marks Act 1994 s 92(1)(a). As to the meaning of 'registered trade mark' see PARA 127 ante. This provision also applies to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 17. As to the application of this provision to unauthorised use of a Community trade mark see PARA 268 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

6 Trade Marks Act 1994 s 92(1)(b).

7 For the meaning of 'business' see PARA 32 note 3 ante. As to the meaning of 'in the course of business' see PARA 467 note 1 post.



8 Trade Marks Act 1994 s 92(1)(c).

9 Ibid s 92(6). Such a person is liable on conviction on indictment to imprisonment for a term not exceeding ten years or to a fine or to both, or on summary conviction to imprisonment for a term not exceeding six months or to a fine not exceeding the statutory maximum or to both: see s 92(6). The 'statutory maximum', with reference to a fine or penalty on summary conviction for an offence, is the prescribed sum within the meaning of the Magistrates' Courts Act 1980 s 32 (as amended): see the Interpretation Act 1978 s 5, Sch 1 (definition added by the Criminal Justice Act 1988 s 170(1), Sch 15 para 58); and SENTENCING AND DISPOSITION OF OFFENDERS vol 92 (2010) PARA 140. The 'prescribed sum' means £5,000 or such sum as is for the time being substituted in this definition by order under the Magistrates' Courts Act 1980 s 143(1) (as substituted): see s 32(9) (amended by the Criminal Justice Act 1991 s 17(2)); and SENTENCING AND DISPOSITION OF OFFENDERS vol 92 (2010) PARA 141.

As to sentencing see *R v Gleeson*[2001] EWCA Crim 2023, [2002] 1 Cr App Rep (S) 485, [2001] All ER (D) 22 (Oct) (potential loss to music industry resulting from unauthorised use of trade marks on compact discs was factor relevant to level of sentence); *R v Neil Lesley Woolridge*[2005] EWCA Crim 1086, [2006] 1 Cr App Rep (S) 72. A conviction under the Trade Marks Act 1994 s 92 can found a confiscation order under the Criminal Justice Act 1988 s 71 (repealed: see now the Proceeds of Crime Act 2002 s 6; and SENTENCING AND DISPOSITION OF OFFENDERS vol 92 (2010) PARA 390 et seq) even where the indictment did not allege selling or offering for sale the infringing goods: *R v Davies*[2003] EWCA Crim 3110, [2004] 2 All ER 706, [2004] FSR 486.

As to offences committed by partnerships and bodies corporate see PARA 139 ante. For exceptions and defences see PARA 144 post. As to the power to issue search warrants see PARA 145 post.

## UPDATE

### 141-146 Unauthorised use

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

### 141 Goods and packaging

NOTE 6--The 1994 Act s 92(1)(b) is not limited to those cases where the other party to the immediate transaction would regard the sign as indicative of trade origin: *R v Morgan (Prosecution Appeal under s 58 of the Criminal Justice Act 2003)*[2006] EWCA Crim 1742, [2008] All ER (D) 120 (Mar).

NOTE 8--Goods stored in the matrimonial home are not necessarily in the possession of both husband and wife: *R v Kousar*[2009] EWCA Crim 139, [2009] 2 Cr App Rep 88, [2009] All ER (D) 289 (Mar).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(ii) Unauthorised Use/142. Material for packaging etc.

## **142. Material for packaging etc.**

A person commits an offence<sup>1</sup> who with a view to<sup>2</sup> gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor<sup>3</sup>:

- 234 (1) applies a sign identical to, or likely to be mistaken for<sup>4</sup>, a registered trade mark<sup>5</sup> to material intended to be used for labelling or packaging goods, as a business<sup>6</sup> paper in relation to goods, or for advertising goods<sup>7</sup>; or
- 235 (2) uses in the course of a business material bearing such a sign for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods<sup>8</sup>; or
- 236 (3) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under head (2) above<sup>9</sup>.

A person guilty of an offence under head (1), head (2), or head (3) above is liable on conviction to imprisonment or a fine or both<sup>10</sup>.

1 As to committing an offence see PARA 141 note 1 ante.

2 As to the meaning of 'with a view to' see PARA 141 note 2 ante.

3 Trade Marks Act 1994 s 92(2).

4 As to the meaning of 'likely to be mistaken for' see PARA 141 note 4 ante.

5 As to the meaning of 'registered trade mark' see PARA 127 ante. This provision also applies to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 17. As to the application of this provision to Community trade marks see PARA 268 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

6 For the meaning of 'business' see PARA 32 note 3 ante.

7 Trade Marks Act 1994 s 92(2)(a).

8 Ibid s 92(2)(b).

9 Ibid s 92(2)(c).

10 Ibid s 92(6). Such a person is liable on conviction on indictment to imprisonment for a term not exceeding ten years or to a fine or to both, or on summary conviction to imprisonment for a term not exceeding six months or to a fine not exceeding the statutory maximum or to both: see s 92(6). As to the statutory maximum, and as to sentencing, see PARA 141 note 9 ante. As to offences committed by partnerships and bodies corporate see PARA 139 ante. For exceptions and defences see PARA 144 post. As to the power to issue search warrants see PARA 145 post.

## **UPDATE**

### **141-146 Unauthorised use**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(ii) Unauthorised Use/143. Making and possessing copies of a sign.

### **143. Making and possessing copies of a sign.**

A person commits an offence<sup>1</sup> who with a view to gain<sup>2</sup> for himself or another, or with intent to cause loss to another, and without the consent of the proprietor<sup>3</sup>:

- 237 (1) makes an article specifically designed or adapted for making copies of a sign identical to, or likely to be mistaken for<sup>4</sup>, a registered trade mark<sup>5</sup>; or
- 238 (2) has such an article in his possession, custody or control in the course of a business<sup>6</sup>,

knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods<sup>7</sup>.

A person guilty of an offence under head (1), head (2), or head (3) above is liable on conviction to imprisonment or a fine or both<sup>8</sup>.

1 As to committing an offence see PARA 141 note 1 ante.

2 As to the meaning of 'with a view to gain' see PARA 141 note 2 ante.

3 Trade Marks Act 1994 s 92(3).

4 As to the meaning of 'likely to be mistaken for' see PARA 141 note 4.

5 Trade Marks Act 1994 s 92(3)(a). As to the meaning of 'registered trade mark' see PARA 127 ante. This provision also applies to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 17. As to the application of this provision to Community trade marks see PARA 268 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

6 Trade Marks Act 1994 s 92(3)(b). For the meaning of 'business' see PARA 32 note 3 ante.

7 Ibid s 92(3).

8 Ibid s 92(6). Such a person is liable on conviction on indictment to imprisonment for a term not exceeding ten years or to a fine or to both, or on summary conviction to imprisonment for a term not exceeding six months or to a fine not exceeding the statutory maximum or to both: see s 92(6). As to the statutory maximum, and as to sentencing, see PARA 141 note 9 ante. As to offences committed by partnerships and bodies corporate see PARA 139 ante. For exceptions and defences see PARA 144 post. As to the power to issue search warrants see PARA 145 post.

## **UPDATE**

### **141-146 Unauthorised use**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(ii) Unauthorised Use/144. Exceptions and defences.

#### **144. Exceptions and defences.**

A person does not commit an offence of the unauthorised use of a trade mark etc in relation to goods<sup>1</sup> unless the goods are goods in respect of which the trade mark<sup>2</sup> is registered<sup>3</sup> or the trade mark has a reputation in the United Kingdom<sup>4</sup> and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark<sup>5</sup>.

It is a defence for a person charged with any such offence to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark<sup>6</sup>.

1    Is an offence under the Trade Marks Act 1994 s 92(1)-(3): see PARAS 141-143 ante. This provision also applies to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 17. As to the application of this provision to Community trade marks see PARA 268 post. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

2    For the meaning of 'trade mark' see PARA 57 ante.

3    For the meaning of 'registered' see PARA 19 note 2 ante.

4    For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

5    Trade Marks Act 1994 s 92(4). As to tests of taking unfair advantage of, and detriment to, the distinctive character or repute of a trade see PARA 76 ante.

6    Ibid s 92(5). The onus of proof is on the person charged, who bears a persuasive burden to prove the defence on the balance of probabilities: *R v Johnstone* [2003] UKHL 28, [2003] 3 All ER 884, [2003] 1 WLR 1736. The Trade Marks Act 1994 s 92(5) extends to an honest and reasonable belief that the mark concerned is not registered: *R v Johnstone* supra.

#### **UPDATE**

##### **141-146 Unauthorised use**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(ii) Unauthorised Use/145. Search warrants.

#### **145. Search warrants.**

Where a justice of the peace is satisfied by information on oath given by a constable that there are reasonable grounds for believing that an offence in relation to the unauthorised use of a trade mark in relation to goods<sup>1</sup> has been or is about to be committed in any premises<sup>2</sup>, and that evidence that such an offence has been or is about to be committed is in those premises, he may issue a warrant authorising a constable to enter and search the premises, using such reasonable force as is necessary<sup>3</sup>. A warrant may authorise persons to accompany any constable executing the warrants, and remains in force for three months from the date of its issue<sup>4</sup>. In executing a warrant issued these provisions a constable may seize any article if he reasonably believes that it is evidence that an offence<sup>5</sup> has been or is about to be committed<sup>6</sup>.

1    le an offence under the Trade Marks Act 1994 s 92: see PARAS 141-144 ante.

2    'Premises' includes land, buildings, fixed or movable structures, vehicles, vessels, aircraft and hovercraft: *ibid* s 92A(5) (s 92A added by the Copyright etc and Trade Marks (Offences and Enforcement) Act 2002 s 6).

3    The Trade Marks Act 1994 s 92A(1) (as added: see note 2 *supra*). The power conferred by s 92A(1) (as added) does not extend to authorising a search for certain classes of personal or confidential material contained in the Police and Criminal Evidence Act 1984 s 9(2) (see CRIMINAL LAW, EVIDENCE AND PROCEDURE vol 11(2) (2006 Reissue) PARA 874): Trade Marks Act 1994 s 92A(2) (as so added).

4    *Ibid* s 92A(3) (as added (see note 2 *supra*); and amended by the Serious Organised Crime and Police Act 2005 s 174(1), Sch 16 para 8).

5    le an offence under the Trade Marks Act 1994 s 92: see PARAS 141-144 ante.

6    *Ibid* s 92A(4) (as added: see note 2 *supra*).

#### **UPDATE**

#### **141-146 Unauthorised use**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/(ii) Unauthorised Use/146. Enforcement function of local weights and measures authority.

#### **146. Enforcement function of local weights and measures authority.**

It is the duty of every local weights and measures authority<sup>1</sup> to enforce within its area the statutory provisions<sup>2</sup> relating to the unauthorised use of a trade mark etc in relation to goods<sup>3</sup>.

<sup>1</sup> The local weights and measures authorities are: (1) in England: (a) for each non-metropolitan county, metropolitan district and London borough, the council of that county, district or borough; (b) for the City of London and the Inner and Middle Temples, the Common Council of the City of London; and (c) for the Isles of Scilly, the Council of the Isles of Scilly (Weights and Measures Act 1985 s69(1)); and (2) in Wales: (a) for each county, the county council; and (b) for each county borough, the county borough council (s 69(2) (amended by the Local Government (Wales) Act 1994 s 66(6), Sch 16 para 75). As to the duties and functions of such authorities see the Weights and Measures Act 1985 Pt VI (ss 69-78); and WEIGHTS AND MEASURES vol 50 (2005 Reissue) PARA 20 et seq.

<sup>2</sup> I.e. the Trade Marks Act 1994 s 92 (see PARAS 141-144 ante), including such provisions in so far as they apply to Community trade marks (see PARA 268 post). This provision also applies to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 17. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante. The following provisions of the Trade Descriptions Act 1968 apply in relation to the enforcement of the Trade Marks Act 1994 s 92 as in relation to the enforcement of the Trade Descriptions Act 1968: s 27 (power to make test purchases), s 28 (as amended) (power to enter premises and inspect and seize goods and documents), s 29 (as amended) (obstruction of authorised officers), s 33 (compensation for the loss etc of goods seized) (see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 507 et seq); Trade Marks Act 1994 s 93(2).

<sup>3</sup> Ibid s 93(1). This provision does not, however, apply in relation to the enforcement of s 92 in Northern Ireland. As to enforcement in Northern Ireland see s 93(3). Nothing in s 93 is to be construed as authorising a local weights and measures authority to bring proceedings in Scotland for an offence: s 93(5).

Any enactment which authorises the disclosure of information for the purpose of facilitating the enforcement of the Trade Descriptions Act 1968 applies as if the Trade Marks Act 1994 s 92 were contained in the Trade Descriptions Act 1968 and as if the functions of any person in relation to the enforcement of the Trade Marks Act 1994 s 92 were functions under the Trade Descriptions Act 1968: Trade Marks Act 1994 s 93(4).

#### **UPDATE**

#### **141-146 Unauthorised use**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/ (iii) Other Offences/147. Falsification of register etc.

### **(iii) Other Offences**

#### **147. Falsification of register etc.**

It is an offence for a person to make, or cause to be made, a false entry in the register of trade marks<sup>1</sup>, knowing or having reason to believe that it is false<sup>2</sup>.

It is also an offence for a person:

- 239 (1) to make or cause to be made anything falsely purporting to be a copy of an entry in the register; or
- 240 (2) to produce or tender or cause to be produced or tendered in evidence any such thing,

knowing or having reason to believe that it is false<sup>3</sup>.

A person guilty of such an offence is liable on conviction to imprisonment or a fine or both<sup>4</sup>.

1 As to the register see PARA 19 ante. For the meaning of 'trade mark' see PARA 57 ante.

2 Trade Marks Act 1994 s 94(1).

3 Ibid s 94(2).

4 Ibid s 94(3). Such a person is liable on conviction on indictment to imprisonment for a term not exceeding two years or to a fine or to both, or on summary conviction to imprisonment for a term not exceeding six months or to a fine not exceeding the statutory maximum or to both: see s 94(3). As to the statutory maximum see PARA 141 note 9 ante. As to offences committed by partnerships and bodies corporate see PARA 139 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (8) OFFENCES/ (iii) Other Offences/148. Falsely representing trade mark as registered.

#### **148. Falsely representing trade mark as registered.**

It is an offence for a person:

- 241 (1) falsely to represent that a mark is a registered trade mark<sup>1</sup> or a protected international trade mark (UK)<sup>2</sup>; or
- 242 (2) to make a false representation as to the goods or services for which a trade mark is registered, or as to the goods or services covered by a protected international trade mark (UK),

knowing or having reason to believe that the representation is false<sup>3</sup>. A person guilty of such an offence is liable on conviction to a fine<sup>4</sup>.

For these purposes, the use<sup>5</sup> in the United Kingdom<sup>6</sup> in relation to a trade mark of the word 'registered' or of any other word or symbol importing a reference, express or implied, to registration, is deemed to be a representation as to registration under the Trade Marks Act 1994 unless it is shown that the reference is to registration elsewhere than in the United Kingdom and that the trade mark is in fact so registered for the goods or services in question<sup>7</sup>.

The use of the words 'trade mark' in respect of an unregistered trade mark does not necessarily constitute an offence under head (1) or head (2) above<sup>8</sup>. Where a false representation as to registration has been made, this may affect a claim in passing off<sup>9</sup> or a claim that a mark has become distinctive by use<sup>10</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 ante.

2 For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

3 Trade Marks Act 1994 s 95(1); Trade Marks (International Registration) Order 1996, SI 1996/714, art 18(1).

4 Trade Marks Act 1994 s 95(3); Trade Marks (International Registration) Order 1996, SI 1996/714, art 18(2). Such a person is liable on summary conviction to a fine not exceeding level 3 on the standard scale: see Trade Marks Act 1994 s 95(3); and the Trade Marks (International Registration) Order 1996, SI 1996/714, art 18(2). As to the standard scale see PARA 32 note 13 ante. As to offences committed by partnerships and bodies corporate see PARA 139 ante.

5 For the meaning of 'use' see PARA 60 note 8 ante.

6 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

7 Trade Marks Act 1994 s 95(2). There is no express reference in the Trade Marks Act 1994 to the symbol ®, but s 95 will cover the use of it. It is sufficient for this purpose that the reference is consistent with registration outside the United Kingdom and that such registration exists: *Second Sight Ltd v Novell UK Ltd* [1995] RPC 423.

8 *Sen Sen Co v Britten* [1899] 1 Ch 692, 16 RPC 137.

9 As to passing off see PARA 304 et seq post.

10 See PARA 101 note 5 ante.

#### **UPDATE**

#### **148 Falsely representing trade mark as registered**

NOTES 3, 4--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (9) IMPORTATION; POWERS OF THE COMMISSIONERS FOR HER MAJESTY'S REVENUE AND CUSTOMS/149. Infringing goods, material or articles to be treated as prohibited goods.

## **(9) IMPORTATION; POWERS OF THE COMMISSIONERS FOR HER MAJESTY'S REVENUE AND CUSTOMS**

### **149. Infringing goods, material or articles to be treated as prohibited goods.**

The proprietor of a registered trade mark<sup>1</sup>, or a licensee<sup>2</sup>, may give notice in writing to the Commissioners for Her Majesty's Revenue and Customs<sup>3</sup>:

- 243 (1) that he is the proprietor or, as the case may be, a licensee of the registered trade mark<sup>4</sup>;
- 244 (2) that, at a time and place specified in the notice, goods which are, in relation to that registered trade mark, infringing goods<sup>5</sup>, material<sup>6</sup> or articles<sup>7</sup> are expected to arrive in the United Kingdom<sup>8</sup> from outside the European Economic Area ('EEA')<sup>9</sup> or from within the EEA but not having been entered for free circulation<sup>10</sup>; and
- 245 (3) that he requests the Commissioners to treat them as prohibited goods<sup>11</sup>.

When such a notice is in force, the importation of the goods to which the notice relates, otherwise than by a person for his private and domestic use, is prohibited; but a person is not by reason of the prohibition liable to any penalty other than forfeiture of the goods<sup>12</sup>.

The above provisions do not apply to goods placed in, or expected to be placed in, one of the following situations<sup>13</sup>:

- 246 (a) when they are entered for release for free circulation, export or re-export;
- 247 (b) when they are found during checks on goods entering or leaving the Community customs territory, placed under a suspensive procedure, in the process of being re-exported subject to notification or placed in a free zone or free warehouse,

in respect of which an application may be made under the European Community measures<sup>14</sup> laid down to prohibit the release of counterfeit and pirated goods<sup>15</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 ante. These provisions also apply to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 16. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante. As to the application of these provisions to Community trade marks see PARA 267 post.

2 As to licences see PARAS 136-137 ante.

3 Trade Marks Act 1994 s 89(1) (amended by virtue of the Commissioners for Revenue and Customs Act 2005 s 50(1), (7)). As to the Commissioners for Her Majesty's Revenue and Customs see CUSTOMS AND EXCISE vol 12(3) (2007 Reissue) PARA 900 et seq. As to the form in which the notice is to be given see PARA 151 post.

The Trade Marks Act 1994 s 89(1) (as amended) applies in relation to an authorised user of a registered collective mark or a registered certification mark as in relation to a licensee of a trade mark: see ss 49(2), 50(2), Sch 1 para 11(c), Sch 2 para 13(c); and PARAS 162, 173 post.

4 Ibid s 89(1)(a).

5 For the meaning of 'infringing goods' see PARA 150 post.

6 For the meaning of 'infringing material' see PARA 150 post.

7 For the meaning of 'infringing articles' see PARA 150 post.

8 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

9 As to the EEA see PARA 102 note 6 ante.

10 Trade Marks Act 1994 s 89(1)(b).

11 Ibid s 89(1)(c).

12 Ibid s 89(2).

13 In the situations referred to in EC Council Regulation 1383/2003 (OJ L196, 2.8.2003, p 7) concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights, art 1(1): Trade Marks Act 1994 s 89(3) (substituted by the Goods Infringing Intellectual Property Rights (Customs) Regulations 2004, SI 2004/1473, reg 13).

See *Pointing v Customs and Excise Comrs* [1999] FSR 394 (customs officers may initiate a court action to determine whether the goods are counterfeit, but it is for the court to make the final decision).

14 In under EC Council Regulation 1383/2003 (OJ L196, 2.8.2003, p 7) art 5(1): Trade Marks Act 1994 s 89(3) (as substituted: see note 13 supra). See *Pointing v Customs and Excise Comrs* [1999] FSR 394.

15 Trade Marks Act 1994 s 89(3) (as substituted: see note 13 supra).

## **UPDATE**

### **149-152 Importation; powers of the Commissioners for Her Majesty's Revenue and Customs**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (9) IMPORTATION; POWERS OF THE COMMISSIONERS FOR HER MAJESTY'S REVENUE AND CUSTOMS/150. Meaning of 'infringing goods', 'infringing material' and 'infringing articles'.

### **150. Meaning of 'infringing goods', 'infringing material' and 'infringing articles'.**

The expressions 'infringing goods', 'infringing material' and 'infringing articles' are to be construed as follows<sup>1</sup>.

Goods are 'infringing goods', in relation to a registered trade mark<sup>2</sup>, if they or their packaging bear a sign identical or similar to that mark<sup>3</sup> and:

- 248 (1) the application of the sign to the goods or their packaging was an infringement<sup>4</sup> of the registered trade mark<sup>5</sup>; or
- 249 (2) the goods are proposed to be imported into the United Kingdom<sup>6</sup> and the application of the sign in the United Kingdom to them or their packaging would be an infringement of the registered trade mark<sup>7</sup>; or
- 250 (3) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark<sup>8</sup>.

Nothing in the above provisions is, however, to be construed as affecting the importation of goods which may lawfully be imported into the United Kingdom by virtue of an enforceable Community right<sup>9</sup>.

Material is 'infringing material', in relation to a registered trade mark, if it bears a sign identical or similar to that mark<sup>10</sup> and either: (a) it is used for labelling or packaging goods, as a business<sup>11</sup> paper, or for advertising goods or services, in such a way as to infringe the registered trade mark<sup>12</sup>; or (b) it is intended to be so used and such use would infringe the registered trade mark<sup>13</sup>.

'Infringing articles', in relation to a registered trade mark, means<sup>14</sup> articles: (i) which are specifically designed or adapted for making copies of a sign identical or similar to that mark<sup>15</sup>; and (ii) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material<sup>16</sup>.

1 Trade Marks Act 1994 s 17(1).

2 As to the meaning of 'registered trade mark' see PARA 127 ante. As to protected international trade marks (UK) see the Trade Marks (International Registration) Order 1996, SI 1996/714, art 16. For the meaning of 'protected international trademark (UK)' see PARA 13 ante. As to the application of these provisions to Community trade marks see PARA 267 post.

3 Trade Marks Act 1994 s 17(2).

4 For the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see *ibid* s 10; and PARA 86 et seq ante.

5 *Ibid* s 17(2)(a).

6 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

7 Trade Marks Act 1994 s 17(2)(b).

8 *Ibid* s 17(2)(c).

9 Ibid s 17(3). For the meaning of 'enforceable Community right' see the European Communities Act 1972 s 2(1); and the Interpretation Act 1978 s 5, Sch 1. As to the prohibition of the importation of infringing goods, materials or articles see PARA 149 ante.

10 Trade Marks Act 1994 s 17(4).

11 For the meaning of 'business' see PARA 32 note 3 ante.

12 Trade Marks Act 1994 s 17(4)(a).

13 Ibid s 17(4)(b).

14 Ibid s 17(5).

15 Ibid s 17(5)(a).

16 Ibid s 17(5)(b).

## **UPDATE**

### **149-152 Importation; powers of the Commissioners for Her Majesty's Revenue and Customs**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (9) IMPORTATION; POWERS OF THE COMMISSIONERS FOR HER MAJESTY'S REVENUE AND CUSTOMS/151. Power of the Commissioners for Revenue and Customs to make regulations.

### **151. Power of the Commissioners for Revenue and Customs to make regulations.**

The Commissioners for Her Majesty's Revenue and Customs<sup>1</sup> may make regulations prescribing the form in which notice is to be given requiring goods, materials or articles to be treated as prohibited goods<sup>2</sup> and requiring a person giving notice: (1) to furnish the Commissioners with such evidence as may be specified in the regulations, either on giving notice or when the goods are imported, or at both those times; and (2) to comply with such other conditions as may be specified in the regulations<sup>3</sup>.

The regulations may, in particular, require a person giving such a notice: (a) to pay such fees in respect of the notice as may be specified by the regulations; (b) to give such security as may be so specified in respect of any liability or expense which the Commissioners may incur in consequence of the notice by reason of the detention of any goods or anything done to goods detained; (c) to indemnify the Commissioners against any such liability or expense, whether security has been given or not<sup>4</sup>.

If notice is given<sup>5</sup> by the proprietor or licensee of a registered trade mark in respect of certain goods, it must be in the prescribed form<sup>6</sup> or a form to the like effect approved by the Commissioners; and separate notices must be given in respect each arrival of such goods<sup>7</sup>. A fee in respect of each notice must be paid to the Commissioners at the time it is given<sup>8</sup>. The person giving the notice must give to the Commissioners such security or further security within such time and in such manner, whether by deposit of a sum of money or guarantee, as the Commissioners may require, in respect of any liability or expense which they may incur in consequence of the notice by reason of the detention of any goods or anything done to goods so detained; and, if such security or further security is not given within the time specified by the Commissioners, the notice has no effect<sup>9</sup>. In every case, however, whether any security or further security is given or not, the person who has given the notice must keep the Commissioners indemnified against all such liability and expense<sup>10</sup>.

The person giving the notice must, either on giving notice or when the goods are imported, furnish the Commissioners with the certificate of registration<sup>11</sup>, or a copy of it, issued by the registrar<sup>12</sup> on the registration of the trade mark specified in the notice, together with evidence that such registration was duly renewed<sup>13</sup> at all such times as it may have expired<sup>14</sup>. If such a certificate or copy and, where applicable, evidence of renewal is not so furnished, the goods may not be detained or, if detained, must be released and any notice given in respect of them has no effect<sup>15</sup>.

<sup>1</sup> As to the Commissioners for Her Majesty's Revenue and Customs see CUSTOMS AND EXCISE vol 12(3) (2007 Reissue) PARA 900 et seq.

<sup>2</sup> I.e. notice under the Trade Marks Act 1994 s 89 (as amended): see PARA 149 ante.

<sup>3</sup> Ibid s 90(1) (amended by virtue of the Commissioners for Revenue and Customs Act 2005 s 50(1), (7)). The regulations may make different provision as respects different classes of case to which they apply and may include such incidental and supplementary provisions as the Commissioners consider expedient: Trade Marks Act 1994 s 90(3). Any such regulations must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament: s 90(4). As to the regulations that have been made see the Trade Marks (Customs) Regulations 1994, SI 1994/2625, which came into force on 31 October 1994 (see reg 1). See further the text and notes 5-15 infra.

These provisions also apply to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 16. For the meaning of 'protected international mark (UK)' see PARA 13 ante. As to the application of these provisions to Community trade marks see PARA 267 post.

4 Trade Marks Act 1994 s 90(2).

5 le under ibid s 89(1) (as amended): see PARA 149 ante.

6 For the prescribed form of notice see the Trade Marks (Customs) Regulations 1994, SI 1994/2625, reg 2, Schedule.

7 Ibid reg 2.

8 Ibid reg 3. The fee is currently £30 plus VAT: reg 3.

9 Ibid reg 4, which is expressed to be without prejudice to the operation of reg 5 (see the text to note 10 infra).

10 Ibid reg 5.

11 As to the issue of a certificate of registration see PARA 388 ante.

12 As to the registrar see PARA 17 ante.

13 As to renewal see PARA 29 ante.

14 Trade Marks (Customs) Regulations 1994, SI 1994/2625, reg 6(1).

15 Ibid reg 6(2), which is expressed to be without prejudice to the operation of reg 5 (see the text to note 10 supra).

## **UPDATE**

### **149-152 Importation; powers of the Commissioners for Her Majesty's Revenue and Customs**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (9) IMPORTATION; POWERS OF THE COMMISSIONERS FOR HER MAJESTY'S REVENUE AND CUSTOMS/152. Power of the Commissioners for Revenue and Customs to disclose information.

## **152. Power of the Commissioners for Revenue and Customs to disclose information.**

Where information relating to infringing goods<sup>1</sup>, material<sup>2</sup> or articles<sup>3</sup> has been obtained or is held by the Commissioners for Her Majesty's Revenue and Customs<sup>4</sup> for the purposes of, or in connection with, the exercise of their functions in relation to imported goods, the Commissioners may authorise the disclosure of that information for the purpose of facilitating the exercise by any person of any function in connection with the investigation or prosecution of an offence relating to the unauthorised use of trade marks etc in relation to goods<sup>5</sup> or under the Trade Descriptions Act 1968<sup>6</sup>. In civil proceedings the Commissioners can be ordered by a court to disclose information relating to the identity of an infringer pursuant to the court's powers to order disclosure from a party who, even if innocently, has become involved in wrongdoing<sup>7</sup>.

1 For the meaning of 'infringing goods' see PARA 150 ante.

2 For the meaning of 'infringing material' see PARA 150 ante.

3 For the meaning of 'infringing articles' see PARA 150 ante.

4 As to the Commissioners for Her Majesty's Revenue and Customs see CUSTOMS AND EXCISE vol 12(3) (2007 Reissue) PARA 900 et seq.

5 ie an offence under the Trade Marks Act 1994 s 92: see PARAS 141-144 ante.

6 Ibid s 91 (amended by the Commissioners for Revenue and Customs Act 2005 s 50(6), Sch 4 para 58). These provisions also apply to protected international trade marks (UK): Trade Marks (International Registration) Order 1996, SI 1996/714, art 16. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante. As to the application of these provisions to Community trade marks see PARA 267 post.

7 See *Norwich Pharmacal Co v Customs and Excise Comrs* [1974] AC 133, [1973] 2 All ER 943, [1974] RPC 101, HL; and PARA 453 post.

## **UPDATE**

### **149-152 Importation; powers of the Commissioners for Her Majesty's Revenue and Customs**

SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (10) THE PARIS CONVENTION AND THE WTO AGREEMENT; SPECIAL PROVISIONS/153. Protection of well known trade marks.

## **(10) THE PARIS CONVENTION AND THE WTO AGREEMENT; SPECIAL PROVISIONS**

### **153. Protection of well known trade marks.**

References in the Trade Marks Act 1994 to a trade mark<sup>1</sup> which is entitled to protection under the Paris Convention<sup>2</sup> or the WTO Agreement<sup>3</sup> as a well known trade mark are to a mark which is well known<sup>4</sup> in the United Kingdom<sup>5</sup> as being the mark of a person who:

- 251 (1) is a national of a Convention country<sup>6</sup>; or
- 252 (2) is domiciled<sup>7</sup> in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business<sup>8</sup>, or has any goodwill<sup>9</sup>, in the United Kingdom; and references to the proprietor of such a mark are to be construed accordingly<sup>10</sup>.

The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO Agreement as a well known trade mark is entitled to restrain by injunction the use<sup>11</sup> in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar<sup>12</sup> to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion<sup>13</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 As to the Paris Convention see PARA 6 ante.

3 As to the WTO Agreement and its relationship to the Paris Convention see PARA 7 ante.

4 A trade mark can only be well known in respect of the goods or services in relation to which it had been used: *PACO/PACO LIFE IN COLOUR Trade Marks*[2000] RPC 451, Trade Marks Registry. In assessing whether a trade mark is well known it is appropriate to apply the criteria set out in the Joint Recommendation Concerning Provision on the Protection of Well Known Marks of the Paris Union and the World Intellectual Property Organisation (1999), art 2: *Le Mans Autoparts Ltd's Trade Mark Application* (O/012/05), Appointed Person.

5 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

6 For the meaning of 'Convention country' see PARA 6 note 2 ante. It has been held that the exclusion of the United Kingdom from the definition of 'Convention country' means that a person who is a national of, or domiciled or established in, the United Kingdom cannot invoke the Trade Marks Act s 56 (*CUTTY SARK Trade Mark* (O/285/01), Trade Marks Registry) but this may require reconsideration (*Imperial Tobacco Ltd v Berry Bros & Rudd Ltd*[2001] All ER (D) 447 (Oct)).

7 As to domicile see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 35 et seq.

8 For the meaning of 'business' see PARA 32 note 3 ante.

9 As to goodwill see PERSONAL PROPERTY vol 35 (Reissue) PARAS 1206-1210.

10 Trade Marks Act 1994 s 56(1) (s 56(1), (2) amended by the Patents and Trade Marks (World Trade Organisation) Regulations 1999, SI 1999/1899, reg 13(4)). This provision implements the International Convention for the Protection of Industrial Property (Paris, 20 March 1883) (the 'Paris Convention'), as revised (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431), art 6 (bis) and the Agreement on

Trade-Related Aspects of Intellectual Property Rights ('TRIPs') (1994) (Cm 2557) art 16(2). As to the Paris Convention see PARA 6 ante; and as to TRIPs see PARA 7 ante.

The Trade Marks Act 1994 s 56 (now amended) overcomes the problem in passing off that certain marks, whilst they had a reputation in the United Kingdom, had no goodwill here because the proprietor had no trade in his goods or service here: see eg *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* [1976] FSR 256, PC; *Alain Bernardin & Cie v Pavilion Properties Ltd* [1967] RPC 581 ('Crazy Horse'). But, while the Trade Marks Act 1994 s 56 (now amended) removes the need for the proprietor to have a trade in the United Kingdom, he still needs to establish a likelihood of confusion to avail himself of the provision: *Philips Electronics BV v Remington Consumer Products Ltd* [1998] RPC 283 at 314 per Jacob J; affd [1999] RPC 809, [1999] All ER (D) 465, CA; referred to ECJ sub nom C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2003] Ch 159, [2002] ECR I-5475, ECJ.

As to the non-implementation of TRIPs art 16(3) see PARA 7 note 13 ante.

11 For the meaning of 'use' see PARA 60 note 8 ante.

12 As to the requirement of similarity see PARA 7 note 11 ante.

13 Trade Marks Act 1994 s 56(2) (as amended: see note 10 supra). The right so conferred is subject to s 48 (effect of acquiescence by the proprietor of an earlier mark: see PARA 99 ante): s 56(2) (as so amended). Nothing in s 56(2) (as amended) affects the continuation of any bona fide use of a trade mark begun before 31 October 1994: s 56(3). See also note 10 supra.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/ (10) THE PARIS CONVENTION AND THE WTO AGREEMENT; SPECIAL PROVISIONS/154. Attempts by agent or representative to register mark of principal; right of principal to injunction.

**154. Attempts by agent or representative to register mark of principal; right of principal to injunction.**

Where an application for registration<sup>1</sup> of a trade mark<sup>2</sup> is made by a person who is an agent or representative<sup>3</sup> of a person who is the proprietor of the mark in a Convention country<sup>4</sup>, the following provisions apply<sup>5</sup>.

If the proprietor opposes the application, registration must be refused<sup>6</sup>. If the application is granted, the proprietor may<sup>7</sup>:

- 253 (1) apply for a declaration of the invalidity of the registration<sup>8</sup>; or
- 254 (2) apply for the rectification of the register<sup>9</sup> so as to substitute his name as the proprietor of the registered trade mark<sup>10</sup>.

The proprietor may, notwithstanding the rights conferred by the Trade Marks Act 1994 in relation to a registered trade mark, by injunction restrain any use<sup>11</sup> of the trade mark in the United Kingdom<sup>12</sup> which is not authorised by him<sup>13</sup>.

The above provisions<sup>14</sup> do not apply if, or to the extent that, the agent or representative justifies his action<sup>15</sup>.

1 As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 'Agent or representative' is to be broadly construed as including licensees, franchisees, distributors and importers: Decision 164C/000548644/1 *Promat Ltd v Pasture BV* (19 December 2002, unreported), OHIM Cancellation Division; Case R 336/2001-2 *Sotorock Holding Ltd v Gordon* (7 July 2003, unreported), OHIM Board of Appeal; Decision 2486/2004 *Sybex Inc v Sybex-Verlag GmbH* (26 July 2004, unreported), OHIM Opposition Division. The agency must relate to the United Kingdom: cf Decision 1131/2003 *NuScience Corp v Basic Fashion Oy* (28 May 2003, unreported), OHIM Opposition Division.

4 For the meaning of 'Convention country' see PARA 6 note 2 ante.

5 Trade Marks Act 1994 s 60(1). Section 60 implements the International Convention for the Protection of Industrial Property (Paris, 20 March 1883) (the 'Paris Convention'), as revised (Stockholm, 14 July 1967 to 13 January 1968; TS 61 (1970); Cmnd 4431), art 6 (septies). As to the Paris Convention see PARA 6 ante.

6 Trade Marks Act 1994 s 60(2). See also note 5 supra.

7 Ibid s 60(3). See also note 5 supra.

8 Ibid s 60(3)(a). As to the grounds for a declaration of invalidity of registration see PARA 118 et seq ante. See also note 5 supra.

9 As to the register see PARA 19 ante.

10 Trade Marks Act 1994 s 60(3)(b). See also note 5 supra. An application under s 60(3)(a) or (b) (see heads (1), (2) in the text) must be made within three years of the proprietor becoming aware of the registration: s 60(6). As to the meaning of 'registered trade mark' see PARA 127 ante.

11 For the meaning of 'use' see PARA 60 note 8 ante.

12 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

13 Trade Marks Act 1994 s 60(4). See also note 5 supra. It would seem that the right so conferred is dependent upon the agent's having applied to register the trade mark himself.

No injunction may be so granted in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more: s 60(6).

14 *Ibid* s 60(2)-(4): see the text to notes 6-13 supra.

15 *Ibid* s 60(5). It is presumed that consent by the proprietor would constitute justification: cf EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 8(3); and PARA 223 post. The fact that the proprietor is unwilling to incur the expense of registering a trade mark does not justify an agent in registering it in his own name: Case R 336/2001-2 *Sotorock Holding Ltd v Gordon* (7 July 2003, unreported), OHIM Board of Appeal.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/(i) In general/155. Nature of collective marks.

## **(11) COLLECTIVE MARKS**

### **(i) In general**

#### **155. Nature of collective marks.**

A collective mark is a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings<sup>1</sup>.

Subject to certain modifications<sup>2</sup>, the provisions of the Trade Marks Act 1994 apply to collective marks<sup>3</sup>.

1 Trade Marks Act 1994 s 49(1). A collective mark is a form of registered mark introduced by the Trade Marks Act 1994. It is essentially for trade associations, giving an indication that the goods or services are those of recognised members of the association which is proprietor. Collective marks are permitted by EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 10.

In relation to a collective mark, the reference in the Trade Marks Act 1994 s 1(1) (signs of which a trade mark may consist: see PARA 57 ante) to distinguishing goods or services of one undertaking from those of other undertakings is to be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings: s 49(2), Sch 1 para 2.

2 Ie subject to the provisions of ibid Sch 1: see note 1 supra; and PARA 156 et seq post.

3 Ibid Sch 1 para 1.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/(i) In general/156. Indication of geographical origin.

#### **156. Indication of geographical origin.**

A collective mark<sup>1</sup> may be registered<sup>2</sup> which consists of signs or indications which may serve, in trade<sup>3</sup>, to designate the geographical origin of the goods or services<sup>4</sup>. The proprietor of such a mark is, however, not entitled to prohibit the use<sup>5</sup> of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name)<sup>6</sup>.

1 For the meaning of 'collective mark' see PARA 155 ante.

2 Ie notwithstanding the Trade Marks Act 1994 s 3(1)(c) (prohibition on registration of marks consisting of an indication of geographical origin): see PARA 60 head (2) ante.

3 As to the meaning of 'trade' see PARA 60 note 4 ante.

4 Trade Marks Act 1994 s 49(2), Sch 1 para 3(1).

5 For the meaning of 'use' see PARA 60 note 8 ante.

6 Trade Marks Act 1994 Sch 1 para 3(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/(i) In general/157. Mark not to be misleading as to character or significance.

**157. Mark not to be misleading as to character or significance.**

A collective mark<sup>1</sup> may not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark<sup>2</sup>. The registrar<sup>3</sup> may accordingly require that a mark in respect of which application is made for registration<sup>4</sup> should include some indication that it is a collective mark<sup>5</sup>. An application may be amended<sup>6</sup> so as to comply with any such requirement<sup>7</sup>.

1 For the meaning of 'collective mark' see PARA 155 ante.

2 Trade Marks Act 1994 s 49(2), Sch 1 para 4(1).

3 As to the registrar see PARA 17 ante.

4 As to procedure on the application see PARA 352 et seq post.

5 Trade Marks Act 1994 Sch 1 para 4(2).

6 Ie notwithstanding ibid s 39(2): see PARA 375 post.

7 Ibid Sch 1 para 4(2).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/(ii) Regulations/158. Regulations governing use of collective mark.

## **(ii) Regulations**

### **158. Regulations governing use of collective mark.**

An applicant for registration of a collective mark<sup>1</sup> must file with the registrar<sup>2</sup> regulations governing the use<sup>3</sup> of the mark<sup>4</sup>. The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse<sup>5</sup>. Further requirements with which the regulations have to comply may be imposed by rules<sup>6</sup>.

1 For the meaning of 'collective mark' see PARA 155 ante.

2 As to the registrar see PARA 17 ante.

3 For the meaning of 'use' see PARA 60 note 8 ante.

4 Trade Marks Act 1994 s 49(2), Sch 1 para 5(1). As to approval of the regulations see PARA 159 post.

5 Ibid Sch 1 para 5(2).

6 Ibid Sch 1 para 5(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/(ii) Regulations/159. Approval of regulations.

### 159. Approval of regulations.

A collective mark<sup>1</sup> may not be registered unless the regulations governing the use of the mark<sup>2</sup> comply with the statutory requirements<sup>3</sup> and any further requirements imposed by rules<sup>4</sup> and are not contrary to public policy or to accepted principles of morality<sup>5</sup>.

Within nine months of the date of the application for registration of a collective mark, the applicant must file the appropriate form<sup>6</sup> with the registrar<sup>7</sup> accompanied by a copy of the regulations governing the use of the mark and pay the prescribed fee<sup>8</sup>. If he does not do so, the application is deemed to be withdrawn<sup>9</sup>.

The registrar must consider whether the above requirements<sup>10</sup> are met<sup>11</sup>. If it appears to the registrar that those requirements are not met, he must inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations<sup>12</sup>. If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or to respond before the end of the specified period, the registrar must refuse the application<sup>13</sup>. If, however, it appears to the registrar that those requirements, and the other requirements for registration, are met, he must accept the application and must proceed<sup>14</sup> accordingly<sup>15</sup>.

1 For the meaning of 'collective mark' see PARA 155 ante.

2 As to the regulations see PARA 158 ante.

3 Ie the Trade Marks Act 1994 s 49(2), Sch 1 para 5(2): see PARA 158 ante.

4 Ie rules made pursuant to ibid Sch 1 para 5(2): see PARA 158 ante.

5 Ibid Sch 1 para 6(1). As to marks contrary to public policy or accepted principles of morality see PARA 63 ante.

6 The appropriate form is Form TM35: Trade Marks Rules 2000, SI 2000/136, r 22. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 post.

7 As to the registrar see PARA 17 ante.

8 Trade Marks Act 1994 Sch 1 para 6(2); Trade Marks Rules 2000, SI 2000/136, r 22. The prescribed fee is currently £200: Trade Marks (Fees) Rules 2000, SI 2000/137, r 3, Schedule. As to the use of forms see PARA 353 post; and as to fees see PARA 16 ante.

9 Trade Marks Act 1994 Sch 1 para 6(2).

10 Ie the requirements mentioned in ibid Sch 1 para 6(1): see the text and notes 1-5 supra.

11 Ibid Sch 1 para 7(1).

12 Ibid Sch 1 para 7(2). As to appeals from decisions of the registrar, including acts of the registrar in exercise of a discretion, see ss 76, 77 (both as amended); and PARA 405 et seq post.

13 Ibid Sch 1 para 7(3).

14 Ie in accordance with ibid s 38: see PARAS 383-387 post.

15 Ibid Sch 1 para 7(4).

## **UPDATE**

### **159 Approval of regulations**

NOTES 6, 8--SI 2000/136 revoked: see now the Trade Marks Rules 2008, SI 2008/1797, r 29.

NOTE 8--SI 2000/137 replaced: Trade Marks (Fees) Rules 2008, SI 2008/1958 (amended by SI 2009/2089).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/(ii) Regulations/160. Publication and inspection of regulations.

**160. Publication and inspection of regulations.**

The regulations<sup>1</sup> must be published<sup>2</sup> and notice of opposition may be given, and observations may be made, relating to the specified<sup>3</sup> matters<sup>4</sup>. This is in addition to any other grounds on which the application may be opposed or observations made<sup>5</sup>.

The regulations governing the use of a registered collective mark<sup>6</sup> must be open to public inspection in the same way as the register<sup>7</sup>.

1 As to the regulations see PARA 158 ante.

2 For the meaning of 'publish' see PARA 17 note 10 ante.

3 I.e. the matters specified in the Trade Marks Act 1994 s 49(2), Sch 1 para 6(1): see PARA 159 ante.

4 Ibid Sch 1 para 8.

5 Ibid Sch 1 para 8.

6 For the meaning of 'collective mark' see PARA 155 ante.

7 Trade Marks Act 1994 Sch 1 para 9. As to the register being open to public inspection see s 63(3)(a); and PARA 24 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/(ii) Regulations/161. Amendment of regulations.

### **161. Amendment of regulations.**

An amendment of the regulations<sup>1</sup> governing the use of a registered collective mark<sup>2</sup> is not effective unless and until the amended regulations are filed<sup>3</sup> with the registrar<sup>4</sup> on the appropriate form<sup>5</sup> and accepted by him<sup>6</sup>.

Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published<sup>7</sup>; and he must publish a notice indicating where copies of the amended regulations may be inspected<sup>8</sup>. If the registrar does so, any person may, within three months of the date of publication of the notice:

- 255 (1) make observations to the registrar on the amendments relating to the specified matters<sup>9</sup> and the registrar must send<sup>10</sup> a copy thereof to the proprietor<sup>11</sup>;
- 256 (2) give notice to the registrar of opposition to the amendment on the appropriate form<sup>12</sup> which must include a statement of the grounds of opposition indicating why the amended regulations do not comply with the specified<sup>13</sup> requirements<sup>14</sup>.

The registrar must send a copy of the appropriate form<sup>15</sup> to the proprietor; and thereafter the statutory provisions relating to opposition proceedings<sup>16</sup> apply to the proceedings as they apply to proceedings relating to opposition to an application for registration with certain modifications<sup>17</sup>.

1 As to the regulations see PARA 158 ante.

2 For the meaning of 'collective mark' see PARA 155 ante.

3 For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 post.

4 As to the registrar see PARA 17 ante.

5 The appropriate form is Form TM36: Trade Marks Rules 2000, SI 2000/136, r 23(1). As to the use of forms see PARA 353 post.

6 Trade Marks Act 1994 s 49(2), Sch 1 para 10(1); Trade Marks Rules 2000, SI 2000/136, r 23(1).

7 For the meaning of 'publish' see PARA 17 note 10 ante.

8 Trade Marks Act 1994 Sch 1 para 10(2); Trade Marks Rules 2000, SI 2000/136, r 23(2).

9 I.e. the matters referred to in the Trade Marks Act 1994 Sch 1 para 6(1): see PARA 159 ante.

10 For the meaning of 'send' see PARA 25 note 14 ante.

11 Trade Marks Act 1994 Sch 1 para 10(3); Trade Marks Rules 2000, SI 2000/136, r 23(3) (amended by SI 2006/3039). For the meaning of 'proprietor' see PARA 22 note 8 ante.

12 The appropriate form is Form TM7: Trade Marks Rules 2000, SI 2000/136, r 23(4) (substituted by SI 2004/947; and amended by SI 2006/3039).

13 I.e. the requirements specified in the Trade Marks Act 1994 Sch 1 para 6(1): see PARA 159 ante.

14 Ibid Sch 1 para 10(3); Trade Marks Rules 2000, SI 2000/136, r 23(4) (as substituted and amended: see note 12 supra).

15 The appropriate form is Form TM7: *ibid* r 23(5) (substituted by SI 2004/947).

16 *Ile* the Trade Marks Rules 2000, SI 2000/136, rr 13A-14 (rr 13A-13C as added; r 14 as amended): see *PARAS* 384-385 post.

17 *Ibid* r 23(5) (as substituted: see note 15 supra).

## **UPDATE**

### **161 Amendment of regulations**

TEXT AND NOTES--SI 2000/136 rr 13A-14, 23 now Trade Marks Rules 2008, SI 2008/1797, rr 18-20, 30.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/ (iii) Infringement, Revocation and Invalidity/162. Infringement; rights of authorised users.

### **(iii) Infringement, Revocation and Invalidity**

#### **162. Infringement; rights of authorised users.**

The statutory provisions relating to:

- 257 (1) the unauthorised application of a mark to certain material<sup>1</sup>;
- 258 (2) the adequacy of other remedies in relation to orders as to the disposal of infringing goods, material or articles<sup>2</sup>; and
- 259 (3) the making of a request to the Commissioners for Her Majesty's Revenue and Customs in relation to the prohibition of the importation of infringing goods, material or articles<sup>3</sup>,

apply in relation to an authorised user of a registered collective mark<sup>4</sup> as in relation to a licensee<sup>5</sup> of a trade mark<sup>6</sup>.

The following provisions<sup>7</sup> have effect as regards the rights of an authorised user in relation to infringement<sup>8</sup> of a registered collective mark<sup>9</sup>.

An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings<sup>10</sup> in respect of any matter which affects his interests<sup>11</sup>. If the proprietor refuses to do so or fails to do so within two months after being called upon, the authorised user may bring the proceedings in his own name as if he were the proprietor<sup>12</sup>. Where infringement proceedings are so brought, the authorised user may not, without the leave of the court<sup>13</sup>, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant; but this does not affect the granting of interim relief on an application by an authorised user alone<sup>14</sup>. A proprietor who is so added as a defendant may not be made liable for any costs in the action unless he takes part in the proceedings<sup>15</sup>.

In infringement proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by authorised users is to be taken into account; and the court may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of such users<sup>16</sup>.

1    Ie the Trade Marks Act 1994 s 10(5): see PARA 90 ante.

2    Ie ibid s 19(2): see PARA 463 post.

3    Ie ibid s 89 (as amended): see PARA 149 ante. As to the Commissioners for Her Majesty's Revenue and Customs see CUSTOMS AND EXCISE vol 12(3) (2007 Reissue) PARA 900 et seq.

4    For the meaning of 'collective mark' see PARA 155 ante.

5    As to the licensing of a registered trade mark see PARAS 136-137 ante.

6    Trade Marks Act 1994 s 49(2), Sch 1 para 11 (amended by virtue of the Commissioners for Revenue and Customs Act 2005 s 50(1), (7)).

7     le the provisions of the Trade Marks Act 1994 Sch 1 para 12(2)-(6) (see the text and notes 10-16 *infra*), which correspond to the provisions of s 30 (general provisions as to the rights of licensees in case of infringement: see PARA 418 *post*).

8     For the meaning of 'infringement' see PARA 84 note 4 *ante*. As to the acts which amount to infringement, if done without the consent of the proprietor, see *ibid* s 10; and PARA 86 *et seq ante*.

9     *Ibid* Sch 1 para 12(1).

10    For the meaning of 'infringement proceedings' see PARA 85 note 4 *ante*.

11    Trade Marks Act 1994 Sch 1 para 12(2).

12    *Ibid* Sch 1 para 12(3).

13    For the meaning of 'the court' see PARA 349 *post*.

14    Trade Marks Act 1994 Sch 1 para 12(4).

15    *Ibid* Sch 1 para 12(5).

16    *Ibid* Sch 1 para 12(6).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/ (iii) Infringement, Revocation and Invalidity/163. Grounds for revocation of registration.

### **163. Grounds for revocation of registration.**

Apart from the usual statutory grounds of revocation<sup>1</sup>, the registration of a collective mark<sup>2</sup> may be revoked on the ground<sup>3</sup>:

- 260 (1) that the manner in which the mark has been used<sup>4</sup> by the proprietor has caused it to become liable to mislead the public as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark<sup>5</sup>; or
- 261 (2) that the proprietor has failed to observe, or to secure the observance of, the regulations<sup>6</sup> governing the use of the mark<sup>7</sup>; or
- 262 (3) that an amendment of the regulations has been made so that the regulations no longer comply with the statutory requirements<sup>8</sup> and any further conditions imposed by rules<sup>9</sup> or are contrary to public policy or to accepted principles of morality<sup>10</sup>.

1    le the grounds provided for in the Trade Marks Act 1994 s 46: see PARA 114 et seq ante.

2    For the meaning of 'collective mark' see PARA 155 ante.

3    Trade Marks Act 1994 s 49(2), Sch 1 para 13.

4    For the meaning of 'use' see PARA 60 note 8 ante.

5    Trade Marks Act 1994 Sch 1 para 13(a), which refers to Sch 1 para 4(1) (see PARA 157 ante).

6    As to the regulations see PARA 158 ante.

7    Trade Marks Act 1994 Sch 1 para 13(b).

8    le ibid Sch 1 para 5(2): see PARA 158 ante.

9    le rules made under ibid Sch 1 para 5(2): see PARA 158 ante.

10   Ibid Sch 1 para 13(c).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(11) COLLECTIVE MARKS/ (iii) Infringement, Revocation and Invalidity/164. Grounds for invalidity of registration.

#### **164. Grounds for invalidity of registration.**

Apart from the usual statutory grounds of invalidity<sup>1</sup>, the registration of a collective mark<sup>2</sup> may be declared invalid on the ground that the mark was registered in breach of any of the statutory provisions relating to the prohibition on a mark being misleading as to character or significance<sup>3</sup> or the conditions subject to which a collective mark may be registered<sup>4</sup>.

1     Ie the grounds provided for in the Trade Marks Act 1994 s 47: see PARA 118 et seq ante.

2     For the meaning of 'collective mark' see PARA 155 ante.

3     Ie the Trade Marks Act 1994 s 49(2), Sch 1 para 4(1): see PARA 157 ante.

4     Ibid Sch 1 para 14. As to the conditions subject to which a collective mark may be registered see Sch 1 para 6(1); and PARA 159 ante.

In all legal proceedings relating to a registered trade mark, the registration of a person as proprietor of a trade mark is prima facie evidence of the validity of the original registration: see s 72; and PARA 110 ante. As to the meaning of 'registered trade mark' see PARA 127 ante. As to certificates of validity see PARA 447 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(i) In general/165. Nature of certification marks.

## **(12) CERTIFICATION MARKS**

### **(i) In general**

#### **165. Nature of certification marks.**

A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of the origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics<sup>1</sup>.

Subject to certain modifications<sup>2</sup>, the provisions of the Trade Marks Act 1994 apply to certification marks<sup>3</sup>.

The assignment or other transmission of a registered certification mark is not effective without the consent of the registrar<sup>4</sup>.

1 Trade Marks Act 1994 s 50(1). In general, certification marks are permitted by EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 10. Nevertheless it is arguable that the Trade Marks Act 1994 s 50 should not be interpreted as permitting the registration as certification marks of geographical designations or indications which are capable of being registered as protected designations of origin or protected geographical origins (as to which see PARA 302 post): see *Joined Cases C-129/97 and C-130/97 Re Chiciak and Fol* [1998] ECR I-3315, [1998] All ER (D) 253, ECJ; Case C-6/02 *European Commission v France* [2003] ECR I-2389, [2003] All ER (D) 69 (Mar), ECJ. The definition in the Trade Marks Act 1994 s 50(1) corresponds to the definition in the Trade Marks Act 1938 s 37(1) (repealed). There was little litigation relating to certification marks under the Trade Marks Act 1938: see eg *Stilton Trade Mark* [1967] RPC 173 (certification by the Stilton Cheese Makers' Association that cheese came from a particular area and was made according to a particular recipe could be the subject of a registration); *Sea Island Cotton Certification Trade Marks* [1989] RPC 87 (which decided, as a matter of discretion, that a certification mark should not be expunged for minor breaches of the regulations).

Certification marks are normally registered by trade associations and the like (the British Standards Institution 'Kitemark' being a typical example), not to indicate membership of the association (for which collective marks cater: see PARA 155 et seq ante), but as a mark of quality.

In relation to a certification mark, the reference in the Trade Marks Act 1994 s 1(1) (signs of which a trade mark may consist: see PARA 57 ante) to distinguishing goods or services of one undertaking from those of other undertakings is to be construed as a reference to distinguishing goods or services which are certified from those which are not: s 50(2), Sch 2 para 2. A certification mark may acquire a distinctive character through use: *Legal Aid Board v Comptroller General of Patents* [2000] All ER (D) 1246.

2 In subject to the provisions of the Trade Marks Act 1994 Sch 2: see note 1 supra; and PARA 166 et seq post.

3 Ibid Sch 2 para 1.

4 Ibid Sch 2 para 12. As to assignment and transmission see PARA 129 et seq ante; and as to the registrar see PARA 17 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(i) In general/166. Indication of geographical origin.

### **166. Indication of geographical origin.**

A certification mark<sup>1</sup> may be registered<sup>2</sup> which consists of signs or indications which may serve, in trade<sup>3</sup>, to designate the geographical origin of the goods or services<sup>4</sup>. The proprietor of such a mark is, however, not entitled to prohibit the use<sup>5</sup> of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name<sup>6</sup>.

1 For the meaning of 'certification mark' see PARA 165 ante.

2 Ie notwithstanding the Trade Marks Act 1994 s 3(1)(c) (prohibition on registration of marks consisting of an indication of geographical origin): see PARA 60 head (2) ante.

3 As to the meaning of 'trade' see PARA 60 note 4 ante.

4 Trade Marks Act 1994 s 50(2), Sch 2 para 3(1).

5 For the meaning of 'use' see PARA 60 note 8 ante.

6 Trade Marks Act 1994 Sch 2 para 3(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(i) In general/167. Nature of proprietor's business.

**167. Nature of proprietor's business.**

A certification mark<sup>1</sup> may not be registered if the proprietor carries on a business<sup>2</sup> involving the supply of goods or services of the kind certified<sup>3</sup>.

1 For the meaning of 'certification mark' see PARA 165 ante.

2 For the meaning of 'business' see PARA 32 note 3 ante.

3 Trade Marks Act 1994 s 50(2), Sch 2 para 4.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(i) In general/168. Mark not to be misleading as to character or significance.

**168. Mark not to be misleading as to character or significance.**

A certification mark<sup>1</sup> may not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark<sup>2</sup>. The registrar<sup>3</sup> may accordingly require that a mark in respect of which application is made for registration<sup>4</sup> should include some indication that it is a certification mark<sup>5</sup>. An application may be amended<sup>6</sup> so as to comply with any such requirement<sup>7</sup>.

1 For the meaning of 'certification mark' see PARA 165 ante.

2 Trade Marks Act 1994 s 50(2), Sch 2 para 5(1).

3 As to the registrar see PARA 17 ante.

4 As to the procedure on the application see PARA 352 et seq post.

5 Trade Marks Act 1994 Sch 2 para 5(2).

6 Ie notwithstanding ibid s 39(2): see PARA 375 post.

7 Ibid Sch 2 para 5(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(ii) Regulations/169. Regulations governing use of certification mark.

## (ii) Regulations

### 169. Regulations governing use of certification mark.

An applicant for registration of a certification mark<sup>1</sup> must file with the registrar<sup>2</sup> regulations governing the use<sup>3</sup> of the mark<sup>4</sup>. The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees, if any, to be paid in connection with the operation of the mark and the procedures for resolving disputes<sup>5</sup>. Further requirements with which the regulations have to comply may be imposed by rules<sup>6</sup>.

1 For the meaning of 'certification mark' see PARA 165 ante.

2 As to the registrar see PARA 17 ante.

3 For the meaning of 'use' see PARA 60 note 8 ante.

4 Trade Marks Act 1994 s 50(2), Sch 2 para 6(1). As to approval of the regulations see PARA 170 post.

Regulations governing the use of an existing registered certification mark deposited at the Patent Office in pursuance of the Trade Marks Act 1938 s 37 (repealed) are to be treated on and after 31 October 1994 as if filed under the Trade Marks Act 1994 Sch 2 para 6: s 105, Sch 3 para 19(1). Any request for amendment of the regulations which was pending on 31 October 1994 must be dealt with under the old law: Sch 3 para 19(2). For the meaning of 'the old law' see PARA 4 note 3 ante. As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

5 Trade Marks Act 1994 Sch 2 para 6(2). See also note 4 supra.

6 Ibid Sch 2 para 6(2). See also note 4 supra.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(ii) Regulations/170. Approval of regulations etc.

### **170. Approval of regulations etc.**

A certification mark<sup>1</sup> may not be registered unless:

- 263 (1) the regulations governing the use of the mark<sup>2</sup> comply with the statutory requirements<sup>3</sup> and any further requirements imposed by rules<sup>4</sup> and are not contrary to public policy or to accepted principles of morality<sup>5</sup>; and
- 264 (2) the applicant is competent to certify the goods or services for which the mark is to be registered<sup>6</sup>.

Within nine months of the date of the application for registration of a certification mark, the applicant must file the appropriate form<sup>7</sup> with the registrar<sup>8</sup> accompanied by a copy of the regulations governing the use of the mark and pay the prescribed fee<sup>9</sup>. If he does not do so, the application is deemed to be withdrawn<sup>10</sup>.

The registrar must consider whether the requirements of heads (1) and (2) above<sup>11</sup> are met<sup>12</sup>. If it appears to the registrar that those requirements are not met, he must inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to file amended regulations<sup>13</sup>. If the applicant fails to satisfy the registrar that those requirements are met, or to file regulations amended so as to meet them, or to respond before the end of the specified period, the registrar must refuse the application<sup>14</sup>. If, however, it appears to the registrar that those requirements, and the other requirements for registration, are met, he must accept the application and must proceed<sup>15</sup> accordingly<sup>16</sup>.

1 For the meaning of 'certification mark' see PARA 165 ante.

2 As to the regulations see PARA 169 ante.

3 I.e. the Trade Marks Act 1994 s 50(2), Sch 2 para 6(2): see PARA 169 ante.

4 I.e. rules made pursuant to ibid Sch 2 para 6(2): see PARA 169 ante.

5 Ibid Sch 2 para 7(1)(a). As to marks contrary to public policy or accepted principles of morality see PARA 63 ante.

6 Ibid Sch 2 para 7(1)(b).

7 The appropriate form is Form TM35: Trade Marks Rules 2000, SI 2000/136, r 22. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 post.

8 As to the registrar see PARA 17 ante.

9 Trade Marks Act 1994 Sch 2 para 7(2); Trade Marks Rules 2000, SI 2000/136, r 22. The prescribed fee is currently £200: Trade Marks (Fees) Rules 2000, SI 2000/137, r 3, Schedule. As to the use of forms see PARA 353 post; and as to fees see PARA 16 ante.

10 Trade Marks Act 1994 Sch 2 para 7(2).

11 I.e. the requirements mentioned in ibid Sch 2 para 7(1): see the text and notes 1-6 supra.

12 Ibid Sch 2 para 8(1). As to appeals from decisions of the registrar, including acts of the registrar in exercise of a discretion, see ss 76, 77 (both as amended); and PARA 405 et seq post.



- 13 Ibid Sch 2 para 8(2).
- 14 Ibid Sch 2 para 8(3).
- 15 le in accordance with ibid s 38: see PARAS 383-387 post.
- 16 Ibid Sch 2 para 8(4).

## **UPDATE**

### **170 Approval of regulations etc**

NOTES 7, 9--SI 2000/136 r 22 now Trade Marks Rules 2008, SI 2008/1797, r 29.

NOTE 9--SI 2000/137 replaced: Trade Marks (Fees) Rules 2008, SI 2008/1958 (amended by SI 2009/2089).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(ii) Regulations/171. Publication and inspection of regulations.

**171. Publication and inspection of regulations.**

The regulations<sup>1</sup> must be published<sup>2</sup> and notice of opposition may be given, and observations may be made, relating to the specified<sup>3</sup> matters<sup>4</sup>. This is in addition to any other grounds on which the application may be opposed or observations made<sup>5</sup>.

The regulations governing the use of a registered certification mark<sup>6</sup> must be open to public inspection in the same way as the register<sup>7</sup>.

1 As to the regulations see PARA 169 ante.

2 For the meaning of 'publish' see PARA 17 note 10 ante.

3 I.e. the matters specified in the Trade Marks Act 1994 s 50(2), Sch 2 para 7(1); see PARA 170 ante.

4 Ibid Sch 2 para 9.

5 Ibid Sch 2 para 9.

6 For the meaning of 'certification mark' see PARA 165 ante.

7 Trade Marks Act 1994 Sch 2 para 10. As to the register being open to public inspection see s 63(3)(a); and PARA 24 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/(ii) Regulations/172. Amendment of regulations.

## **172. Amendment of regulations.**

An amendment of the regulations<sup>1</sup> governing the use of a registered certification mark<sup>2</sup> is not effective unless and until the amended regulations are filed<sup>3</sup> with the registrar<sup>4</sup> on the appropriate form<sup>5</sup> and accepted by him<sup>6</sup>.

Before accepting any amended regulations the registrar may in any case where it appears to him expedient to do so cause them to be published<sup>7</sup>; and he must publish a notice indicating where copies of the amended regulations may be inspected<sup>8</sup>. If the registrar does so, any person may, within three months of the date of publication of the notice:

- 265 (1) make observations to the registrar on the amendments relating to the specified matters<sup>9</sup> and the registrar must send<sup>10</sup> a copy thereof to the proprietor<sup>11</sup>;
- 266 (2) give notice to the registrar of opposition to the amendment on the appropriate form<sup>12</sup> which must include a statement of the grounds of opposition indicating why the amended regulations do not comply with the specified<sup>13</sup> requirements<sup>14</sup>.

The registrar must send a copy of the appropriate form<sup>15</sup> to the proprietor; and thereafter the statutory provisions relating to opposition proceedings<sup>16</sup> apply to the proceedings as they apply to proceedings relating to opposition to an application for registration with certain modifications<sup>17</sup>.

1 As to the regulations see PARA 169 ante.

2 For the meaning of 'certification mark' see PARA 165 ante.

3 For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 post.

4 As to the registrar see PARA 17 ante.

5 The appropriate form is Form TM36: Trade Marks Rules 2000, SI 2000/136, r 23(1). As to the use of forms see PARA 353 post.

6 Trade Marks Act 1994 s 50(2), Sch 2 para 11(1); Trade Marks Rules 2000, SI 2000/136, r 23(1). See also PARA 169 note 4 ante.

7 For the meaning of 'publish' see PARA 17 note 10 ante.

8 Trade Marks Act 1994 Sch 2 para 11(2); Trade Marks Rules 2000, SI 2000/136, r 23(2).

9 I.e. the matters referred to in the Trade Marks Act 1994 Sch 2 para 7(1): see PARA 170 ante.

10 For the meaning of 'send' see PARA 25 note 14 ante.

11 Trade Marks Act 1994 Sch 2 para 11(3); Trade Marks Rules 2000, SI 2000/136, r 23(3) (amended by SI 2006/3039). For the meaning of 'proprietor' see PARA 22 note 8 ante.

12 The appropriate form is Form TM7: Trade Marks Rules 2000, SI 2000/136, r 23(4) (substituted by SI 2004/947; and amended by SI 2006/3039).

13 I.e. the requirements specified in the Trade Marks Act 1994 Sch 2 para 7(1): see PARA 170 ante.

14 Ibid Sch 2 para 11(3); Trade Marks Rules 2000, SI 2000/136, r 23(4) (as substituted and amended: see note 12 supra).

15 The appropriate form is Form TM7: ibid r 23(5) (substituted by SI 2004/947).

16 In the Trade Marks Rules 2000, SI 2000/136, rr 13A-14 (rr 13A-13C as added; r 14 as amended): see PARAS 384-385 post.

17 Ibid r 23(5) (as substituted: see note 15 supra).

## **UPDATE**

### **172 Amendment of regulations**

TEXT AND NOTES--SI 2000/136 rr 13A-14, 23 now Trade Marks Rules 2008, SI 2008/1797, rr 18-20, 30.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/ (iii) Infringement, Revocation and Invalidity/173. Infringement; rights of authorised users.

### **(iii) Infringement, Revocation and Invalidity**

#### **173. Infringement; rights of authorised users.**

The statutory provisions relating to:

- 267 (1) the unauthorised application of a mark to certain material<sup>1</sup>;
- 268 (2) the adequacy of other remedies in relation to orders as to the disposal of infringing goods, material or articles<sup>2</sup>; and
- 269 (3) the making of a request to the Commissioners for Her Majesty's Revenue and Customs in relation to the prohibition of the importation of infringing goods, material or articles<sup>3</sup>,

apply in relation to an authorised user of a registered certification mark<sup>4</sup> as in relation to a licensee<sup>5</sup> of a trade mark<sup>6</sup>.

In infringement proceedings<sup>7</sup> brought by the proprietor of a registered certification mark any loss suffered or likely to be suffered by authorised users must be taken into account; and the court<sup>8</sup> may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of such users<sup>9</sup>.

1 le the Trade Marks Act 1994 s 10(5): see PARA 90 ante.

2 le ibid s 19(2): see PARA 463 post.

3 le ibid s 89 (as amended): see PARA 149 ante. As to the Commissioners for Her Majesty's Revenue and Customs see CUSTOMS AND EXCISE vol 12(3) (2007 Reissue) PARA 900 et seq.

4 For the meaning of 'certification mark' see PARA 165 ante.

5 As to the licensing of a registered trade mark see PARAS 136-137 ante.

6 Trade Marks Act 1994 s 50(2), Sch 2 para 13. For the meaning of 'trade mark' see PARA 57 ante.

7 For the meaning of 'infringement proceedings' see PARA 85 note 4 ante.

8 For the meaning of 'the court' see PARA 349 post.

9 Trade Marks Act 1994 Sch 2 para 14. This applies only in relation to infringements committed on or after 31 October 1994: s 105, Sch 3 para 6(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/ (iii) Infringement, Revocation and Invalidity/174. Grounds for revocation of registration.

#### **174. Grounds for revocation of registration.**

Apart from the usual statutory grounds of revocation<sup>1</sup>, the registration of a certification mark<sup>2</sup> may be revoked on the ground<sup>3</sup>:

- 270 (1) that the proprietor has begun to carry on a business<sup>4</sup> involving the supply of goods or services of the kind certified<sup>5</sup>;
- 271 (2) that the manner in which the mark has been used<sup>6</sup> by the proprietor has caused it to become liable to mislead the public as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark<sup>7</sup>;
- 272 (3) that the proprietor has failed to observe, or to secure the observance of, the regulations<sup>8</sup> governing the use of the mark<sup>9</sup>;
- 273 (4) that an amendment of the regulations has been made so that the regulations no longer comply with the statutory requirements<sup>10</sup> and any further conditions imposed by rules<sup>11</sup> or are contrary to public policy or to accepted principles of morality<sup>12</sup>; or
- 274 (5) that the proprietor is no longer competent to certify the goods or services for which the mark is registered<sup>13</sup>.

1    Ie the grounds provided for in the Trade Marks Act 1994 s 46: see PARA 114 et seq ante.

2    For the meaning of 'certification mark' see PARA 165 ante.

3    Trade Marks Act 1994 s 50(2), Sch 2 para 15.

4    For the meaning of 'business' see PARA 32 note 3 ante.

5    Trade Marks Act 1994 Sch 2 para 15(a), which refers to such a business as is mentioned in Sch 2 para 4: see PARA 167 ante.

6    For the meaning of 'use' see PARA 60 note 8 ante.

7    Trade Marks Act 1994 Sch 2 para 15(b). As to the manner referred to see Sch 2 para 5(1); and PARA 168 ante.

8    Ie *ibid* Sch 2 para 6(2): see PARA 169 ante.

9    *Ibid* Sch 2 para 15(c).

10   Ie *ibid* Sch 2 para 6(2): see PARA 169 ante.

11   Ie rules made pursuant to *ibid* Sch 2 para 6(2): see PARA 169 ante.

12   *Ibid* Sch 2 para 15(d).

13   *Ibid* Sch 2 para 15(e).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/2. REGISTERED TRADE MARKS IN THE UNITED KINGDOM/(12) CERTIFICATION MARKS/ (iii) Infringement, Revocation and Invalidity/175. Grounds for invalidity of registration.

### **175. Grounds for invalidity of registration.**

Apart from the usual statutory grounds of invalidity<sup>1</sup>, the registration of a certification mark<sup>2</sup> may be declared invalid on the ground that the mark was registered in breach of any of the statutory provisions relating to the nature of a proprietor's business<sup>3</sup>, the prohibition on a mark being misleading as to character or significance<sup>4</sup> or the conditions<sup>5</sup> subject to which a certification mark may be registered<sup>6</sup>.

1    Ie the grounds provided for in the Trade Marks Act 1994 s 47: see PARA 118 et seq ante.

2    For the meaning of 'certification mark' see PARA 165 ante.

3    Ie the Trade Marks Act 1994 s 50(2), Sch 2 para 4: see PARA 167 ante.

4    Ie ibid Sch 2 para 5(1): see PARA 168 ante.

5    Ie ibid Sch 2 para 7(1): see PARA 170 ante.

6    Ibid Sch 2 para 16. In all legal proceedings relating to a registered trade mark, the registration of a person as proprietor of a trade mark is prima facie evidence of the validity of the original registration: see s 72; and PARA 110 ante. As to the meaning of 'registered trade mark' see PARA 127 ante. As to certificates of validity see PARA 447 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(1) INTRODUCTION/176. The Community Trade Mark Regulation.

### **3. COMMUNITY TRADE MARKS**

#### **(1) INTRODUCTION**

##### **176. The Community Trade Mark Regulation.**

A system of registration of trade marks covering the whole of the European Union is provided for by the Community Trade Mark Regulation<sup>1</sup>. The Regulation provides for registration of a 'Community trade mark'<sup>2</sup> registered in accordance with the conditions contained in, and in the manner provided by, that Regulation<sup>3</sup>.

A Community trade mark so registered has effect throughout the Community<sup>4</sup>. It is infringed by the performance of prohibited acts<sup>5</sup> anywhere in the Community<sup>6</sup>. Accordingly, a person wishing to protect a trade mark throughout the Community may register that mark in accordance with the Regulation: this can be an alternative to, or in addition to<sup>7</sup>, registration in each of the member states<sup>8</sup>.

The substantive law of Community trade marks<sup>9</sup>, as provided for by the Regulation, closely mirrors the provisions of the Trade Marks Directive<sup>10</sup>, and decisions as to the interpretation of identical or materially identical provisions of one are regarded as decisions on the interpretation of the other<sup>11</sup>.

By virtue of the accession of the European Community to the Madrid Protocol<sup>12</sup>, a Community trade mark can form the basis for an international application and an international registration can form the basis for an application for a Community trade mark<sup>13</sup>.

1 The EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark. The Community Trade Mark Regulation does not prevent actions concerning a Community trade mark being brought under the law of member states relating in particular to civil liability and unfair competition: art 14(2). Thus the Regulation does not affect the law of passing off in the United Kingdom: see PARA 304 et seq post. The Regulation is referred to in the Trade Marks Act 1994 as 'the Community Trade Mark Regulation': s 51.

2 For the meaning of 'Community trade mark' see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 1(1); and PARA 206 post.

3 See ibid art 1(1); and PARA 206 post. For the requirements for registration as a Community trade mark see PARAS 205-223 post. As to the manner of registration see PARAS 278-283 post. The Community Trade Mark Regulation does not affect EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12) on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, and in particular arts 3(4) and 14 (as to which see PARA 302 et seq post); EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 159 (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1); and by virtue of EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12)).

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 1(2); and see PARA 206 post. The Community Trade Mark Regulation also makes provision for the consequences of the enlargements of the Community which occurred on 1 May 2004 (when Cyprus, the Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Slovakia and Slovenia joined) and 1 January 2007 (when the Republic of Bulgaria and Romania joined): art 159a (added by the Act of Accession 2003 (OJ L236, 23.9.03, p 33); renumbered by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1); and amended by the Act of Accession 2005 (OJ L157, 21.6.05, p 203)).

5 As to the prohibited acts which infringe a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 9; and PARA 224 et seq post.



6 As to national proceedings for infringement of a Community trade mark see PARA 250 et seq post. An action may be brought in a single court to restrain infringement throughout the European Union: see *ibid* art 94(1); and PARA 252 post.

7 There will of course be some circumstances in which it may be advantageous to register a trade mark in one or more of the member states. There are subtle differences in the requirements as to registration provided for by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) and by EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks (which provides the requirements for registration in the member states: see PARA 5 ante).

8 There will be many marks which are not registrable as Community trade marks but could be registered as national trade marks. In particular, where the requirements for registration as a Community trade mark are not met in any one member state, the trade mark may not be so registered: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(2); and PARA 209 post. But this would not prevent registration in those member states in which the requirements for registration provided for by EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) were met.

A Community trade mark or an application for a Community trade mark may be converted into a national trade mark application if it ceases to have effect: see PARAS 197-203 post.

9 In particular, the requirements for registration of a Community trade mark (cf the corresponding provisions under the Trade Marks Act 1994: see PARA 55 et seq ante), infringement (cf para 84 et seq ante) and revocation or invalidity (cf para 114 et seq ante).

10 In EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks. As to the Trade Marks Directive see PARA 5 ante.

11 See eg Case C-191/01P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Wm Wrigley Jr Co* [2003] ECR I-12447, sub nom *Wm Wrigley Jr Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] All ER (EC) 1040, ECJ. As to the law of registered trade marks in the United Kingdom see PARA 2 et seq ante.

But see also *Antoni and Alison's Application* [1998] ETMR 460, OHIM Board of Appeal (where it was said that it was not appropriate for the Board of Appeal to consider the interpretation of EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) by the member states); *Penny Makinson's (PI Associates') Application* [1999] ETMR 234, OHIM Board of Appeal.

12 See EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1) on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989; and EC Council Decision 2003/793 (OJ L296, 14.11.03, p 20) approving the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989. As to the Madrid Agreement and the Protocol see PARA 8 ante.

13 As to the international registration of marks under the Madrid Protocol see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 140-156 (all added by EC Council Regulation 1992/2003 (OJ L296, 14.11.2003, p 1); and EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 151(3) substituted by EC Council Regulation 422/2004 (OJ L70 9.3.04 p 1)). As to procedures concerning the international registration of marks see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 102-126 (all added by EC Commission Regulation 782/2004 (OJ L123, 27.4.2004, p 88); and EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) rr 114, 122 amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.2005, p 4)). The details of these provisions are outside the scope of this work, but the system is comparable to that under the Trade Marks Act 1994 (see PARAS 11-13 ante).

A trade mark which is entitled to protection in the European Community by virtue of the Madrid Protocol is referred to in the Trade Marks Act 1994 as an 'international trade mark (EC)': see PARA 8 note 17 ante.

## UPDATE

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(1) INTRODUCTION/177. Domestic implementation of the Community Trade Mark Regulation.

### **177. Domestic implementation of the Community Trade Mark Regulation.**

The Community Trade Mark Regulation<sup>1</sup> has general application. It is binding in its entirety and directly applicable in all member states<sup>2</sup>. Accordingly there is no Act of Parliament or secondary legislation which gives effect to the Regulation. The provisions of the Regulation have the force of law without such implementation<sup>3</sup>.

The Secretary of State<sup>4</sup> may by regulations make such provision as he considers appropriate in connection with the operation of the Community Trade Mark Regulation<sup>5</sup>. Provision may in particular be made with respect to: (1) the making of applications for Community trade marks<sup>6</sup> by way of the Patent Office<sup>7</sup>; (2) the procedures for determining a posteriori the invalidity, or liability to revocation, of the registration of a trade mark from which a Community trade mark claims seniority; (3) the conversion of a Community trade mark, or an application for a Community trade mark, into an application for registration under the Trade Marks Act 1994; (4) the designation of courts in the United Kingdom having jurisdiction over proceedings arising out of the Community Trade Mark Regulation<sup>8</sup>.

Without prejudice to the generality of the above, provision may be made by regulations: (a) applying in relation to a Community trade mark the statutory provisions relating to the remedy for groundless threats of infringement proceedings<sup>9</sup>, the importation of infringing goods, material or articles<sup>10</sup>, and offences<sup>11</sup>; and (b) making, in relation to the list of professional representatives<sup>12</sup> and persons on that list, provision corresponding to that made by, or capable of being made under, the statutory provisions<sup>13</sup> in relation to the register of trade mark agents and registered trade mark agents<sup>14</sup>.

1    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    Treaty Establishing the European Community (Rome, 25 March 1957; TS1 (1973); Cmnd 5179) art 249 (formerly art 189; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ); EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 160(4), 2nd para (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)).

3    It could, however, be said that the European Communities Act 1972 provides for the implementation of the Community Trade Mark Regulation: see the European Communities Act 1972 s 2(1).

4    As to the Secretary of State see PARA 14 ante.

5    Trade Marks Act 1994 ss 51, 52(1). References in the Trade Marks Act 1994 to a Community instrument include references to any instrument amending or replacing that instrument: s 103(3).

6    For these purposes, 'Community trade marks' has the meaning given by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 1(1) (see PARA 206 post): Trade Marks Act 1994 s 51. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

7    As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

8    Trade Marks Act 1994 ss 51, 52(2). Regulations under s 52 must be made by statutory instrument which is subject to annulment in pursuance of a resolution of either House of Parliament: s 52(4).

The following regulations have been so made: (1) the Community Trade Mark (Fees) Regulations 1995, SI 1995/3175 (see PARA 278 note 6 post); (2) the Trade Marks (International Registrations Designating the

European Community, etc) Regulations 2004, SI 2004/2332; (3) the Community Trade Mark Regulations 2006, SI 2006/1027 (see PARAS 196, 202, 250, 266-269, 288, 349 post).

Many of the provisions of the Community Trade Mark Regulations 2006, SI 2006/1027, also apply to international trade marks (EC): reg 2(2). To that extent the regulations are better regarded as having been made pursuant to the Trade Marks Act 1994 s 54: see PARA 8 ante.

9 le ibid s 21: see PARAS 123-125 ante, 266 post.

10 le ibid ss 89-91 (as amended): see PARAS 149-152 ante, 267 post.

11 le ibid s 92 (see PARAS 141-144 ante), s 93 (see PARA 146 ante), s 95 (see PARA 148 ante) and s 96 (supplementary provisions relating to summary proceedings in Scotland). See also PARA 268 post.

12 le the list maintained in pursuance of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 89 (as amended): see PARAS 194-195 post.

13 le the Trade Marks Act 1994 ss 84-88: see PARA 32 et seq ante.

14 Ibid s 52(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

### **177 Domestic implementation of the Community Trade Mark Regulation**

TEXT AND NOTE 14--Reference to trade mark agents and registered trade mark agents now to trade mark attorneys and registered trade mark attorneys: Trade Marks Act 1994 s 52(3) (amended by Legal Services Act 2007 Sch 21 para 110).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(1) INTRODUCTION/178. Community implementing provisions.

### **178. Community implementing provisions.**

The rules implementing the Community Trade Mark Regulation<sup>1</sup> must be adopted in an Implementing Regulation<sup>2</sup>.

The Implementing Regulation<sup>3</sup> came into force on 22 December 1995<sup>4</sup>, and it provides for the detailed operation of the Office for Harmonisation in the Internal Market<sup>5</sup> and for the procedures of the Office<sup>6</sup>.

1    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    Ibid art 157(1) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)). See note 3 infra.

3    The Implementing Regulation is EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark. The rules of procedure of the Boards of Appeal created by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) must be adopted and amended in accordance with the procedure laid down in art 158: art 157(3) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)). The rules implementing EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) are provided by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 (amended by EC Commission Regulation 782/2004 (OJ L123, 27.4.04, p 88); and EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)); and transitional provisions are provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 2.

4    Ibid art 3.

5    As to the Office see PARA 180 et seq post. For an outline of the procedure in the Office see PARA 277 et seq post.

6    The detail of the rules laid down by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) is beyond the scope of this work, although the content of those rules is summarised where appropriate.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

### **178 Community implementing provisions**

NOTE 3--Regulation 2868/95 further amended: EC Commission Regulation 355/2009 (OJ L109, 30.4.2009, p 3)

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(1) INTRODUCTION/179. Commencement and transitional provisions.

### **179. Commencement and transitional provisions.**

The provisions of the Community Trade Mark Regulation<sup>1</sup> entered into force on 15 March 1994<sup>2</sup>. Applications for Community trade marks<sup>3</sup> were permitted to be filed at the Office for Harmonisation in the Internal Market<sup>4</sup> from 1 April 1996<sup>5</sup>.

The member states were required to take the necessary measures<sup>6</sup> for the purpose of implementing the Regulation by 15 March 1997<sup>7</sup>.

1    le EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    Ibid art 160(1) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)). The date mentioned in the text is the 60th day following that of the publication of the Regulation in the Official Journal of the European Communities: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 160(1) (as so amended).

3    For the meaning of 'Community trade mark' see PARA 206 post. As to applications for Community trade marks see PARAS 278-283 post.

4    As to the Office see PARA 180 et seq post.

5    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 160(3) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)). The date mentioned in the text is the date fixed by the Administrative Board of the Office pursuant to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 160(3) (as so amended). Applications for Community trade marks filed within three months before that date are deemed to have been filed on that date: art 160(4), 1st para (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)).

6    le the necessary measures for the purpose of implementing EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 91 (see PARA 250 post) and art 110 (as amended) (see PARA 201 post). The United Kingdom measures are now contained in the Community Trade Mark Regulations 2006, SI 2006/1027: see PARA 177 note 8 ante.

7    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 160(2) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)). The member states were required to take measures within three years following the entry into force of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) and also to inform the EC Commission of those measures forthwith: art 160(2).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/180. The Office for Harmonisation in the Internal Market.

## **(2) ADMINISTRATION**

### **(i) The Office for Harmonisation in the Internal Market**

#### **180. The Office for Harmonisation in the Internal Market.**

The Community Trade Mark Regulation<sup>1</sup> established the Office for Harmonisation in the Internal Market (Trade Marks and Designs), referred to in the Regulation as 'the Office'<sup>2</sup>. It has legal personality<sup>3</sup> and is represented and managed by its President<sup>4</sup>. The Office has its seat in Alicante, Spain<sup>5</sup>.

The Protocol on the Privileges and Immunities of the European Communities<sup>6</sup> applies to the Office<sup>7</sup>.

The contractual liability of the Office is governed by the law applicable to the contract in question<sup>8</sup>. As for tortious liability, the Office must, in accordance with the general principles common to the laws of the member states, make good any damage caused by its departments or by its servants in the performance of their duties<sup>9</sup>.

1    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    Ibid art 2. The Office is a body of the Community: art 111(1). The administration of the Office is provided for by arts 112, 114(5), 119-138 (arts 127, 129-131, 134, 136 as amended). Those provisions are not within the scope of this work but are summarised in PARA 181 et seq post.

3    Ibid art 111(1). In each of the member states the Office enjoys the most extensive legal protection accorded to legal persons under their laws; it may in particular acquire or dispose of movable and immovable property and may be a party to legal proceedings: art 111(2).

4    Ibid arts 111(3), 119(1). The particular functions of the President are laid down by art 119(2).

5    See the Statement by the Council and the Commission on the seat of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ L11, 14.1.94, p 36).

6    Ie the Protocol on the Privileges and Immunities of the European Communities (OJ L152, 13.7.67, p 1) (as amended): see INTERNATIONAL RELATIONS LAW vol 61 (2010) PARA 304 et seq.

7    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 113.

8    Ibid art 114(1). The European Court of Justice is competent to give judgment pursuant to any arbitration clause contained in a contract concluded by the Office: art 114(2).

9    Ibid art 114(3). The European Court of Justice has jurisdiction in disputes relating to compensation for the damage referred to in this provision: art 114(4).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/181. Staff and senior officials of the Office.

### **181. Staff and senior officials of the Office.**

The Community Trade Mark Regulation<sup>1</sup> makes provision for the employment of staff by the Office for Harmonisation in the Internal Market<sup>2</sup>. In general, the regulations<sup>3</sup> relating to staff of European Union bodies apply to the staff of the Office<sup>4</sup>, and the powers conferred on those bodies by those regulations may be exercised by the Office in respect of its staff<sup>5</sup>.

The President and any Vice-Presidents<sup>6</sup> of the Office are appointed by the EC Council<sup>7</sup>.

1    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    See *ibid* arts 112, 114(5). As to the establishment etc of the Office see PARA 180 *et seq ante*.

3    Ie the Staff Regulations of officials of the European Communities, the Conditions of Employment of other servants of the European Communities, and the rules adopted by agreement between the Institutions of the European Communities for giving effect to those Staff Regulations and Conditions of Employment apply to the staff of the Office.

4    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 112(1).

5    *Ibid* art 112(2).

6    As to Vice-Presidents see *ibid* art 119(3).

7    See *ibid* art 120, which lays down the procedure for and terms of their appointment.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/182. Organs of the Office.

## 182. Organs of the Office.

The Community Trade Mark Regulation<sup>1</sup> makes provision for the following organs of the Office for Harmonisation in the Internal Market, in addition to the President and Vice-Presidents<sup>2</sup>:

- 275 (1) the Administrative Board<sup>3</sup>;
- 276 (2) the Examiners<sup>4</sup>;
- 277 (3) the Opposition Divisions<sup>5</sup>;
- 278 (4) the Administration of Trade Marks and Designs and Legal Division<sup>6</sup>;
- 279 (5) the Cancellation Divisions<sup>7</sup>;
- 280 (6) the Boards of Appeal<sup>8</sup>; and
- 281 (7) the Budget Committee<sup>9</sup>.

1 The EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2 As to the President and Vice-Presidents see PARAS 180-181 ante. As to the establishment etc of the Office see PARA 180 et seq ante. In practice, as a result of an internal reorganisation by the Office in 2006, the core business of the Office is carried out by two departments, the Trade Marks and Registry Department and the Trade Marks and Cancellation Department.

3 The Administrative Board is set up by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 121(1) and its powers, duties and organisation are governed by arts 121-124.

4 Examiners are competent to act pursuant to *ibid* art 125(a). An examiner is responsible for taking decisions on behalf of the Office in relation to an application for registration of a Community trade mark, including the matters referred to in art 36 (as amended), art 38 and art 66 (see PARAS 279, 297 post): art 126. They are governed by art 132.

5 Opposition Divisions are competent to act pursuant to *ibid* art 125(b). They are responsible for taking decisions on an opposition to an application to register a Community trade mark (see PARA 282 post): art 127(1). As to their composition see arts 127(2), 132 (art 127(2) substituted by Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

6 The Administration of Trade Marks and Designs and Legal Division is competent to act pursuant to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 125(c) (amended by virtue of EC Council Regulation 6/2002 (OJ L3, 5.1.2002, p 1) on Community designs, art 104(1)). Its powers and duties are governed by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 128, 132.

7 Cancellation Divisions are competent to act pursuant to *ibid* art 125(d). They are responsible for taking decisions in relation to an application for the revocation or declaration of invalidity of a Community trade mark (see PARAS 289-290 post): art 129(1). As to their composition see arts 129(2), 132 (art 129(2) substituted by Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

8 The Boards of Appeal are competent to act pursuant to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 125(e). They are responsible for deciding appeals from the decisions of Examiners, the Opposition Divisions, the Administration of Trade Marks and Legal Division and the Cancellation Divisions: art 130(1). As to their composition see arts 130(2), 131, 132 (arts 130(2), 131 substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). The Boards of Appeal form part of the administrative office responsible for registering trade marks and, although they enjoy a wide degree of independence while carrying out their duties, they are not to be classified as tribunals: Case T-63/01 *Procter and Gamble v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-5255, (2002) Times, 28 December, CFI; but cf *Lenzing AG's European Patent (UK)* [1997] RPC 245, sub nom *R v Comptroller of Patents, Designs and Trade Marks, ex p Lenzing AG* [1997] 9 LS Gaz R 31 (a patent case). As to appeals to a Board of Appeal see PARA 291 et seq post.

There is provision for an Enlarged Board of Appeal (also known as the Grand Board of Appeal) chaired by the President of the Boards of Appeal to decide certain specific cases where the legal difficulty or the importance of

the case or special circumstances justify it: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 130(2)-(5) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). It is understood that the Enlarged Board of Appeal was created mainly to ensure consistency in the Office's case law, as with its counterpart the Enlarged Board of Appeal of the European Patent Office; but the need for this may be questioned given the appellate jurisdiction of the Court of First Instance and the European Court of Justice (see PARA 294 post). It may be noted that the economic importance of the case has already been regarded as sufficient justification for a reference to the Enlarged Board of Appeal: Case R 856/2004-G *Lego Juris A/S v Mega Brands Inc* [2007] ETMR 11, OHIM Enlarged Board of Appeal. The Enlarged Board of Appeal issued its first decision in Case R 495/2005-G *Application of Kenneth (t/a Screw You)* [2007] ETMR 7, OHIM Enlarged Board of Appeal.

9 The Budget Committee is set up, attached to the Office, by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 133(1). Its organisation is governed by arts 121(6), 122, 123, 124(1)-(4), (6), (7): art 133(2). As to the powers and duties of the Budget Committee see PARA 183 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/183. Budget and financial control.

### **183. Budget and financial control.**

The Budget Committee<sup>1</sup> is responsible for the budget and financial control of the Office for Harmonisation in the Internal Market<sup>2</sup>, in particular the adoption of the Office's budget<sup>3</sup>. An internal audit function must be set up within the Office, with an internal auditor appointed by the President responsible for verifying the proper operation of budget implementation systems and procedures of the Office<sup>4</sup>. The Budget Committee must also adopt internal financial provisions for the Office<sup>5</sup>.

1 As to the Budget Committee see PARA 182 note 9 ante. The Budget Committee has the powers assigned to it by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 39(4), 133-139 (arts 134, 139 amended by EC Council Regulation 1992/2003 (OJ L245, 14.11.03, p 1); and EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 136 substituted by EC Council Regulation 1653/2003 (OJ L296, 29.9.03, p 36)): EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 133(1).

2 See ibid arts 133-138 (art 134 as amended and art 36 as substituted: see note 1 supra). As to the establishment etc of the Office see PARA 180 et seq ante.

3 Ibid art 135(3). As to the contents and preparation of the Office's budget see arts 134-135 (art 134 as amended: see note 1 supra). In particular, the revenue and expenditure shown in the budget must balance: art 134(2).

4 Ibid art 136 (as substituted: see note 1 supra). As to the President see PARAS 180-181 ante.

5 See ibid art 138, which sets out the procedure for the adoption of such provisions.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/184. Fees.

#### **184. Fees.**

Provision is made for fees regulations<sup>1</sup>, which must determine the amounts of fees and the ways in which they are paid<sup>2</sup>. The amounts of the fees must be fixed at such a level as to ensure that the revenue in respect thereof is in principle sufficient for the budget of the Office for Harmonisation in the Internal Market<sup>3</sup> to be balanced<sup>4</sup>.

Fees must be charged in particular in the cases listed below<sup>5</sup>:

- 282 (1) late payment of the registration fee<sup>6</sup>;
- 283 (2) issue of a copy of the certificate of registration<sup>7</sup>;
- 284 (3) registration of a licence or another right in respect of a Community trade mark<sup>6</sup>;
- 285 (4) registration of a licence or another right in respect of an application for a Community trade mark;
- 286 (5) cancellation of the registration of a licence or another right;
- 287 (6) alteration of a registered Community trade mark<sup>7</sup>;
- 288 (7) issue of an extract from the register;
- 289 (8) inspection of the files<sup>8</sup>;
- 290 (9) issue of copies of file documents;
- 291 (10) issue of certified copies of the application;
- 292 (11) communication of information in a file; and
- 293 (12) review of the determination of the procedural costs to be refunded.

1 See the EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 139. The fees regulations must be adopted and amended in accordance with the procedure laid down in art 158: art 139(3) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)). EC Commission Regulation 2869/95 (OJ L303, 15.12.95, p 33) on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (amended by EC Commission Regulation 781/2004 (OJ L123, 27.4.04, p 85); EC Commission Regulation 1042/2005 (OJ L172, 5.7.05, p 22); and EC Commission Regulation 1687/2005 (OJ L271, 15.10.05, p 14)) was so adopted.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 139(1). Rights of the Office to the payment of a fee are extinguished after four years from the end of the calendar year in which the fee fell due (art 80(1)), and rights against the Office for the refunding of fees or sums of money paid in excess of a fee are extinguished after four years from the end of the calendar year in which the right arose (art 80(2)). That four year period is interrupted in the case covered by art 80(1) by a request for payment of the fee and in the case covered by art 80(2) by a reasoned claim in writing; on interruption it begins again immediately and ends at the latest six years after the end of the year in which it originally began, unless, in the meantime, judicial proceedings to enforce the right have begun; and in this case the period ends at the earliest one year after the judgment has acquired the authority of a final decision: art 80(3).

The President of the Office may waive action for the enforced recovery of any sum due where the sum to be recovered is minimal or where such recovery is too uncertain: EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 74.

3 As to the establishment etc of the Office see PARA 180 et seq ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 139(2). The Office is obliged to produce a balanced budget: see art 134(2); and PARA 183 note 3 ante.

5 Ibid art 157(2) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1); and EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

6 As to registration of a licence or another right in respect of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 22(5), 23; and PARAS 275-276 post.

7 As to alteration of a registered Community trade mark see *ibid* art 48; and PARA 248 post.

8 As to the inspection of the Office's files see *ibid* art 84; and PARA 189 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

## **184 Fees**

Note 1--Regulation 2869/95 further amended: EC Commission Regulation 355/2009 (OJ L109, 30.4.2009, p 3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/185. Languages in the Office.

### **185. Languages in the Office.**

The languages of the Office for Harmonisation in the Internal Market are English, French, German, Italian and Spanish<sup>1</sup>.

An application for a Community trade mark<sup>2</sup> must be filed in one of the official languages of the European Community<sup>3</sup>. The applicant must indicate a second language, which must be a language of the Office, the use of which he accepts as a possible language of proceedings for opposition, revocation or invalidity proceedings<sup>4</sup>. Where the applicant for a Community trade mark is the sole party to proceedings before the Office, the language of proceedings is the language used for filing the application for a Community trade mark<sup>5</sup>.

The notice of opposition and an application for revocation or invalidity must be filed in one of the languages of the Office<sup>6</sup>. If the language chosen<sup>7</sup> for the notice of opposition or the application for revocation or invalidity is the language of the application for a trade mark or the second language indicated when the application was filed, that language will be the language of the proceedings<sup>8</sup>.

If the language chosen<sup>9</sup> for the notice of opposition or the application for revocation or invalidity is neither the language of the application for a trade mark nor the second language indicated when the application was filed, the opposing party or the party seeking revocation or invalidity is required to produce, at his own expense, a translation of his application either into the language of the application for a trade mark, provided that it is a language of the Office, or into the second language indicated when the application was filed<sup>10</sup>. The language into which the application has been translated will then become the language of the proceedings<sup>11</sup>.

Parties to opposition, revocation, invalidity or appeal proceedings may agree that a different official language of the European Community is to be the language of the proceedings<sup>12</sup>.

1 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 115(2). A challenge to the legality of the language regime established by art 115 on the ground that it was contrary to the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') art 6 was unsuccessful: Case C-361/01P *Kik v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR I-8283, [2004] IP & T 403, ECJ. Further provisions as to the use of languages in the Office are provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark (the 'Implementing Regulation') art 1 rr 16, 38, 95-99 (rr 16, 98 substituted, and r 38 amended, by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). There is a body of case law of the Office for Harmonisation in the Internal Market Boards of Appeal and of the Court of First Instance, not all of it consistent, on the interpretation and application of these provisions; for a recent example see Case T-6/05 *DEF-TEC Defense Technology GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] All ER (D) 23 (Sep), CFI. As to the establishment etc of the Office see PARA 180 et seq ante. As to translation services required by the Office see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 117.

2 For the meaning of 'Community trade mark' see PARA 206 post. As to applications for Community trade marks see PARAS 278-283 post.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 115(1).

4 Ibid art 115(3). If the application was filed in a language which is not one of the languages of the Office, the Office must arrange to have the application, as described in art 26(1) (see PARA 278 post), translated into the language indicated by the applicant: art 115(3).

5 Ibid art 115(4). If the application was made in a language other than the languages of the Office, the Office may send written communications to the applicant in the second language indicated by the applicant in his application: art 115(4). Procedural documents must be drawn up by the Office in the language used for filing the application; the written communications which may be sent in the second language are any communications which from their content cannot be regarded as amounting to procedural documents: Case C-361/01P *Kik v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR I-8283, [2004] IP & T 403, ECJ.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 115(5).

7 ie one of the languages of the Office, in accordance with ibid art 115(5): see the text to note 6 supra.

8 Ibid art 115(6).

9 See note 7 supra.

10 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 115(6). The translation must be produced within the period prescribed in the Implementing Regulation (see note 1 supra): art 115(6).

11 Ibid art 115(6).

12 Ibid art 115(7).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/186. Control of legality.

### **186. Control of legality.**

The EC Commission must check the legality of: (1) those acts of the President<sup>1</sup> of the Office for Harmonisation in the Internal Market<sup>2</sup> in respect of which Community law does not provide for any check on legality by another body; and (2) acts of the Budget Committee<sup>3</sup> attached to the Office<sup>4</sup>. It must require that any such unlawful acts be altered or annulled<sup>5</sup>.

Member states and any person directly and personally involved may refer to the EC Commission such an act, whether express or implied, for the Commission to examine the legality of that act. Such referral must be made within one month of the day on which the party concerned first became aware of the act in question. The Commission must take a decision within three months. If no decision has been taken within this period, the case is deemed to have been dismissed<sup>6</sup>.

1 As to the President see PARAS 180-181 ante.

2 As to the establishment etc of the Office see PARA 180 et seq ante.

3 As to the Budget Committee see PARAS 182 text and note 9, 183 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 118(1). The Budget Committee is attached to the Office pursuant to art 133: art 118(1).

5 Ibid art 118(2).

6 Ibid art 118(3) (amended by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(i) The Office for Harmonisation in the Internal Market/187. Access to documents.

### **187. Access to documents.**

The provisions<sup>1</sup> regarding access to European Parliament, Council and Commission documents also apply to documents held by the Office for Harmonisation in the Internal Market<sup>2</sup>.

<sup>1</sup> See under EC Parliament and Council Regulation 1049/2001 (OJ L145, 31.5.01, p 43) regarding public access to European Parliament, Council and Commission documents.

<sup>2</sup> EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 118a(1) (art 118a added by EC Council Regulation 1653/2003 (OJ L245, 29.9.03, p 36)). The Administrative Board was required to adopt the practical arrangements for implementing these provisions within six months of the entry into force of EC Council Regulation 1653/2003 (OJ L245, 29.9.03, p 36): EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 118a(2) (as so added). Decisions taken by the Office pursuant to EC Parliament and Council Regulation 1049/2001 (OJ L145, 31.5.01, p 43) art 8 may give rise to the lodging of a complaint to the Ombudsman or form the subject of an action before the Court of Justice under the conditions laid down in the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') arts 195, 230 respectively: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 118a(3) (as so added). As to the establishment etc of the Office see PARA 180 et seq ante; and as to the Administrative Board see PARA 182 text and note 3 ante.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(ii) Public Information/188. The register of Community trade marks.

## **(ii) Public Information**

### **188. The register of Community trade marks.**

The Office for Harmonisation in the Internal Market<sup>1</sup> must keep a register, to be known as the register of Community trade marks, which must contain the prescribed particulars<sup>2</sup>; the register must be open to public inspection<sup>3</sup>.

An application for a Community trade mark<sup>4</sup> and other prescribed information<sup>5</sup> must be published in all the official languages of the European Community<sup>6</sup>.

1 As to the Office see PARA 180 et seq ante.

2 I.e. those particulars the registration or inclusion of which is provided for by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, or by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark. Article 1 r 84 (amended by EC Commission Regulation 782/2004 (OJ L123, 27.4.04, p 88); and by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)) specifies precisely what the register must contain.

Perhaps the most important particular, the registration of which is provided for, is the registration of Community trade marks: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 45; and PARA 283 post.

The Office must also maintain an electronic data bank with the particulars of applications for registrations and entries in the register, which must be made available to the public: see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 87.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 83.

4 For the meaning of 'Community trade mark' see PARA 206 post. As to applications for Community trade marks see PARAS 278-283 post.

5 I.e. all other information the publication of which is prescribed by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) or EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1).

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 116(1). All entries in the register of Community trade marks must be made in all the official languages of the European Community: art 116(2). In cases of doubt, the text in the language of the Office in which the application for the Community trade mark was filed is authentic: art 116(3). If the application was filed in an official language of the European Community other than one of the languages of the Office, the text in the second language indicated by the applicant is authentic: art 116(3). As to the use of languages in the Office see PARA 185 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(ii) Public Information/189. Inspection of the Office's files.

### **189. Inspection of the Office's files.**

The files relating to a Community trade mark<sup>1</sup> application<sup>2</sup> which have not yet been published<sup>3</sup> must not be made available for inspection without the consent of the applicant<sup>4</sup>. However, any person who can prove that the applicant for a Community trade mark has stated that, after the trade mark has been registered, he will invoke the rights under it against him, may obtain inspection of the files prior to the publication of that application and without the consent of the applicant<sup>5</sup>.

Subsequent to the publication of the Community trade mark application, the files relating to the application and the resulting trade mark may be inspected on request<sup>6</sup>.

However, where the files are inspected pursuant to the above provisions<sup>7</sup>, certain documents in the file may be withheld from inspection<sup>8</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 post.

2 As to applications for Community trade marks see PARAS 278-283 post.

3 As to publication see PARA 190 post.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 84(1). Rules as to the keeping of files are provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 91 (substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 84(2).

6 Ibid art 84(3). The procedure for such inspection, and for communication of information in the files, is provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 88-91 (r 89 amended by EC Commission Regulation 782/2004 (OJ L123, 27.4.04, p 88); and by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4); and EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) r 91 as substituted (see note 4 supra)).

7 Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 84(2) or art 84(3).

8 Ie in accordance with the provisions of EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) (see PARA 178 ante): EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 84(4).

The parts of the file which must be excluded from inspection pursuant to this provision are: (1) documents relating to exclusion or objection pursuant to art 132 (conflicts of interest of examiners or members of the Divisions of the Office for Harmonisation in the Internal Market); (2) draft decisions and opinions, and all other internal documents used for the preparation of decisions and opinions; and (3) parts of the file which the party concerned showed a special interest in keeping confidential before the application for inspection of the files was made, unless inspection of such part of the file is justified by overriding legitimate interests of the party seeking inspection: EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 88. As to the Office see PARA 180 et seq ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(ii) Public Information/190. Periodical publications.

### **190. Periodical publications.**

The Office for Harmonisation in the Internal Market<sup>1</sup> must periodically publish:

- 294 (1) a Community Trade Marks Bulletin containing entries made in the register of Community trade marks<sup>2</sup> as well as other prescribed particulars<sup>3</sup>; and
- 295 (2) an Official Journal containing notices and information of a general character issued by the President of the Office, as well as any other information relevant to implementation of the Community Trade Mark Regulation<sup>4</sup>.

In this way, applications for and registrations of Community trade marks are published by the Office<sup>5</sup>.

1 As to the Office see PARA 180 et seq ante.

2 As to the register of Community trade marks see PARA 188 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (the 'Community Trade Mark Regulation'), art 85(a). The particulars referred to are those the publication of which is prescribed by that regulation, or by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark. Article 1 r 85 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)) makes further provision for the publication of the Community Trade Marks Bulletin.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 85(b). EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 86 makes further provision for the publication of the Official Journal of the Office. As to the President see PARAS 180-181 ante.

5 Applications are required to be published by virtue of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 40 (as substituted) (see PARA 279 post) and registrations must be registered by virtue of art 45 (see PARA 283 post).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(ii) Public Information/191. Administrative co-operation and exchange of publications.

### **191. Administrative co-operation and exchange of publications.**

Unless otherwise provided<sup>1</sup>, the Office for Harmonisation in the Internal Market<sup>2</sup> and the courts or authorities of the member states must, on request, give assistance to each other by communicating information or opening files for inspection. Where the Office lays files open to inspection by courts, public prosecutors' offices or central industrial property offices, the inspection is not subject to the restrictions set down in the Community Trade Mark Regulation<sup>3</sup>.

The Office and the central industrial property offices of the member states must despatch to each other on request and for their own use one or more copies of their respective publications free of charge<sup>4</sup>.

The Office may conclude agreements relating to the exchange or supply of publications<sup>5</sup>.

1     Ie in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (the 'Community Trade Mark Regulation'), or in national laws.

2     As to the Office see PARA 180 et seq ante.

3     EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 86. Further provision for co-operation between the Office and the authorities of the member states is provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 92-93.

As to the inspection of the Office's files, and the restrictions thereon, see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 84; and PARA 189 ante.

4     Ibid art 87(1).

5     Ibid art 87(2).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iii) Representation/192. Capacity to act.

### **(iii) Representation**

#### **192. Capacity to act.**

For the purpose of the Community Trade Mark Regulation<sup>1</sup>, companies or firms and other legal bodies are regarded as legal persons if, under the terms of the law governing them, they have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued<sup>2</sup>.

1     Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2     Ibid art 3. If a legal body has these capacities it qualifies as a legal person within the meaning of art 3 even if the law governing it does not grant it legal personality: Case R 195/1998-1 *Nauta Dutilh's Application* [2000] ETMR 90, OHIM Board of Appeal.

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iii) Representation/193. General principles of representation.

### **193. General principles of representation.**

Subject to the following<sup>1</sup>, no person is compelled to be represented<sup>2</sup> before the Office for Harmonisation in the Internal Market<sup>3</sup>. The exceptions are:

- 296 (1) natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must be professionally represented<sup>4</sup> before the Office in all proceedings<sup>5</sup>, other than in filing an application for a Community trade mark<sup>6</sup>;
- 297 (2) natural or legal persons having their domicile or principal place of business or a real and effective industrial or commercial establishment in the Community may be represented before the Office by an employee<sup>7</sup>; and an employee of a legal person to which this provision applies may also represent other legal persons which have economic connections with the first legal person, even if those other legal persons have neither their domicile nor their principal place of business nor a real and effective industrial or commercial establishment within the Community<sup>8</sup>.

<sup>1</sup> le subject to the provisions of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 88(2).

<sup>2</sup> le professionally represented. For the provisions relating to professional representation see *ibid* art 89 (as amended); and PARAS 194-195 post.

<sup>3</sup> *Ibid* art 88(1). As to the Office see PARA 180 et seq ante.

<sup>4</sup> le represented in accordance with *ibid* art 89(1) (as amended): see PARA 194 post.

<sup>5</sup> le proceedings established by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

<sup>6</sup> *Ibid* art 88(2). An exception is provided for by art 88(3) (as amended): see the text to note 8 *infra*. See also EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, which may permit other exceptions: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 88(2).

<sup>7</sup> EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) must specify whether and under what conditions an employee must file with the Office a signed authorisation for insertion on the file: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 88(4) (added by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) requires that employees file with the Office a signed authorisation and sets out the applicable conditions: art 1 r 76(2)-(4) (added by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

<sup>8</sup> EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 88(3) (amended by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iii) Representation/194. Professional representation.

#### **194. Professional representation.**

Representatives acting before the Office for Harmonisation in the Internal Market<sup>1</sup> must file with it a signed authorisation for insertion on the files<sup>2</sup>.

Representation of natural or legal persons before the Office may only be undertaken by:

- 298 (1) any legal practitioner qualified in one of the member states and having his place of business within the Community, to the extent that he is entitled, within the said state, to act as a representative in trade mark matters<sup>3</sup>; or
- 299 (2) professional representatives whose names appear on the list maintained for this purpose by the Office<sup>4</sup>.

1 As to the Office see PARA 180 et seq ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 89(1). The details of such authorisation are set out in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 76 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). Further provisions on representations are provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 75, 77.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 89(1)(a). As to the requirements to act as a representative in trade mark matters in the United Kingdom see PARA 31 et seq ante.

4 Ibid art 89(1)(b) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1). EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) must specify whether and under what conditions the representatives before the Office must file with the Office a signed authorisation for insertion on the file: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 89(1)(b) (as so substituted). EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) provides that professional representatives entered on the list maintained by the Office must file with the Office a signed authorisation for insertion in the file only if the Office expressly requires it or where there are a several parties to the proceedings in which the representative acts before the Office if the other party expressly asks for it: art 1 r 76(1) (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). As to the list of professional representatives see PARA 195 post.

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iii) Representation/195. The list of professional representatives.

### **195. The list of professional representatives.**

Any natural person who fulfils the following conditions may be entered on the list of professional representatives<sup>1</sup>:

- 300 (1) he must be a national of one of the member states<sup>2</sup>;
- 301 (2) he must have his place of business or employment in the Community<sup>3</sup>; and
- 302 (3) he must be entitled to represent natural or legal persons in trade mark matters before the central industrial property office of a member state<sup>4</sup>.

Entry must be effected upon request, accompanied by a certificate furnished by the central industrial property office of the member state concerned indicating that the foregoing conditions<sup>5</sup> are fulfilled<sup>6</sup>.

1 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 89(2).

The conditions under which a person may be removed from the list of professional representatives are laid down in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 89(5). Amendment of the list of representatives is provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 178.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 89(2)(a). The President of the Office for Harmonisation in the Internal Market may grant exemption from this requirement in special circumstances: art 89(4)(b). As to the President and the Office see PARAS 180-181 ante.

3 Ibid art 89(2)(b).

4 Ibid art 89(2)(c) (amended by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). Where, in that member state, the entitlement is not conditional upon the requirement of special professional qualifications, persons applying to be entered on the list who act in trade mark matters before the central industrial property office of that state must have habitually so acted for at least five years. However, persons whose professional qualification to represent natural or legal persons in trade mark matters before the central industrial property office of one of the member states is officially recognised in accordance with the regulations laid down by such state is not subject to the condition of having exercised the profession: art 89(2)(c) (as so amended). The President of the Office may grant exemption from the requirement that a person applying to be entered onto the list must have habitually acted in trade mark matters before the central industrial property office of the member state for at least five years: art 89(4)(a).

5 I.e. the conditions laid down in ibid art 89(2): see heads (1)-(3) in the text.

6 Ibid art 89(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iii) Representation/196. Privilege for communications with professional representatives.

**196. Privilege for communications with professional representatives.**

Any communication as to any matter relating to the protection of any trade mark or as to any matter involving passing off<sup>1</sup>:

- 303 (1) between a person and his professional trade marks representative<sup>2</sup>; or
- 304 (2) for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his professional trade marks representative<sup>3</sup>,

is privileged from disclosure in legal proceedings in the same way as a communication between a person and his solicitor or a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his solicitor<sup>4</sup>.

1 Community Trade Marks Regulations 2006, SI 2006/1027, reg 11(1), (2). As to passing off see PARA 304 et seq post.

2 Ibid reg 11(2)(a). A person's 'professional trade marks representative' means a person who is retained by and is on the special list of professional representatives for trade marks matters referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 89 (see PARAS 194-195 ante): Community Trade Marks Regulations 2006, SI 2006/1027, reg 11(3).

3 Ibid reg 11(2)(b).

4 Ibid reg 11(2). Cf the Trade Marks Act 1994 s 87: see PARA 34 ante. As to legal professional privilege see LEGAL PROFESSIONS vol 66 (2009) PARAS 1032, 1146.

**UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iv) Conversion into a National Trade Mark Application/197. Introduction.

## **(iv) Conversion into a National Trade Mark Application**

### **197. Introduction.**

In some cases, a sign will satisfy the requirements for registration<sup>1</sup> as a Community trade mark<sup>2</sup> in some, but not all, member states<sup>3</sup>. In other cases, a mark may become liable to be revoked<sup>4</sup> or declared invalid<sup>5</sup> for reasons obtaining in some, but not all, member states<sup>6</sup>. However, a Community trade mark has equal effect throughout the Community<sup>7</sup>. It cannot be valid in respect of only part of the Community: therefore, if it is liable to be refused registration, declared invalid, or revoked<sup>8</sup> in one member state, it cannot continue to be registered at all.

In order to mitigate possible unfair consequences of this, a Community trade mark or a Community trade mark application<sup>9</sup> may be converted into a national trade mark application<sup>10</sup>. Accordingly, the applicant for or proprietor of a Community trade mark may request the conversion of his Community trade mark application or Community trade mark into a national trade mark<sup>11</sup>:

305 (1) to the extent that the Community trade mark application is refused, withdrawn, or deemed to be withdrawn<sup>12</sup>; or

306 (2) to the extent that the Community trade mark ceases to have effect<sup>13</sup>.

1 As to the requirements for registration as a Community trade mark see PARAS 205-223 post.

2 For the meaning of 'Community trade mark' see PARA 206 post.

3 See PARA 209 post.

4 For the grounds of revocation see PARA 237 et seq post.

5 For the grounds of invalidity see PARA 243 et seq post.

6 Eg a Community trade mark would be liable to revocation if, in consequence of acts or inactivity of the proprietor, it has become the common name of the product in respect of which it is registered: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 50(1)(b); and PARA 239 post.

7 See *ibid* art 1(2); and PARA 206 post.

8 As to whether a Community trade mark may be revoked for non-use if it is not used throughout the Community, or at least in a substantial part thereof, see PARAS 198 note 3, 237 note 5 post.

9 As to applications for Community trade marks see PARAS 278-283 post.

10 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 108-110 (all as amended); the Community Trade Mark Regulations 2006, SI 2006/1027, reg 10; and PARAS 198-203 post.

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 108(1).

12 *Ibid* art 108(1)(a).

13 *Ibid* art 108(1)(b).

## **UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iv) Conversion into a National Trade Mark Application/198. Limitation of right to convert.

### **198. Limitation of right to convert.**

Conversion cannot take place:

- 307 (1) where the rights of the proprietor of the Community trade mark<sup>1</sup> have been revoked on the grounds of non-use<sup>2</sup>, unless in the member state for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that member state<sup>3</sup>; or
- 308 (2) for the purpose of protection in a member state in which, in accordance with the decision of the Office for Harmonisation in the Internal Market<sup>4</sup> or of the national court<sup>5</sup>, grounds for refusal of registration or grounds for revocation or invalidity apply to the Community trade mark application or Community trade mark<sup>6</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 post.

2 For revocation on the grounds of non-use see PARAS 237-238 post.

3 I.e. EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 108(2)(a). This appears to imply that a Community trade mark may be revoked unless it is used in all member states or at least in a substantial part of the Community, contrary to the widely-held theory that use in one member state is sufficient to preserve a Community trade mark from revocation: see PARAS 237-238 post. The law relating to genuine use in the member states derives from EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, arts 10(1), 12(1) (which are in materially identical terms to the equivalent provisions in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) (ie arts 15, 50(1))). So, in principle, the answer to the question 'has the Community trade mark has been put to genuine use?' should yield the same answer under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) as under the laws of the member states unless the former requires use in all member states or at least in a substantial part of the Community.

4 As to the Office see PARA 180 et seq ante.

5 See PARA 251 et seq post.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 108(2)(b).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iv) Conversion into a National Trade Mark Application/199. Time for filing a request for conversion.

### **199. Time for filing a request for conversion.**

In cases where a Community trade mark application<sup>1</sup> is deemed to be withdrawn, the Office<sup>2</sup> must send to the applicant a communication fixing a period of three months from the date of that communication in which a request for conversion may be filed<sup>3</sup>.

Where the Community trade mark application is withdrawn or the Community trade mark ceases to have effect as a result of a surrender being recorded<sup>4</sup> or of failure to renew the registration<sup>5</sup>, the request for conversion must be filed within three months after the date on which the Community trade mark application has been withdrawn or on which the registration of the Community trade mark ceases to have effect<sup>6</sup>.

Where the Community trade mark application is refused by decision of the Office or the Community trade mark ceases to have effect as a result of a decision of the Office or of a Community trade mark court, the request for conversion must be filed within three months after the date on which that decision acquired the authority of a final decision<sup>7</sup>.

If the request is not filed within the period laid down, the Office will not transmit the request for conversion to the central industrial property offices of the relevant member states<sup>8</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 post. As to applications for Community trade marks see PARAS 278-283 post.

2 As to the Office see PARA 180 et seq ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 108(4) (art 108(4)-(6) substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

4 As to surrender of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 49; and PARA 236 post.

5 As to renewal of a Community trade mark see *ibid* art 47; and PARA 283 post.

6 *Ibid* art 108(5) (as substituted: see note 3 *supra*).

7 *Ibid* art 108(6) (as substituted: see note 3 *supra*).

8 See *ibid* art 109(3) (as substituted); and PARA 200 post. Further, the effect referred to in art 32 (date of filing of application equivalent to regular national filing: see PARA 278 note 23 post) lapses if the request is not filed in due time: art 108(7).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iv) Conversion into a National Trade Mark Application/200. Submission of a request for conversion.

## **200. Submission of a request for conversion.**

A request for conversion must be filed with the Office for Harmonisation in the Internal Market<sup>1</sup> and must specify the member states in which application of the procedure for registration of a national trade mark is desired<sup>2</sup>.

If the Community trade mark application<sup>3</sup> has been published<sup>4</sup>, receipt of any such request must be recorded in the register of Community trade marks<sup>5</sup> and the request for conversion must be published<sup>6</sup>.

The Office must check whether conversion may be requested<sup>7</sup>, whether the request has been filed within the prescribed period<sup>8</sup>, whether the conversion fee has been paid<sup>9</sup> and whether the request fulfills the formal conditions<sup>10</sup>. If all these conditions are fulfilled, the Office must transmit the request to the central industrial property offices of the states specified therein<sup>11</sup>.

1 As to the Office see PARA 180 et seq ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 109(1). As to what the request must contain see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 44 (substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

The request will not be deemed to be filed until the conversion fee has been paid: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 109(1). As to fees see PARA 184 ante.

3 For the meaning of 'Community trade mark' see PARA 206 post. As to applications for Community trade marks see PARAS 278-283 post.

4 As to publication see PARA 190 ante.

5 As to the register of Community trade marks see PARA 188 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 109(2).

7 Ie in accordance with ibid art 108(1), (2): see PARAS 197-198 ante.

8 Ie the period laid down in ibid art 108(4), (5), or (6) (all as substituted), as the case may be: see PARA 199 ante.

9 Ie in accordance with ibid 109(1): see the text and note 2 supra.

10 Ie laid down in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 44 (as substituted: see note 2 supra).

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 109(3) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). The procedure for examination, publication and transmission of the request is provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 45-47 (rr 45, 47 substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iv) Conversion into a National Trade Mark Application/201. Formal requirements for conversion.

## **201. Formal requirements for conversion.**

Any central industrial property office to which the request for conversion is transmitted may obtain from the Office for Harmonisation in the Internal Market<sup>1</sup> any additional information concerning the request enabling that office to make a decision regarding the national trade mark resulting from that conversion<sup>2</sup>.

Any central industrial property office to which the request is transmitted may require that the applicant must, within not less than two months<sup>3</sup>:

- 309 (1) pay the national application fee<sup>4</sup>;
- 310 (2) file a translation in one of the official languages of the state in question of the request and of the documents accompanying it<sup>5</sup>;
- 311 (3) indicate an address for service in the state in question<sup>6</sup>;
- 312 (4) supply a representation<sup>6</sup> of the trade mark in the number of copies specified by the state in question<sup>8</sup>.

1 As to the Office see PARA 180 et seq ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 110(1) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). A Community trade mark application or a Community trade mark transmitted in accordance with EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 109 (as amended) (see PARA 200 ante) must not be subjected to formal requirements of national law which are different from or additional to those provided for in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) or in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 110(2).

As to the procedure on receipt of such an application by the United Kingdom registrar see PARA 202 post.

3 Ibid art 110(3).

4 Ibid art 110(3)(a).

5 Ibid art 110(3)(b).

6 Ibid art 110(3)(c).

7 As to the requirements of a representation see PARA 278 note 10 post.

8 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 110(3)(d).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iv) Conversion into a National Trade Mark Application/202. Request for conversion to be treated as application under the Trade Marks Act 1994.

## **202. Request for conversion to be treated as application under the Trade Marks Act 1994.**

Where pursuant to the relevant provisions<sup>1</sup> either:

- 313 (1) the applicant for or the proprietor of a Community trade mark<sup>2</sup> requests the conversion of his Community trade mark application or Community trade mark into an application for registration of a trade mark under the Trade Marks Act 1994<sup>3</sup>; or
- 314 (2) the holder of an international registration designating the European Community<sup>4</sup> requests<sup>5</sup> the conversion of that designation into an application for registration of a trade mark under the Trade Marks Act 1994<sup>6</sup>,
- 315 the following<sup>7</sup> applies<sup>8</sup>.

Where the request has been transmitted to the registrar<sup>9</sup>, it must be treated as an application for registration of a trade mark under the Trade Marks Act 1994<sup>10</sup>.

1    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 108 (as amended): see PARAS 197-199 ante.

2    For the meaning of 'Community trade mark' see PARA 206 post.

3    Community Trade Mark Regulations 2006, SI 2006/1027, reg 10(1)(a). For the meaning of 'registration' under the Trade Marks Act 1994 see PARA 19 note 2 ante.

4    An 'international registration designating the European Community' means an international registration in relation to which a request has been made (either in the relevant international application or subsequently) for extension of protection to the European Community under the Madrid Protocol art 3 (ter) (1) or (2): Community Trade Mark Regulations 2006, SI 2006/1027, reg 2. As to the Madrid Protocol see PARA 8 ante. As to international registrations see PARA 11 et seq ante.

5    In accordance with EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 154(1)(a) (added by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)).

6    Community Trade Mark Regulations 2006, SI 2006/1027, reg 10(1)(b).

7    Ie ibid regs 2, 10(2), (3) (see the text and notes 9, 10 infra).

8    Ibid reg 10(1).

9    Ie under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 109(3) (as substituted): see PARA 200 ante. As to the registrar see PARA 17 ante.

10   Community Trade Mark Regulations 2006, SI 2006/1027, reg 10(2). A decision of the registrar in relation to the request must be treated as a decision of the registrar under the Trade Marks Act 1994: Community Trade Mark Regulations 2006, SI 2006/1027, reg 10(3). As to appeals from decisions of the registrar see PARA 404 et seq post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(iv) Conversion into a National Trade Mark Application/203. Filing date, priority and seniority of converted application.

### **203. Filing date, priority and seniority of converted application.**

The national trade mark application resulting from conversion of a Community trade mark<sup>1</sup> application or a Community trade mark enjoys in respect of the member states concerned the date of filing or the date of priority<sup>2</sup> of the Community application or trade mark<sup>3</sup>. Where seniority has been claimed<sup>4</sup> by the Community trade mark application from a national trade mark in the state concerned, the national converted application enjoys that claim to seniority<sup>5</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 post.

2 As to priority see PARA 284 et seq post.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 108(3). This does not mean that a national trade mark resulting from conversion of a Community trade mark during the course of opposition proceedings founded on that Community trade mark may be relied upon as founding such proceedings: Case R 286/2002-3 *SFI Group plc v Sandhu* (unreported, 12 June 2003), OHIM Board of Appeal.

4 Ie under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 34 or art 35 (as substituted): see PARAS 287-288 post.

5 Ibid art 108(3).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(2) ADMINISTRATION/(v) Reciprocity/204. In general.

## **(v) Reciprocity**

### **204. In general.**

For the purposes of determining rights to priority<sup>1</sup>, it is necessary for the Office for Harmonisation in the Internal Market<sup>2</sup> to establish whether a state which is not a party to the Paris Convention<sup>3</sup> or to the WTO Agreement<sup>4</sup> accords reciprocal treatment to first filings made at the Office.

If necessary, the President of the Office must request the EC Commission to inquire whether a state which is not a party to the Paris Convention or to the WTO Agreement accords reciprocal treatment within the meaning of the relevant provisions<sup>5</sup>. If the EC Commission determines that such reciprocal treatment is accorded, it must publish a communication to this effect in the Official Journal of the European Union<sup>6</sup>.

The relevant provisions<sup>7</sup> take effect for the nationals of the states concerned from the date of publication in the Official Journal of the European Union of such a communication, unless the communication states an earlier date from which it is applicable. They cease to be effective from the date of publication in the Official Journal of the European Union of a communication to the effect that reciprocal treatment is no longer accorded, unless the communication states an earlier date from which it is applicable<sup>8</sup>.

1. See under the provisions of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 29(5) (as amended) (priority of certain applications: see PARA 284 post).

2. As to the Office see PARA 180 et seq ante.

3. As to the Paris Convention see PARA 6 ante.

4. As to the WTO Agreement see PARA 7 ante.

5. EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 101(1) (art 1 r 101(1)-(3) substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). As to the relevant provisions see note 1 supra.

6. EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 101(2) (as substituted: see note 5 supra). Any such communication must also be published in the Official Journal of the Office: art 1 r 101(4). As to the Official Journal of the Office see PARA 190 ante.

7. See note 1 supra.

8. EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 101(3) (as substituted: see note 5 supra). Any such communication must also be published in the Official Journal of the Office: art 1 r 101(4).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(i) Introduction/205. In general.

### **(3) REQUIREMENTS FOR REGISTRATION**

#### **(i) Introduction**

##### **205. In general.**

Any sign may be registered as a Community trade mark<sup>1</sup> unless one of a number of specified grounds for refusal exists. The grounds for refusal are divided into two classes, described in the Community Trade Mark Regulation<sup>2</sup> as 'absolute grounds for refusal'<sup>3</sup> and 'relative grounds for refusal'<sup>4</sup>. This corresponds to the division under the Trade Marks Act 1994<sup>5</sup>.

Where grounds for refusal of registration exist in respect of only some of the goods or services for which a Community trade mark has been applied for, refusal of registration must cover those goods or services only<sup>6</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 post.

2 ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

3 See ibid art 7 (as amended); and PARA 209 et seq post.

4 See ibid art 8 (as amended); and PARA 218 et seq post.

5 See PARAS 55-82 ante.

6 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 38(1) (see PARA 279 post), art 43(5) (see PARA 282 post), art 50(2) (see PARA 241 post), and arts 51(3), 52(5) (see PARA 246 post). Cf EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 13.

#### **UPDATE**

##### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(i) Introduction/206. Meaning of 'Community trade mark'.

## **206. Meaning of 'Community trade mark'.**

A Community trade mark is defined as a trade mark<sup>1</sup> for goods or services which is registered<sup>2</sup> in accordance with the conditions contained in the Community Trade Mark Regulation<sup>3</sup> and in the manner there provided<sup>4</sup>.

A Community trade mark has a unitary character. It has equal effect throughout the Community. Thus it may not be registered, transferred or surrendered, or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor may its use be prohibited, save in respect of the whole Community<sup>5</sup>.

1 'Trade mark' is not defined in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark; but a sign which is not a trade mark within the meaning of the Trade Marks Act 1994 (see PARA 57 ante) may not be registered as a Community trade mark: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 4, 7(1)(a); and see PARAS 208, 210 post.

2 le under ibid art 45: see PARA 283 post.

3 le EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

4 Ibid art 1(1). Thus a Community trade mark is obtained by registration: art 6. As to the conditions for registration see PARAS 209-223 post. As to the manner of registration see PARAS 278-283 post. Note that Community trade marks may now be obtained via an international application under the Madrid Protocol (see PARA 8 ante): see PARA 176 ante. Such trade marks are referred to in the Trade Marks Act 1994 as 'international trade marks (EC)': see PARA 8 note 17 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 1(2). This principle applies unless otherwise provided in the Regulation: art 1(2). Earlier national rights may be invoked to prohibit the use of Community trade marks only in certain circumstances: see art 106; and PARA 259 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(i) Introduction/207. Persons who can be proprietors of Community trade marks.

## **207. Persons who can be proprietors of Community trade marks.**

Any natural or legal person<sup>1</sup>, including authorities established under public law, may be the proprietor of a Community trade mark<sup>2</sup>.

1 As to which bodies constitute legal persons for these purposes see PARA 192 ante. The Office for Harmonisation in the Internal Market apparently considers that an English partnership can own a Community trade mark: see *Byford v Oliver* [2003] EWHC 295 (Ch), [2003] EMLR 416; *Michaels Foodmarket v Drinkstop Ltd* (O/168/05), Appointed Person.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 5 (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). For the meaning of 'Community trade mark' see PARA 206 ante.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(i) Introduction/208. Signs of which a Community trade mark may consist.

**208. Signs of which a Community trade mark may consist.**

A Community trade mark<sup>1</sup> may consist of any signs capable of being represented graphically<sup>2</sup>, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing<sup>3</sup> the goods or services of one undertaking from those of other undertakings<sup>4</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the requirement that the sign is capable of being represented graphically see PARA 57 note 2 ante.

3 As to the requirement that signs are capable of distinguishing goods or services of one undertaking from other undertakings see PARA 57 note 3 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 4. Signs which do not satisfy the requirements of art 4 may not be registered: see art 7(1)(a); and PARA 210 post.

**UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/209. In general.

## **(ii) Absolute Grounds for Refusal of Registration**

### **209. In general.**

The absolute grounds for refusal of registration<sup>1</sup> of a Community trade mark<sup>2</sup> prohibit registration notwithstanding that the grounds of non-registrability<sup>3</sup> obtain in only a part of the Community<sup>4</sup>.

1    le those set out in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1). As to the absolute grounds generally see PARA 58 ante.

2    For the meaning of 'Community trade mark' see PARA 206 ante.

3    As to the grounds of non-registrability see PARA 210 et seq post.

4    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(2); Case T-91/99 *Ford Motor Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2000] ECR II-1925, [2000] 2 CMLR 276, CFI. Thus it is sufficient to render a trade mark ineligible for registration that the trade mark is descriptive (see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(1)(c); and PARA 211 post) or otherwise devoid of distinctive character (see art 7(1)(b); and PARA 211 post) in the language of one member state: Case C-383/99P *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] Ch 82, [2001] ECR I-6251, [2002] All ER (EC) 29, ECJ. Similarly a trade mark may be ineligible for registration on relative grounds (see PARA 218 et seq post) due to the existence of an conflicting earlier trade mark or right in one member state: see Case R 415/1999-1 *Goldshield Group plc v Unilever plc* (12 September 2000, unreported), OHIM Board of Appeal. For the meaning of 'earlier trade mark' see PARA 218 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/210. Signs which cannot constitute trade marks.

## **210. Signs which cannot constitute trade marks.**

Signs which do not satisfy the requirements as to what a Community trade mark<sup>1</sup> may consist of<sup>2</sup> must not be registered<sup>3</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 The signs which do not satisfy the requirements of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 4: see PARA 208 ante.

3 Ibid art 7(1)(a). As to the meaning of 'registered' in this context see PARA 283 note 5 post.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/211. Lack of distinctive character.

## **211. Lack of distinctive character.**

The following must not be registered<sup>1</sup> as Community trade marks<sup>2</sup>:

- 316 (1) trade marks<sup>3</sup> which are devoid of any distinctive character<sup>4</sup>;
- 317 (2) trade marks which consist exclusively of signs or indications which may serve, in trade<sup>5</sup>, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services<sup>6</sup>;
- 318 (3) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade<sup>7</sup>.

However, these prohibitions do not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it<sup>8</sup>.

1 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 As to the meaning of 'trade mark' in this context see PARA 206 note 1 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(b). As to the meaning of 'devoid of distinctive character' see PARA 60 note 3 ante.

5 For the purposes of the equivalent provision in the Trade Marks Act 1994, 'trade' includes any business or profession: see s 103(1); and PARA 60 note 4 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(1)(c). As to the meaning of this provision see further PARA 60 note 5 ante. A Community collective mark which consists of signs or indications which may designate the geographical origin of goods or services may, however, be registered: see art 64(2); and PARA 296 post. As to Community collective marks see PARAS 295-301 post.

7 Ibid art 7(1)(d). As to the meaning of this provision see further PARA 60 note 6 ante.

8 Ibid art 7(3). As to distinctive character acquired as a result of use see PARA 61 ante. Such distinctive character through use must be acquired in the part of the Community in which the trade mark is devoid of distinctive character: Case T-91/99 *Ford Motor Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2000] ECR II-1925, [2000] 2 CMLR 276, CFI; Case C-108/05 *Bovemij Verzekeringen NV v Benelux-Merkenbureau* [2007] ETMR 29, [2006] All ER (D) 46 (Sep), ECJ. It is not necessary to consider whether the mark has acquired a distinctive character, however, unless the applicant or proprietor has invoked EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(3): Case C-136/02P *Mag Instrument Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-9165, [2004] All ER (D) 75 (Oct), ECJ. An applicant may, however, invoke EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(3) on appeal to the Board of Appeal even if he has not done so at first instance: Case T-163/98 *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [1999] ECR II-2383, [1999] All ER (EC) 648, CFI; revsd on other grounds Case C-383/99P *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] Ch 82, [2001] ECR I-6251, [2002] All ER (EC) 29, ECJ. As to appeals to the Board of Appeal see PARAS 291-293 post.

## **UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

**211 Lack of distinctive character**

NOTE 4--Where a three-dimensional mark is constituted by the shape of the product for which registration is sought, the mere fact that that shape is a variant of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Regulation 40/94 art 7(1)(b): Case T-28/08 *Mars, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2009] All ER (D) 127 (Jul), CFI. See also *Pioneer Hi-Bred International Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2009] IP & T 485.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/212. Shape.

## **212. Shape.**

A sign must not be registered as a Community trade mark<sup>1</sup>, if it consists exclusively of<sup>2</sup>:

- 319 (1) the shape which results from the nature of the goods<sup>3</sup> themselves<sup>4</sup>;
- 320 (2) the shape of goods which is necessary to obtain a technical result<sup>5</sup>; or
- 321 (3) the shape which gives substantial value to the goods<sup>6</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(e). As to the purpose of these provisions see PARA 62 note 2 ante. As to the meaning of 'registered' in this context see PARA 283 note 5 post.

3 As to the goods to be considered see PARA 62 note 3 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(1)(e)(i). As to the meaning of this provision see further PARA 62 note 3 ante.

5 Ibid art 7(1)(e)(ii). As to the meaning of this provision see further PARA 62 note 4 ante.

6 Ibid art 7(1)(e)(iii). As to the meaning of this provision see further PARA 62 note 5 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

## **212 Shape**

NOTES--See Case T-28/08 *Mars, Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2009] All ER (D) 127 (Jul), CFI; and PARA 211 NOTE 4.

NOTE 5--See Case T-270/06 *Lego Juris A/S v Office of Harmonisation in the Internal Market (Trade Marks and Designs)* [2009] IP & T 383, CFI (registration of sign as trade mark was invalid as it consisted exclusively of shape of goods which is necessary to obtain technical result).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/213. Public policy; immoral trade marks.

**213. Public policy; immoral trade marks.**

A Community trade mark<sup>1</sup> must not be registered<sup>2</sup> if it is contrary to public policy<sup>3</sup> or to accepted principles of morality<sup>4</sup>.

1 As to the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

3 As to the meaning of 'public policy' see PARA 63 note 3 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(f). As to the meaning of this provision see further PARA 63 note 4 ante.

**UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/214. Deceptive trade marks.

#### **214. Deceptive trade marks.**

A Community trade mark<sup>1</sup> must not be registered<sup>2</sup> if it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service<sup>3</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(g). As to the meaning of this provision see further PARA 64 note 3 ante.

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/215. State emblems etc protected under the Paris Convention.

## **215. State emblems etc protected under the Paris Convention.**

The Paris Convention<sup>1</sup> contains provisions prohibiting the registration of certain specially protected signs, which are incorporated by reference into the Community Trade Mark Regulation<sup>2</sup>.

Under the Paris Convention, the signatories must:

- 322 (1) refuse or invalidate the registration, without authorisation of the competent authorities, either as trade marks or elements of trade marks, of armorial bearings, flags and other state emblems, of signatories to the Convention, official signs and hallmarks indicating control and warranty adopted by them<sup>3</sup>, and any imitation from a heraldic point of view<sup>4</sup>;
- 323 (2) refuse or invalidate the registration, either as trade marks or elements of trade marks, of armorial bearings, flags and other emblems, abbreviations and names of international intergovernmental organisations of which one or more signatories to the Convention are members, with the exception of armorial bearings, flags and other emblems, abbreviations and names that are already the subject of international agreements in force, intended to ensure their protection<sup>5</sup>.

In the case of state flags, the prohibition under head (1) above applies solely to marks registered after 6 November 1925<sup>6</sup>. In the case of all other signs under heads (1) and (2) above, the prohibition applies only to marks registered two or more months after receipt of a communication<sup>7</sup> that the signatory or international intergovernmental organisation wishes, wholly or within certain limits, to place the sign within the protection provided for by heads (1) and (2) above<sup>8</sup>.

The above is subject to the provision that, in cases of bad faith, the signatories have the right to cancel even those marks incorporating state emblems, signs and hallmarks which were registered before 6 November 1925<sup>9</sup>.

1 As to the Paris Convention see PARA 6 ante.

2 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(h), (i) (see PARA 216 post), which incorporates by reference the provisions of the Paris Convention art 6 (ter). As to the manner in which the United Kingdom has incorporated these provision into domestic law see the Trade Marks Act 1994 s 56 (as amended); and PARA 153 ante.

3 Prohibition of the use (and, presumably, registration as a trade mark) of official signs and hallmarks indicating control and warranty apply solely in cases where the marks in which they are incorporated are intended to be used on goods of the same or similar kind: Paris Convention art 6 (ter) (2).

4 Ibid art 6 (ter) (1)(a).

5 Ibid art 6 (ter) (1)(b). Signatories to the Convention are not required to apply this provision: (1) to the prejudice of owners of rights acquired in good faith before the entry into force, in that country, of the Convention; or (2) when the registration is not of such a nature as to suggest to the public that a connection exists between the organisation concerned and the armorial bearings, flags, emblems, abbreviations and names, or if such registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organisation: art 6 (ter) (1)(c).

6 Ibid art 6 (ter) (5).

7 le in accordance with ibid art 6 (ter) (3).

8 Ibid art 6 (ter) (6).

9 Ibid art 6 (ter) (7).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/216. Prohibition on registration of state emblems etc as Community trade marks.

## **216. Prohibition on registration of state emblems etc as Community trade marks.**

The following must not be registered<sup>1</sup> as Community trade marks<sup>2</sup>:

- 324 (1) trade marks which have not been authorised by the competent authorities and are to be refused pursuant to the Paris Convention<sup>3</sup>; or
- 325 (2) trade marks which include badges, emblems or escutcheons other than those covered by head (1) above and which are of particular public interest, unless the consent of the appropriate authorities to their registration has been given<sup>4</sup>.

1 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

2 As to the meaning of 'Community trade mark' see PARA 206 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(h). The text refers to refusal pursuant to the Paris Convention art 6 (ter); see PARA 215 ante. As to the Paris Convention see PARA 6 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(1)(i).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(ii) Absolute Grounds for Refusal of Registration/217. Geographical indications and designations of origin.

## **217. Geographical indications and designations of origin.**

The following must not be registered<sup>1</sup> as Community trade marks<sup>2</sup>:

- 326 (1) trade marks for wines which contain or consist of a geographical indication identifying wines, or for spirits which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin<sup>3</sup>;
- 327 (2) trade marks which contain or consist of a protected designation of origin or a protected geographical indication<sup>4</sup> when they correspond to one of the protected situations<sup>5</sup> and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing of the application for registration of the designation of origin or geographical indication<sup>6</sup>.

1 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

2 As to the meaning of 'Community trade mark' see PARA 206 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(j) (added by EC Council Regulation 3288/94 (OJ L349, 31.12.94, p 83)). This provision was added in order to give effect to the Agreement on Trade-Related Aspects of Intellectual Property Rights ('TRIPs') (1994) (Cm 2557) art 23(2): see EC Council Regulation 3288/94 (OJ L349, 31.12.94, p 83), 4th recital. As to TRIPs see PARA 7 ante.

4 I.e. registered in accordance with EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12) on the protection of geographical indications and designations of origin for agricultural products and foodstuff. See further PARA 302 et seq post.

5 I.e. under EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12) art 13.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(1)(k) (added by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1); and amended by virtue of EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12)).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(iii) Relative Grounds for Refusal of Registration/218. Meaning of 'earlier trade mark'.

### (iii) Relative Grounds for Refusal of Registration

#### 218. Meaning of 'earlier trade mark'.

For the purposes of the registration of a Community trade mark<sup>1</sup>, an 'earlier trade mark' means:

- 328 (1) a Community trade mark, a trade mark registered in a member state, or at the Benelux Trade Mark Office or a trade mark registered under international arrangements which have effect either in a member state or in the Community<sup>2</sup>, provided the mark has a date of application for registration<sup>3</sup> which is earlier than the date of registration of the Community trade mark, taking account (where appropriate) of the priorities<sup>4</sup> claimed in respect of those trade marks<sup>5</sup>;
- 329 (2) applications for the trade marks referred to in head (1) above, subject to their registration<sup>6</sup>; and
- 330 (3) trade marks which, at the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known<sup>7</sup> in a member state<sup>8</sup>.

Most of the relative grounds for refusal of registration<sup>9</sup> depend upon the existence of an earlier trade mark<sup>10</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 I.e. under the Madrid Agreement or Madrid Protocol: see PARA 8 ante.

3 The date of application of the registration is the date of filing the application. As to the date of filing an application for a Community trade mark see PARA 278 note 23 post.

4 As to claims to priority of other applications see PARA 284 et seq post.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 8(2)(a) (amended by EC Council Regulation 1992/2003 (OJ L296, 14.11.03, p 1)). A national trade mark resulting from conversion of a Community trade mark application during the course of opposition does not constitute an 'earlier trade mark': Case R 286/2002-3 *SFI Group plc v Sandhu* (12 June 2003, unreported), OHIM Board of Appeal.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(2)(b).

7 I.e. well known within the meaning of the Paris Convention art 6 (bis). See further PARA 153 ante. As to the Paris Convention see PARA 6 ante.

8 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(2)(c).

9 See PARA 219 et seq post.

10 If the earlier trade mark expires during the course of opposition proceedings it can no longer be relied upon: Case T-191/04 *MIP Metro Group Intellectual Property GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] All ER (D) 57 (Sep), CFI. Cf the position under the Trade Marks Act 1994 s 6 (as amended): see PARA 70 note 19 ante.

#### UPDATE

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(iii) Relative Grounds for Refusal of Registration/219. Identical earlier mark for identical goods or services.

## **219. Identical earlier mark for identical goods or services.**

Upon opposition<sup>1</sup> by the proprietor of an earlier trade mark<sup>2</sup>, a trade mark must not be registered<sup>3</sup>, if it is identical<sup>4</sup> with the earlier trade mark and the goods or services for which registration is applied for are identical<sup>5</sup> with the goods or services for which the earlier trade mark is protected<sup>6</sup>.

1 As to opposing an application for registration of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 42-43; and PARA 282 post.

2 For the meaning of 'earlier trade mark' see PARA 218 ante.

3 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

4 As to the meaning of 'identical' in this context see PARA 71 note 3 ante.

5 As to the meaning of 'identical' in this context see PARA 71 note 5 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(1)(a). Cf the corresponding infringement provisions: see art 9(1)(a); and PARA 226 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(iii) Relative Grounds for Refusal of Registration/220. Identical earlier mark and similar goods or services; similar earlier mark and identical or similar goods or services.

**220. Identical earlier mark and similar goods or services; similar earlier mark and identical or similar goods or services.**

Upon opposition<sup>1</sup> by the proprietor of an earlier trade mark<sup>2</sup>, a trade mark must not be registered<sup>3</sup>, if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services<sup>4</sup> covered by the trade mark there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected<sup>5</sup>. The likelihood of confusion includes the likelihood of association with the earlier trade mark<sup>6</sup>.

1 As to opposing an application for registration of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 42-43; and PARA 282 post.

2 For the meaning of 'earlier trade mark' see PARA 218 ante.

3 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

4 As to the meaning of 'similarity of the goods or services' see PARA 73 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(1)(b). As to the likelihood of confusion see PARA 74 ante.

6 Ibid art 8(1)(b). See also PARA 74 ante.

**UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(iii) Relative Grounds for Refusal of Registration/221. Identical or similar mark for dissimilar goods or services.

**221. Identical or similar mark for dissimilar goods or services.**

Upon opposition<sup>1</sup> by the proprietor of an earlier trade mark<sup>2</sup>, a trade mark must not be registered<sup>3</sup> where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar<sup>4</sup> to those for which the earlier trade mark is registered, where:

331 (1) in the case of an earlier Community trade mark<sup>5</sup>, the trade mark has a reputation<sup>6</sup> in the Community; or

332 (2) in the case of an earlier national trade mark<sup>7</sup>, the trade mark has a reputation in the member state concerned,

and the use of a trade mark applied for without due cause<sup>8</sup> would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark<sup>9</sup>.

1 As to opposing an application for registration of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 42-43; and PARA 282 post.

2 For the meaning of 'earlier trade mark' see PARA 218 ante.

3 As to the meaning of 'registered' in this context see PARA 283 note 5 post.

4 This ground of objection can be invoked when the goods or services are identical or similar as well as when they are dissimilar: see PARA 75 note 10 ante.

5 For the meaning of 'Community trade mark' see PARA 206 ante.

6 As to the meaning of 'reputation' see PARA 75 note 7 ante.

7 I.e. those trade marks (and applications for trade marks), other than Community trade marks, which are specified by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(2). See PARA 218 head (1) ante.

8 As to the meaning of 'without due cause' see PARA 75 note 9 ante.

9 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(5). As to the tests of unfair advantage and detriment see PARA 76 ante.

**UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(iii) Relative Grounds for Refusal of Registration/222. Refusal by virtue of an earlier right.

## 222. Refusal by virtue of an earlier right.

Upon opposition<sup>1</sup> by the proprietor<sup>2</sup> of a non-registered trade mark<sup>3</sup> or of another sign<sup>4</sup> used in the course of trade of more than mere local significance<sup>5</sup>, a trade mark must not be registered as a Community trade mark<sup>6</sup> where and to the extent that, pursuant to the Community legislation or the law of the member state governing that sign<sup>7</sup>:

333 (1) rights to the sign were acquired prior to the date of application for registration of the Community trade mark, or the date of priority<sup>8</sup> claimed for the application for registration of the Community trade mark<sup>9</sup>; and

334 (2) that sign confers on its proprietor the right to prohibit the use<sup>10</sup> of a subsequent trade mark<sup>11</sup>.

1 As to opposing an application for registration of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 42-43; and PARA 282 post.

2 'Proprietor' is not defined for the purposes of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1). In this context, it presumably means a person who is recognised by law as owning a right in respect of the trade mark, such as a right in passing off. As to ownership of goodwill at common law see PARA 313 post.

3 'Non-registered mark' is not defined for the purposes of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1). It would presumably include a trade mark protected by the law of passing off, even though, strictly speaking, the right protected by passing off is not a right in a non-registered trade mark, but in the goodwill of a business. See further PARA 306 post.

4 An appellation of origin is a sign used in the course of trade within EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(4); Decisions 1645/01-1647/01 and 1645/2001 *Budejovicky Budvar NP v Anheuser-Busch Inc* (OJ OHIM 12/01 p 2335), OHIM Opposition Division; affd on other grounds Cases R 820/2001-2-R 822/2001-2 and R 921/2001-2 *Budejovicky Budvar NP v Anheuser-Busch Inc* (3 December 2003, unreported), OHIM Board of Appeal. It is presumed that the same would apply to protected designations of origin and protected geographical indications (see PARA 302 post). Rights to a name or likeness in the nature of copyrights or personality rights cannot be relied upon under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(4) but must be invoked under art 52(2) (see PARA 245 post): Decision 506/2000 *EinStein Stadtcafé Verwaltungs- und Betriebsgesellschaft mbH's Application, Opposition of Hebrew University of Jerusalem* [2000] ETMR 952, OHIM Opposition Division.

5 Whether a sign is of 'more than mere local significance' does not depend on geographical criteria alone but also upon considerations such as the intensity of marketing and the size of the population concerned: Decision 2149/2000 *McCann-Erickson Advertising Ltd's Application* [2001] ETMR 52, OHIM Opposition Division; Decision 572C/002386126/1 *Garware Polyester Ltd v Coveme SpA* (10 November 2004, unreported), OHIM Cancellation Division. Cf *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch), [2004] RPC 809, [2004] 17 LS Gaz R 32 (holding that a mark should be considered as having mere local significance if its geographical spread is restricted to substantially less than the whole of the European Union and, from the perspective of the Community market in the services or goods in question, the mark is of little significance; Decision 2149/2000 *McCann-Erickson Advertising Ltd's Application* supra and other OHIM decisions to similar effect were not cited).

6 For the meaning of 'Community trade mark' see PARA 206 ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(4) (amended by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

8 As to priority see PARA 284 post.

9 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(4)(a).

10 'Use' in this context presumably means use in relation to the goods or services for which the application for the Community trade mark is made.

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(4)(b). As to passing off see PARA 304 et seq post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(3) REQUIREMENTS FOR REGISTRATION/(iii) Relative Grounds for Refusal of Registration/223. Attempts by agent or representative to register trade mark.

### **223. Attempts by agent or representative to register trade mark.**

Upon opposition<sup>1</sup> by the proprietor<sup>2</sup> of the trade mark, a Community trade mark<sup>3</sup> must not be registered<sup>4</sup> where an agent or representative<sup>5</sup> of the proprietor of the trade mark applies for registration of it in his own name without the proprietor's consent<sup>6</sup>, unless the agent justifies his action<sup>7</sup>.

<sup>1</sup> As to opposing an application for registration of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 42-43; and PARA 282 post.

<sup>2</sup> As to the meaning of 'the proprietor' see PARA 222 note 2 ante.

<sup>3</sup> For the meaning of 'Community trade mark' see PARA 206 ante.

<sup>4</sup> As to the meaning of 'registered' in this context see PARA 283 note 5 post.

<sup>5</sup> As to the meaning of 'agent or representative' see PARA 154 note 3 ante.

<sup>6</sup> Such consent must be clear, specific and unconditional and must be valid on the day of application for registration: Case T-6/05 *DEF-TEC Defense Technology GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] All ER (D) 23 (Sep), CFI.

<sup>7</sup> EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(3). This implements the Paris Convention art 6 (septies) (1). As to the Paris Convention see PARA 6 ante. As to justification see PARA 154 note 15 ante.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/224. Rights conferred by registered trade mark.

## **(4) EFFECTS OF COMMUNITY TRADE MARKS**

### **224. Rights conferred by registered trade mark.**

A Community trade mark<sup>1</sup> confers on the proprietor exclusive rights in it<sup>2</sup>. These rights are expressed as giving the proprietor the right to prevent all third parties not having his consent from doing certain acts<sup>3</sup>.

The effects of Community trade marks are governed solely by Community legislation<sup>4</sup>; but in other respects, infringement of a Community trade mark is governed by the national law relating to infringement<sup>5</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 9(1).

3 Ibid art 9(1). Although the acts set out in art 9(1) are not expressly described as amounting to an infringement of the Community trade mark, elsewhere the term infringement is often used interchangeably with a reference to the effects of a Community trade mark.

As to infringement by use of a trade mark outside the jurisdiction see PARA 84 note 3 ante; and for the meaning of references to doing anything with or without the consent of the proprietor of a registered trade mark see PARA 276 note 4 post.

4 Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

5 Ibid art 14(1). As to the bringing of an action for infringement see PARA 257 et seq post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/225. Date from which right runs.

## **225. Date from which right runs.**

The rights conferred by a Community trade mark<sup>1</sup> prevail against third parties from the date of publication of registration of the trade mark<sup>2</sup>.

However, reasonable compensation may be claimed in respect of matters arising after the date of publication of a Community trade mark application, which would, after publication of the registration of the trade mark, be prohibited<sup>3</sup> by virtue of the publication<sup>4</sup>.

<sup>1</sup> For the meaning of 'Community trade mark' see PARA 206 ante.

<sup>2</sup> EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 9(3). As to the publication of registration of a trade mark as a Community trade mark see PARA 190 ante.

<sup>3</sup> I.e. the acts which the proprietor is or would be entitled to prevent under *ibid* arts 9(1), 11: see PARA 226 et seq post.

<sup>4</sup> *Ibid* art 9(3). The court seized of the case may not decide on the merits until after the registration has been published: art 9(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/226. Identical mark for identical goods or services.

## **226. Identical mark for identical goods or services.**

The proprietor of a Community trade mark<sup>1</sup> is entitled to prevent third parties not having his consent from using<sup>2</sup> in the course of trade<sup>3</sup> a sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered<sup>4</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the meaning of 'use' see PARA 229 post.

3 'Trade' is not defined for the purposes of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark. For the definition of 'trade' given in respect of the corresponding provision in the Trade Marks Act 1994 see PARA 60 note 4 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 9(1)(a). As to the corresponding relative ground of refusal see art 8(1)(a); and PARA 219 ante. As to the limits on the effect of a Community trade mark see PARAS 232-233 post; and as to the exhaustion of rights conferred by a Community trade mark see PARA 234 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/227. Identical mark for similar goods or services; similar mark for identical goods or services.

**227. Identical mark for similar goods or services; similar mark for identical goods or services.**

The proprietor of a Community trade mark<sup>1</sup> is entitled to prevent third parties not having his consent from using<sup>2</sup> in the course of trade<sup>3</sup> any sign where because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services<sup>4</sup> covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public. The likelihood of confusion includes the likelihood of association between the sign and the trade mark<sup>5</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the meaning of 'use' see PARA 229 post.

3 As to the meaning of 'trade' see PARA 226 note 3 ante.

4 As to 'similarity of the goods or services' see PARA 73 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 9(1)(b). As to the corresponding relative ground for refusal of registration see art 8(1)(b); and PARA 220 ante. As to the likelihood of confusion see PARA 74 ante; as to the limits on the effect of a Community trade mark see PARAS 232-233 post; and as to the exhaustion of rights conferred by a Community trade mark see PARA 234 post.

**UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/228. Identical or similar mark for dissimilar goods or services.

## **228. Identical or similar mark for dissimilar goods or services.**

The proprietor of a Community trade mark<sup>1</sup> is entitled to prevent third parties not having his consent from using<sup>2</sup> in the course of trade<sup>3</sup> any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar<sup>4</sup> to those for which the Community trade mark is registered, where the latter has a reputation in the Community<sup>5</sup> and where the use of that sign without due cause<sup>6</sup> takes unfair advantage of, or is detrimental to, the distinctive character or repute of the Community trade mark<sup>7</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the meaning of 'use' see PARA 229 post.

3 As to the meaning of 'trade' see PARA 226 note 3 ante.

4 This ground of objection can be invoked when the goods or services are identical or similar as well as when they are dissimilar: see PARA 88 note 7 ante.

5 As to the meaning of 'reputation' see PARA 75 note 7 ante.

6 As to the concept of use without due cause see PARA 75 note 9 ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 9(1)(c). Cf the corresponding relative ground for refusal of registration: see art 8(5); and PARA 221 ante. As to the concept of unfair advantage or detriment to the distinctive character or repute of the Community trade mark see PARA 76 ante.

As to the limits on the effect of a Community trade mark see PARAS 232-233 post; and as to the exhaustion of rights conferred by a Community trade mark see PARA 234 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/229. Meaning of 'use' for the purposes of infringement.

## **229. Meaning of 'use' for the purposes of infringement.**

The following may be prohibited as infringing<sup>1</sup> a Community trade mark<sup>2</sup>:

- 335 (1) affixing the sign<sup>3</sup> to the goods or the packaging thereof<sup>4</sup>;
- 336 (2) offering the goods, putting them on the market or stocking them for those purposes under that sign, or offering or supplying services thereunder<sup>5</sup>;
- 337 (3) importing or exporting goods<sup>6</sup> under that sign<sup>7</sup>; or
- 338 (4) using the sign on business<sup>8</sup> papers<sup>9</sup> and in advertising<sup>10</sup>.

1    Is prohibited under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 9(1): see PARAS 224-228 ante. As to whether use must be trade mark use see PARA 89 note 2 ante.

2    For the meaning of 'Community trade mark' see PARA 206 ante. As to the limits on the effect of a Community trade mark see PARAS 232-233 post; and as to the exhaustion of rights conferred by a Community trade mark see PARA 234 post.

3    Is the sign which the proprietor is entitled to prohibit others from using pursuant to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 9(1). As to the manner in which the sign is used see PARA 89 note 2 ante.

4    Ibid art 9(2)(a). As to where the sign is applied to the goods or packaging outside the jurisdiction see PARA 89 note 3 ante.

5    Ibid art 9(2)(b). As to offering and putting goods on the market see PARA 89 note 4 ante.

6    As to importing or exporting goods see PARA 89 note 5 ante.

7    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 9(2)(c).

8    'Business' is not defined for the purposes of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1). Cf the definition provided by the Trade Marks Act 1994: see PARA 32 note 3 ante.

9    See PARA 89 note 9 ante.

10   EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 9(2)(d).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/230. Reproduction of Community trade marks in dictionaries.

### **230. Reproduction of Community trade marks in dictionaries.**

If the reproduction of a Community trade mark<sup>1</sup> in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work must, at the request of the proprietor of the Community trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark<sup>2</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 10. The conventional method of indicating that a mark is a registered trade mark is by the use of the ® sign in relation to it.

The proprietor of a Community trade mark who does not enforce his rights under this provision risks his trade mark becoming the common name in the trade for the product or service in respect of which it is registered. If this happens, the mark may become liable to revocation pursuant to art 50(1)(b) on the grounds that this has occurred in consequence of his inactivity. See further PARA 239 post.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/231. Community trade mark registered in the name of an agent or representative.

**231. Community trade mark registered in the name of an agent or representative.**

Where a Community trade mark<sup>1</sup> is registered in the name of the agent or representative of a person who is the proprietor<sup>2</sup> of that trade mark, without the proprietor's authorisation, the proprietor is entitled:

339 (1) to oppose<sup>3</sup> the use<sup>4</sup> of his mark by his agent or representative if he has not authorised such use; and

340 (2) to demand the assignment in his favour of the registration of the Community trade mark,

unless the agent or representative justifies his action<sup>5</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 It is presumed that 'proprietor' in this context has the same meaning as in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 8(3) (see PARAS 222 note 2, 223 ante), since that provision and these provisions are both derived from the Paris Convention art 6 (septies). As to the Paris Convention see PARA 6 ante.

3 It is presumed that 'oppose' in this context means that the proprietor of the trade mark is entitled to restrain the use of the trade mark by injunction. Cf the corresponding provisions under the Trade Marks Act 1994 s 60(4): see PARA 154 ante.

4 As to the meaning of 'use' see PARA 229 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 11, 18. Head (2) in the text also applies to applications for Community trade marks: art 24. See also note 2 supra.

**UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/232. Limitation of the effects of a Community trade mark.

## **232. Limitation of the effects of a Community trade mark.**

A Community trade mark<sup>1</sup> does not entitle the proprietor to prohibit a third party from using<sup>2</sup> in the course of trade<sup>3</sup>:

- 341 (1) his own name<sup>4</sup> or address<sup>5</sup>;
- 342 (2) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristics of the goods or service<sup>6</sup>; or
- 343 (3) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts<sup>7</sup>,

provided he uses them in accordance with honest practices in industrial or commercial matters<sup>8</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the meaning of 'use' see PARA 229 ante.

3 As to the meaning of 'trade' see PARA 226 note 3 ante.

4 As to what constitutes a person's 'own name' and whether this defence is available to corporations see PARA 93 notes 3, 4 ante.

5 See PARA 93 note 5 ante.

6 See PARA 94 note 3 ante.

7 See PARA 95 ante.

8 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 12. As to the meaning of 'honest practices' see PARA 96 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/233. Acquiescence.

### 233. Acquiescence.

Where the proprietor of a Community trade mark<sup>1</sup> has acquiesced<sup>2</sup>, for a period of five successive years, in the use<sup>3</sup> of a later Community trade mark in the Community while being aware of such use, he<sup>4</sup> is no longer entitled on the basis of the earlier trade mark either:

- 344 (1) to apply for a declaration that the registration of the later trade mark is invalid; or
- 345 (2) to oppose<sup>5</sup> the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith<sup>6</sup>.

Where the proprietor of an earlier national trade mark<sup>7</sup> or other earlier sign<sup>8</sup> has acquiesced, for a continuous period of five successive years,<sup>9</sup> in the use of a later Community trade mark in the member state in which the earlier trade mark or other earlier sign is protected while being aware of such use, he<sup>10</sup> is no longer entitled on the basis of the earlier trade mark either:

- 346 (a) to apply for a declaration that the registration of the later trade mark is invalid; or
- 347 (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith<sup>11</sup>.

In any such case<sup>12</sup>, the proprietor of a later Community trade mark is not entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later Community trade mark<sup>13</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 It is not clear where, in the scale commencing with merely standing by with knowledge to some form of positive inducement, the word 'acquiesce' comes. Given the context of the use of the word in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, it is unlikely that it would be interpreted in the technical sense given to it by English case law.

3 As to the meaning of 'use' see PARA 229 ante.

4 It is not clear whether a third party would be prevented from applying for a declaration that the registration of the later trade mark is invalid by reason of this provision. It would be odd if the proprietor of the earlier trade mark or sign were so prevented but third parties were not, yet there is no explicit provision for this. Cf the Trade Marks Act 1994 s 48: see PARA 99 ante.

5 As to the meaning of 'oppose' see PARA 231 note 3 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 53(1). As to the meaning of 'bad faith' see PARA 69 note 3 ante.

7 Ie an 'earlier trade mark' within the meaning of ibid art 8(2) (as amended), other than a Community trade mark: see PARA 218 ante.

8 Ie an earlier sign within the meaning of ibid art 8(4): see PARA 222 ante.

9 The five year period runs from the date on which the Community trade mark is registered, and thus does not expire until the end of the fifth anniversary day: Decision 1067C/000852913/1 *Michel Bugatti SA v Bugatti International SA* (11 May 2006, unreported), OHIM Cancellation Division.

10 See note 4 supra.

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 53(2).

12 In the cases referred to in *ibid* art 53(1), (2): see the text and notes 1-11 supra.

13 *Ibid* art 53(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(4) EFFECTS OF COMMUNITY TRADE MARKS/234. Exhaustion of rights.

### **234. Exhaustion of rights.**

A Community trade mark<sup>1</sup> does not entitle the proprietor to prohibit its use<sup>2</sup> in relation to goods which have been put on the market in the Community under that trade mark by the proprietor or with his consent<sup>3</sup>; but this provision does not apply where there exist legitimate reasons<sup>4</sup> for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market<sup>5</sup>.

Quite apart from this, the proprietor's right to enforce a Community trade mark may be restricted in some circumstances by the general rules under the EC Treaty<sup>6</sup> relating to free movement of goods and competition law<sup>7</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the meaning 'use' see PARA 229 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 13(1). The wording and, presumably, effect of this provision are identical to the Trade Marks Act 1994 s 12(1): see PARA 103 ante. As to what may amount to the proprietor's consent see PARA 107 ante.

4 As to what may amount to 'legitimate reasons' see PARA 104 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 13(2). The wording and, presumably, effect of this provision are identical to the Trade Marks Act 1994 s 12(2): see PARA 103 ante.

6 I.e. the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179).

7 See PARAS 105-106 ante. The specific exhaustion defences under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) and EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, do not necessarily cover all the ground covered by the case law of the ECJ interpreting the EC Treaty: see PARA 105 note 5 ante.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(i) Introduction/235. Modes of extinction or modification of Community trade marks.

## **(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION**

### **(i) Introduction**

#### **235. Modes of extinction or modification of Community trade marks.**

The Community Trade Mark Regulation<sup>1</sup> provides a number of ways in which the rights conferred by a Community trade mark<sup>2</sup> may be cancelled or varied<sup>3</sup>. It uses the following terminology:

- 348 (1) 'surrender' for voluntary surrender by the proprietor<sup>4</sup>;
- 349 (2) 'revocation' for removal of a registration on grounds which have arisen since registration<sup>5</sup>;
- 350 (3) 'declaration of invalidity' for cases where the mark ought not to have been registered originally<sup>6</sup>;
- 351 (4) 'alteration' for minor corrections<sup>7</sup>; and
- 352 (5) 'division' for splitting a registration into two or more registrations<sup>8</sup>.

1    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    For the meaning of 'Community trade mark' see PARA 206 ante.

3    Ie apart from lapse for failure to pay renewal fees: see PARA 283 post. Cf the position under the Trade Marks Act 1994: see PARA 109 ante.

4    See PARA 236 post.

5    See PARA 237 et seq post.

6    See PARA 243 et seq post.

7    See PARA 248 post.

8    See PARA 249 post.

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(ii) Surrender/236. In general.

## **(ii) Surrender**

### **236. In general.**

A Community trade mark<sup>1</sup> may be surrendered in respect of some or all of the goods or services for which it is registered<sup>2</sup>. Surrender can be entered only with the agreement of the proprietor of a right entered in the register<sup>3</sup>.

The surrender must be declared to the Office for Harmonisation in the Internal Market in writing by the proprietor of the trade mark and does not have effect until it has been entered into the register<sup>4</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 49(1). As to the procedure for surrender see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 36 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 49(3). If a licence has been registered, surrender can only be entered in the register if the proprietor of the trade mark proves that he has informed the licensee of his intention to surrender; this entry must be made on expiry of three months after the date on which the proprietor satisfies the Office for Harmonisation in the Internal Market that he has informed the licensee of his intention to surrender the Community trade mark: art 49(3); EC Commission Regulation 2868/95 (OJ L303, 15.12.95) art 1 r 36(2). As to the Office see PARA 180 et seq ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 49(2). If the proprietor applies to surrender a Community trade mark which is subject to an application for revocation or a declaration of invalidity the proceedings must continue: Decision 69C/000670042/1 *Lancôme Parfums et Beauté & Cie's Application* [2001] ETMR 89, OHIM Cancellation Division. Cf the position under the Trade Marks Act 1994 s 45: see PARA 113 note 5 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iii) Revocation/237. Use of Community trade marks.

### **(iii) Revocation**

#### **237. Use of Community trade marks.**

If, within the period of five years following registration<sup>1</sup> the proprietor has not put the Community trade mark<sup>2</sup> to genuine<sup>3</sup> use<sup>4</sup> in the Community<sup>5</sup>, in connection with the goods or services for which it is registered, or if such use has been suspended for an uninterrupted period of five years, the Community trade mark is subject to the sanctions provided for<sup>6</sup>, unless there are proper reasons<sup>7</sup> for non-use<sup>8</sup>.

1 As to registration of a Community trade mark see PARA 283 note 5 post.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 As to genuine use see PARA 114 note 6 ante.

4 The following constitute use for these purposes: (1) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered; and (2) affixing the Community trade mark to goods or to the packaging of goods in the Community solely for export purposes: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 15(2). See also PARA 114 note 7 ante. Use of the Community trade mark with the consent of the proprietor is deemed to constitute use by the proprietor: art 15(3). For the requirement of use as it applies to Community collective marks see PARA 300 note 1 post; and for the meaning of references to 'use' generally see PARA 229 ante.

5 It is often said that the requirement of genuine use in the Community is satisfied by use in one member state, but it is not clear that this is correct: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 108(2)(a); and PARA 198 text and note 3 ante. It may be questioned whether a Community-wide monopoly should be maintained by use solely in, for example, Malta.

6 Ie by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1): see art 50; and PARA 238 post.

7 As to the meaning of 'proper reasons' see PARA 114 note 10 ante.

8 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 15(1).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iii) Revocation/238. Non-use.

### **238. Non-use.**

The rights of the proprietor of the Community trade mark<sup>1</sup> must<sup>2</sup> be declared to be revoked on application to the Office for Harmonisation in the Internal Market<sup>3</sup> or on the basis of a counterclaim in infringement proceedings<sup>4</sup> if, within a continuous period of five years, the trade mark has not been put to genuine<sup>5</sup> use<sup>6</sup> in the Community<sup>7</sup> in connection with the goods or services for which it is registered, and there are no proper reasons<sup>8</sup> for non-use<sup>9</sup>.

No person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between the expiry of the five-year period and the filing of the application or counterclaim, genuine use of the trade mark has been started or resumed. However, the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use is to be disregarded where preparations for the commencement or resumption occurred only after the proprietor became aware that the application or counterclaim may be filed<sup>10</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 Cf the corresponding provisions of the Trade Marks Act 1994 s 46: see PARAS 111, 114 ante. In that Act, the permissive 'may' is used, but it has been held that there is no discretion not to revoke the mark. In EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 50, the directive 'shall' is used, so it is clear there is no discretion in this provision.

3 As to the Office see PARA 180 et seq ante; and as to bringing an application for revocation in the Office see PARA 289 et seq post.

4 As to the raising of a counterclaim for revocation in infringement proceedings see PARA 261 et seq post.

5 As to genuine use see PARA 114 note 6 ante.

6 As to the meaning of 'use' see PARA 237 note 4 ante. In revocation proceedings for non-use the burden lies on the proprietor of the Community trade mark to prove genuine use within the relevant period or proper reasons for non-use: Decision 686C/000405555/1 *BARRICADE Trade Mark* (17 May 2004, unreported), OHIM Cancellation Division.

7 As to the requirement of genuine use in the Community see PARA 237 note 5 ante.

8 As to the meaning of 'proper reasons' see PARA 114 note 10 ante.

9 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 50(1)(a).

10 Ibid art 50(1)(a).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iii) Revocation/239. Mark becoming common name.

### **239. Mark becoming common name.**

The rights of the proprietor of the Community trade mark<sup>1</sup> must<sup>2</sup> be declared to be revoked on application to the Office for Harmonisation in the Internal Market<sup>3</sup> or on the basis of a counterclaim in infringement proceedings<sup>4</sup> if, in consequence of acts or inactivity<sup>5</sup> of the proprietor, the trade mark has become the common name in the trade<sup>6</sup> for a product or service in respect of which it is registered<sup>7</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 See PARA 238 note 2 ante.

3 As to the Office see PARA 180 et seq ante; and as to bringing an application for revocation in the Office see PARA 289 et seq post.

4 As to the raising of a counterclaim for revocation in infringement proceedings see PARA 261 et seq post.

5 As to the acts or inactivity of the proprietor see PARA 115 notes 3-6 ante. One mode of inactivity would be a failure to take action in relation to the reproduction of a Community trade mark in a dictionary etc: see PARA 230 ante.

6 As to the meaning of 'common name in the trade' see PARA 115 ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 50(1)(b).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iii) Revocation/240. Liability to mislead in consequence of use.

#### **240. Liability to mislead in consequence of use.**

The rights of the proprietor of the Community trade mark<sup>1</sup> must<sup>2</sup> be declared to be revoked on application to the Office for Harmonisation in the Internal Market<sup>3</sup> or on the basis of a counterclaim in infringement proceedings<sup>4</sup> if, in consequence of the use<sup>5</sup> made of it by the proprietor of the trade mark or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services<sup>6</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 See PARA 238 note 2 ante.

3 As to the Office see PARA 180 et seq ante; and as to bringing an application for revocation in the Office see PARA 289 et seq post.

4 As to the raising of a counterclaim for revocation in infringement proceedings see PARA 261 et seq post.

5 As to the requirement for liability that the mark mislead in consequence of the use made of it see PARA 116 note 3 ante. As to the meaning of 'use' see PARA 229 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 50(1)(c). This ground relates to events arising after the registration date of the mark. If the mark was misleading as to its date of registration, it will be liable to be declared invalid pursuant to art 51(1) (as amended) (see PARA 243 post), which includes any of the provisions of art 7 (absolute grounds for refusal: see PARA 209 et seq ante), including, therefore, art 7(1)(g) (mark of such a nature as to deceive the public: see PARA 214 ante). As to the circumstances in which this ground may be invoked see PARA 116 note 5 ante.

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iii) Revocation/241. Partial revocation.

#### **241. Partial revocation.**

Where grounds for revocation<sup>1</sup> exist in respect of only some of the goods or services for which the Community trade mark<sup>2</sup> is registered<sup>3</sup>, the rights of the proprietor must be declared to be revoked in respect of those goods or services only<sup>4</sup>.

1 As to the grounds for revocation see PARAS 237-240 ante; and as to the additional grounds for revocation of a Community collective mark see PARA 300 post.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 As to the meaning of 'registered' see PARA 283 note 5 post.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 50(2). As to narrowing the specification of goods or services in such circumstances see PARA 117 note 4 ante.

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iii) Revocation/242. Date from which revocation takes effect.

## **242. Date from which revocation takes effect.**

A Community trade mark<sup>1</sup> is deemed not to have had, as from the date of the application<sup>2</sup> for revocation<sup>3</sup> or of the counterclaim<sup>4</sup>, the specified effects<sup>5</sup>, to the extent that the rights of the proprietor have been revoked<sup>6</sup>.

An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision<sup>7</sup> at the request of one of the parties<sup>8</sup>.

Subject to certain national provisions<sup>9</sup>, the retroactive effect of revocation of the trade mark does not affect the following<sup>10</sup>:

353 (1) any decision on infringement which has acquired the authority of a final decision and has been enforced prior to the revocation decision<sup>11</sup>; or

354 (2) any contract concluded prior to the revocation decision, in so far as it has been performed before that decision<sup>12</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to applications for revocation in the Office for Harmonisation in the Internal Market see PARA 289 et seq post. As to the Office see PARA 180 et seq ante.

3 As to the grounds for revocation see PARAS 237-240 ante. As to the additional grounds for revocation of a Community collective mark see PARA 300 post.

4 As to the raising of a counterclaim for revocation in infringement proceedings see PARA 261 et seq post.

5 I.e. the effects specified in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

6 Ibid art 54(1).

7 I.e. the decision declaring the rights of the proprietor to be revoked.

8 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 54(1).

9 I.e. national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the proprietor of the trade mark, or unjust enrichment.

10 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 54(3).

11 Ibid art 54(3)(a).

12 Ibid art 54(3)(b). However, repayment, to the extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity: art 54(3)(b).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iv) Declaration of Invalidity/243. Registration granted in breach of absolute grounds for refusal.

#### **(iv) Declaration of Invalidity**

##### **243. Registration granted in breach of absolute grounds for refusal.**

A Community trade mark<sup>1</sup> must be declared to be invalid on application to the Office for Harmonisation in the Internal Market<sup>2</sup> or on the basis of a counterclaim in infringement proceedings<sup>3</sup>:

- 355 (1) where the Community trade mark was registered in breach of the absolute grounds<sup>4</sup> for refusal of registration<sup>5</sup>;
- 356 (2) where the applicant was acting in bad faith<sup>6</sup> when he filed the application for the trade mark<sup>7</sup>.

Where the trade mark was registered even though it is devoid of any distinctive character<sup>8</sup> or consists exclusively of signs or indications which may serve, in trade<sup>9</sup>, to designate the kind etc of goods or services<sup>10</sup> or consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade<sup>11</sup>, it may nevertheless not be declared invalid if, in consequence of the use<sup>12</sup> which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered<sup>13</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the Office see PARA 180 et seq ante; and as to bringing an application for a declaration of invalidity in the Office see PARA 289 et seq post.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 51(1) on the Community trade mark. As to the raising of a counterclaim for revocation in infringement proceedings see PARA 261 et seq post.

4 Ie on the ground that the trade mark was registered contrary to the provisions of ibid art 7: see PARA 209 et seq ante.

5 Ibid art 51(1)(a) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). The Cancellation Division is required to assess such an application on its merits and is not fettered by any decision during the application phase: Case R 766/2000-2 *Société France Cartes v Naipes Heraclio Fournier SA* [2002] ETMR 92, OHIM Board of Appeal.

6 Where the applicant had no intention to use the mark applied for, this does not amount to bad faith: Decision 34C/000053447/1 *Trillium Digital Systems Inc's Trade Mark* [2000] ETMR 1054, OHIM Cancellation Division; Decision 468C/00512632/1 *POTTERY BARN Trade Mark* [2005] ETMR 74, OHIM Cancellation Division; Decision 813C/001628395/1 *NAKED Trade Mark* (14 December 2004, unreported), OHIM Cancellation Division. As to the meaning of 'bad faith' under the equivalent provision in the Trade Marks Act 1994 see PARA 69 note 3 ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 51(1)(b). As to the additional ground of invalidity of a Community collective mark see PARA 301 post.

8 Ie in breach of ibid art 7(1)(b): see PARA 211 ante.

9 As to the meaning of 'trade' see PARA 226 note 3 ante.



- 10    le in breach of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 7(1)(c): see PARA 211 ante.
- 11    le in breach of ibid art 7(1)(d): see PARA 211 ante.
- 12    As to the meaning of 'use' see PARA 229 ante.
- 13    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 51(2). As to distinctive character acquired as a result of use see PARA 61 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iv) Declaration of Invalidity/244. Registration granted in breach of relative grounds for refusal.

#### **244. Registration granted in breach of relative grounds for refusal.**

A Community trade mark<sup>1</sup> must be declared invalid on application to the Office for Harmonisation in the Internal Market<sup>2</sup> or on the basis of a counterclaim<sup>3</sup> in infringement proceedings<sup>4</sup>:

- 357 (1) where there is an earlier trade mark<sup>5</sup> in relation to which the specified conditions for refusal<sup>6</sup> are fulfilled<sup>7</sup>;
- 358 (2) where the trade mark was registered in the name of the agent or representative of the proprietor thereof and the specified conditions<sup>8</sup> are fulfilled<sup>9</sup>; or
- 359 (3) where there is an earlier right<sup>10</sup> in relation to which the specified condition for refusal<sup>11</sup> is fulfilled<sup>12</sup>.

However, a Community trade mark may not be declared invalid where the proprietor of the earlier trade mark, trade mark or earlier right<sup>13</sup> (as the case may be) consents expressly to the registration of the Community trade mark before submission of the application for a declaration of invalidity or the counterclaim<sup>14</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the Office see PARA 180 et seq ante; and as to bringing an application for a declaration of invalidity in the Office see PARA 289 et seq post.

3 As to the raising of a counterclaim in infringement proceedings see PARA 261 et seq post.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 52(1).

5 Ie an earlier trade mark as referred to in ibid art 8(2) (as amended): see PARA 218 ante.

6 Ie the conditions set out in ibid art 8(1) or (5): see PARAS 219-221 ante.

7 Ibid art 52(1)(a).

8 Ie where there is a trade mark as referred to in ibid art 8(3) and the specified conditions are those set out in that provision: see PARA 223 ante.

9 Ibid art 52(1)(b).

10 Ie an earlier right as referred to in ibid art 8(4) (as amended): see PARA 222 ante.

11 Ie the condition set out in ibid art 8(4) (as amended): see PARA 222 ante.

12 Ibid art 52(1)(c). Where the proprietor of such a right has previously applied for a declaration that the Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the rights referred to in art 52(1) or art 52(2) (as substituted) (see PARA 245 post) which he could have invoked in support of his first application or counterclaim: art 52(4). See Decision 793C/00192500/2 *Luis Cabellero SA v Scottish & Newcastle plc* (17 May 2004, unreported), OHIM Cancellation Division.

13 Ie the right referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 52(1): see the text and notes 1-12 supra.

14 Ibid art 52(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

### **244 Registration granted in breach of relative grounds for refusal**

NOTE 12--See Cases T-114/07 and T-115/07 *Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2010] IP & T 77, CFI.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iv) Declaration of Invalidity/245. Use of Community trade mark would infringe another earlier right.

#### **245. Use of Community trade mark would infringe another earlier right.**

A Community trade mark<sup>1</sup> must be declared invalid on application to the Office for Harmonisation in the Internal Market<sup>2</sup> or on the basis of a counterclaim in infringement proceedings<sup>3</sup> where the use of such trade mark may be prohibited pursuant to another earlier right<sup>4</sup>, and in particular:

- 360 (1) a right to a name<sup>5</sup>;
- 361 (2) a right of personal portrayal<sup>6</sup>;
- 362 (3) a copyright<sup>7</sup>; or
- 363 (4) an industrial property right<sup>8</sup>,
- 364 under the Community legislation or national law governing the protection.

However, a Community trade mark may not be declared invalid where the proprietor of the earlier right<sup>9</sup> consents expressly to the registration of the Community trade mark before submission of the application for a declaration of invalidity or the counterclaim<sup>10</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the Office see PARA 180 et seq ante; and as to bringing an application for a declaration of invalidity in the Office see PARA 289 et seq post.

3 As to the raising of a counterclaim in infringement proceedings see PARA 261 et seq post.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 52(2) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). Where the proprietor of such a right has previously applied for a declaration that the Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new application for a declaration of invalidity or lodge a counterclaim on the basis of another of the rights referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 52(1) (see PARA 244 ante) or art 52(2) (as substituted) which he could have invoked in support of his first application or counterclaim: art 52(4).

5 Ibid art 52(2)(a) (as substituted: see note 4 supra).

6 Ibid art 52(2)(b) (as substituted: see note 4 supra).

7 Ibid art 52(2)(c) (as substituted: see note 4 supra). As to copyright see COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 3 et seq.

8 Ibid art 52(2)(d) (as substituted: see note 4 supra).

9 Ie the earlier right referred to in ibid art 52(2) (as substituted): see the text to notes 1-8 supra.

10 Ibid art 52(3).

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iv) Declaration of Invalidity/246. Partial declaration of invalidity.

#### **246. Partial declaration of invalidity.**

Where the grounds of invalidity<sup>1</sup> exist in respect of only some of the goods or services for which the Community trade mark<sup>2</sup> is registered, the trade mark must be declared invalid as regards those goods or services only<sup>3</sup>.

1 As to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 51(3), 52(5). As to the effect of a declaration of invalidity see PARA 247 post. As to narrowing the specification of goods or services in such circumstances see PARA 120 note 4 ante.

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(iv) Declaration of Invalidity/247. Effect of declaration of invalidity.

## **247. Effect of declaration of invalidity.**

A Community trade mark<sup>1</sup> is deemed not to have had, as from the outset, the specified effects<sup>2</sup>, to the extent that the trade mark is declared invalid<sup>3</sup>.

Subject to certain national provisions<sup>4</sup>, the retroactive effect of invalidity of the trade mark does not affect the following<sup>5</sup>:

- 365 (1) any decision on infringement which has acquired the authority of a final decision and has been enforced prior to the invalidity decision<sup>6</sup>; or
- 366 (2) any contract concluded prior to the invalidity decision, in so far as it has been performed before that decision (although repayment, to the extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity)<sup>7</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 I.e the effects specified in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark: see PARA 224 et seq ante.

3 Ibid art 54(2). As to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

4 I.e national provisions relating either to claims for compensation for damage caused by negligence or lack of good faith on the part of the proprietor of the trade mark, or unjust enrichment.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 54(3).

6 Ibid art 54(3)(a).

7 Ibid art 54(3)(b).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(v) Alteration/248. In general.

## **(v) Alteration**

### **248. In general.**

A Community trade mark<sup>1</sup> may not be altered in the register<sup>2</sup> during the period of registration or on renewal thereof<sup>3</sup>. Nevertheless, where the Community trade mark includes the name and address of the proprietor, an alteration not substantially affecting the identity of the trade mark as originally registered may be registered at the request of the proprietor<sup>4</sup>.

The publication<sup>5</sup> of the registration of the alteration must contain a representation of the Community trade mark as altered; and third parties whose rights may be affected by the alteration may challenge its registration within a period of three months following publication<sup>6</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the register of Community trade marks see PARA 188 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 48(1).

4 Ibid art 48(2). As to the procedure for alteration see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 25-27 (rr 25, 26 amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

As to the principles applied by the United Kingdom courts under the similar provision in the Trade Marks Act 1994 see PARA 122 note 5 ante.

5 As to publication see PARA 190 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 48(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(5) SURRENDER, REVOCATION, INVALIDITY, ALTERATION AND DIVISION/(vi) Division/249. In general.

## **(vi) Division**

### **249. In general.**

The proprietor of a Community trade mark<sup>1</sup> may divide the registration by declaring that some of the goods or services included in the original registration will be the subject of one or more divisional registrations<sup>2</sup>. The goods or services in the divisional registration must not overlap with the goods or services which remain in the original registration or those which are included in other divisional registrations<sup>3</sup>.

Division is not permissible<sup>4</sup>:

- 367 (1) if, where an application<sup>5</sup> for revocation of rights or for a declaration of invalidity has been entered against the original registration, a divisional declaration has the effect of introducing a division amongst the goods or services against which the application for revocation of rights or a declaration of invalidity is directed, until the decision of the Cancellation Division<sup>6</sup> has become final or the proceedings are finally terminated otherwise<sup>7</sup>;
- 368 (2) if, where a counterclaim<sup>8</sup> for revocation or for a declaration of invalidity has been entered in a case before a Community trade mark court<sup>9</sup>, a divisional declaration has the effect of introducing a division amongst the goods or services against which the counterclaim is directed, until the mention of the Community trade mark court's judgment is recorded in the register<sup>10</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 48a(1) (art 48a added by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). The declaration must comply with the provisions set out in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 48a(3) (as so added). The declaration is subject to a fee and must be deemed not to have been made until the fee is paid: art 48a(4) (as so added). As to the procedure for the division of a registration see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 25a (added by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). The division will take effect on the date on which it is entered on the register: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 48a(5) (as so added). As to the register of Community trade marks see PARA 188 ante.

All requests and applications submitted and all fees paid with regard to the original registration prior to the date on which the Office for Harmonisation in the Internal Market receives the declaration of division will be deemed to have been submitted or paid with regard to the divisional registration or registrations. The fees for the original registration which have been paid prior to the date on which the declaration of division is received will not be refunded: art 48a(6) (as so added). The divisional registration will preserve the filing date and any priority date and seniority date of the original registration: art 48a(7) (as so added). As to the Office see PARA 180 et seq ante.

Division of an application to register a Community trade mark is also possible: see art 44a(1) (as added); and PARA 281 post. Under the Trade Marks Act 1994 s 41(1) only division of an application, and not division of a registration, is permitted: see PARA 367 post.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 48a(1) (as added: see note 2 supra).

4 Ibid art 48a(2) (as added: see note 2 supra).

- 5 As to bringing an application for revocation or a declaration of invalidity in the Office see PARA 289 et seq post.
- 6 As to the Cancellation Division see PARA 182 ante.
- 7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 48a(2)(a) (as added: see note 2 supra).
- 8 As to the raising of a counterclaim in infringement proceedings see PARA 261 et seq post.
- 9 As to Community trade mark courts see PARA 250 post.
- 10 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 48a(2)(b) (as added: see note 2 supra). The judgment is recorded pursuant to art 96(6): see PARA 264 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(i) Introduction/250. In general.

## **(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS**

### **(i) Introduction**

#### **250. In general.**

An action for infringement of a Community trade mark<sup>1</sup> must be brought in a court of one of the member states<sup>2</sup>. For that purpose, the member states must designate as limited a number as possible of national courts and tribunals<sup>3</sup> ('Community trade mark courts') which must perform the functions assigned to them<sup>4</sup>. For that purpose, in England and Wales the High Court and a number of county courts are designated as Community trade mark courts<sup>5</sup>.

Given the unitary character of Community trade marks<sup>6</sup>, it will often be the case that the courts of more than one member state could potentially exercise jurisdiction over an infringement action. In general<sup>7</sup>, the Brussels Convention<sup>8</sup> applies to proceedings relating to Community trade marks and applications<sup>9</sup> for Community trade marks, as well as to proceedings relating to simultaneous and successive actions on the basis of Community trade marks and national trade marks<sup>10</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 92; and PARA 251 post.

3 I.e. courts and tribunals of first and second instance: see generally COURTS.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 91(1). Each member state was required to communicate to the EC Commission by 22 September 1995 a list of Community trade mark courts indicating their names and territorial jurisdiction: arts 91(2), 160(1). Any change made after communication of that list must be notified without delay by the member state concerned to the Commission: art 91(3). This information must be notified by the Commission to the member states and published in the Official Journal of the European Communities: art 91(4).

As long as a member state has not communicated the list stipulated by art 91(2), jurisdiction for any proceedings resulting from an action or application in respect of which the Community trade mark courts have exclusive jurisdiction (i.e. which is covered by art 92: see PARA 251 post) and for which the courts of that state have jurisdiction (i.e. pursuant to art 93: see PARA 252 post) lies with the court of that state in question which would have jurisdiction *ratione loci* and *ratione materiae* in the case of proceedings relating to a national trade mark registered in that state: art 91(5).

5 Community Trade Mark Regulations 2006, SI 2006/1027, reg 12(1), (2). The county courts so designated are the Patents County Court and the county courts at Birmingham, Bristol, Cardiff, Leeds, Liverpool, Manchester and Newcastle upon Tyne: see reg 12(1), (2). For the purpose of hearing appeals from judgments of the designated first instance courts, the Court of Appeal is also designated as a Community trade mark court: reg 12(3).

6 As to the unitary character of Community trade marks see PARA 206 ante.

7 I.e. unless otherwise specified in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1): see note 8 infra.

8 I.e. the Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters (Brussels, 27 September 1968: Cmnd 7395), as amended by the Conventions on the Accession to that Convention of the states acceding to the European Communities. The Brussels Convention sets out (inter alia) the rules under which the courts of signatory states allocate jurisdiction between themselves. It has largely been superseded by EC Council Regulation 44/2001 (OJ L12, 16.1.01, p 1) on jurisdiction and the recognition and enforcement of

judgments in civil and commercial matters (the 'Brussels I' Regulation), which is in similar but not identical terms. See further CONFLICT OF LAWS vol 8(3) (Reissue) PARA 65 et seq.

In the case of proceedings in respect of the actions or claims in respect of which the Community trade mark courts have exclusive jurisdiction (ie which are covered by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 92: see PARA 251 post): (1) the Brussels Convention arts 2, 4, 5(1), (3), (4), (5) do not apply; (2) the Brussels Convention arts 17, 18 apply subject to the limitations in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 93(4) (see PARA 252 post); and (3) the provisions of the Brussels Convention Title II which are applicable to persons domiciled in a member state are also applicable to persons who do not have a domicile in any member state but have an establishment therein: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 90(2).

The provisions of the Brussels Convention which are rendered applicable by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) have effect in respect of any member state solely in the text of the Convention which is in force in respect of that state at any given time: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 104.

As to the relationship between EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) and the Brussels Convention see *Prudential Assurance Co Ltd v Prudential Insurance Co of America* [2003] EWCA Civ 327, [2003] 1 WLR 2295, [2003] FSR 25.

9 As to an application for Community trade marks being an object of property see PARA 271 note 1 post.

10 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 90(1).

## UPDATE

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(ii) Jurisdiction of National Courts/251. Exclusive jurisdiction of Community trade mark courts.

## **(ii) Jurisdiction of National Courts**

### **251. Exclusive jurisdiction of Community trade mark courts.**

The Community trade mark courts<sup>1</sup> have exclusive jurisdiction:

- 369 (1) for all infringement actions<sup>2</sup> and, if they are permitted under national law, actions in respect of threatened infringement<sup>3</sup> relating to Community trade marks<sup>4</sup>;
- 370 (2) for actions for declaration of non-infringement, if they are permitted under national law<sup>5</sup>;
- 371 (3) for all actions brought for reasonable compensation in respect of matters arising after the date of publication of the Community trade mark application, which matters would, after publication of the registration of the trade mark, be prohibited by virtue of that publication<sup>6</sup>; and
- 372 (4) for counterclaims for revocation or for a declaration of invalidity of the Community trade mark<sup>7</sup>.

1 For the meaning of 'Community trade mark courts' see PARA 250 ante.

2 As to infringement actions see PARA 257 et seq post.

3 Actions for threatened infringement are permitted by the law of England and Wales: see PARA 416 note 1 post.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 92(a). As to actions for groundless threats of infringement proceedings see PARA 266 post; cf paras 123-125 ante. For the meaning of 'Community trade mark' see PARA 206 ante.

5 Ibid art 92(b). Actions for a declaration of non-infringement are permitted by the law of England and Wales: see PARA 457 post.

6 Ibid art 92(c), which refers to actions brought as a result of the acts referred to in art 9(3), second sentence (see PARA 225 ante).

7 Ibid art 92(d), which refers to counterclaims as pursuant to art 96 (see PARA 262 et seq post). As to the grounds for revocation see PARAS 237-240 ante; as to the additional grounds for revocation of a Community collective mark see PARA 300 post; as to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(ii) Jurisdiction of National Courts/252. International jurisdiction: exclusive jurisdiction of Community trade mark courts.

## **252. International jurisdiction: exclusive jurisdiction of Community trade mark courts.**

The rules for determining which member state's Community trade mark courts<sup>1</sup> have jurisdiction over a dispute involving their exclusive jurisdiction<sup>2</sup> are as follows:

- 373 (1) the general rule<sup>3</sup> is that proceedings in respect of which the Community trade mark courts have exclusive jurisdiction must be brought in the courts of the member state in which the defendant is domiciled or, if he is not domiciled in any of the member states, in which he has an establishment<sup>4</sup>;
- 374 (2) if head (1) above does not apply, such proceedings must be brought in the courts of the member state in which the claimant is domiciled or, if he is not domiciled in any of the member states, in which he has an establishment<sup>5</sup>;
- 375 (3) if neither head (1) nor head (2) above applies, such proceedings must be brought in the Spanish courts<sup>6</sup>;
- 376 (4) notwithstanding heads (1) to (3) above:  
5
  - 5. (a) if the parties agree that a different Community trade mark court will have jurisdiction over the dispute<sup>7</sup>, that court will have exclusive jurisdiction<sup>8</sup>;
  - 6. (b) a Community trade mark court before whom a defendant enters an appearance will have jurisdiction, except where an appearance was entered solely to contest the jurisdiction<sup>9</sup>;
- 6
  - 377 (5) such proceedings, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the member state in which the act of infringement has been committed or threatened to be committed<sup>10</sup>.

A Community trade mark court whose jurisdiction is based on heads (1) to (4) above has jurisdiction in respect of acts of infringement<sup>11</sup> committed or threatened within the territory of any of the member states<sup>12</sup>. Such a court has jurisdiction to grant provisional and protective measures which, subject to the appropriate procedure<sup>13</sup> are applicable in the territory of any member state; no other court has such jurisdiction<sup>14</sup>.

A Community trade mark court whose jurisdiction is based on head (5) above has jurisdiction in respect of acts committed or threatened within the territory of the member state in which that court is situated<sup>15</sup>.

1 For the meaning of 'Community trade mark courts' see PARA 250 ante.

2 I.e. the actions and claims referred to in PARA 251 ante.

3 I.e. subject to the provisions of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, as well as any provisions of the Brussels Convention and EC Council Regulation 44/2001 (OJ L12, 16.1.01, p 1) on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, applicable by virtue of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 90 (see PARA 250 ante). As to the Brussels Convention see PARA 250 note 8 ante.

- 4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 93(1). As to domicile for the purposes of the Brussels Convention see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 83 et seq.
- 5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 93(2).
- 6 Ibid art 93(3). Spain is the state where the Office for Harmonisation in the Internal Market has its seat: Statement by the Council and the Commission on the seat of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ L11, 14.1.94, p 36). As to the Office see PARA 180 et seq ante.
- 7 Ie an agreement to which the Brussels Convention art 17 and EC Council Regulation 44/2001 (OJ L12, 16.1.01, p 1) art 23 apply: see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 77.
- 8 Ie the Brussels Convention art 17 and EC Council Regulation 44/2001 (OJ L12, 16.1.01, p 1) art 23 (see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 77) apply in such a case: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 93(4)(a). See also PARA 250 note 8 ante.
- 9 Ie the Brussels Convention art 18 and EC Council Regulation 44/2001 (OJ L12, 16.1.01, p 1) art 23 (see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 78) apply in such a case: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 93(4)(b). See also PARA 250 note 8 ante.
- 10 Ibid art 93(5), which also applies to an act to which the second sentence of art 9(3) applies (see PARA 225 ante).
- 11 Including acts to which the second sentence of ibid art 9(3) applies (see PARA 225 ante).
- 12 Ibid art 94(1). As to infringement actions see PARA 257 et seq post.
- 13 Ie any necessary procedure pursuant to the Brussels Convention Title III: see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 191 et seq.
- 14 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 99(2). As to provisional and protective measures see PARA 258 post.
- 15 Ibid art 94(2).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(ii) Jurisdiction of National Courts/253. International jurisdiction: other cases.

### **253. International jurisdiction: other cases.**

Within the member state whose courts have jurisdiction under the 'Brussels I' Regulation<sup>1</sup> or the Brussels Convention<sup>2</sup> as they apply to relevant proceedings<sup>3</sup>, the courts which have jurisdiction for actions other than those in respect of which the Community trade mark courts<sup>4</sup> have exclusive jurisdiction<sup>5</sup> are those which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to a national trade mark registered in that state<sup>6</sup>.

Actions relating to a Community trade mark<sup>7</sup>, other than those in respect of which the Community trade mark courts have exclusive jurisdiction, for which no court otherwise has jurisdiction<sup>8</sup>, may be heard before the Spanish courts<sup>9</sup>.

1 As to the 'Brussels I' Regulation see PARA 250 note 8 ante.

2 As to the Brussels Convention see PARA 250 note 8 ante.

3 I.e. those mentioned in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 90(1). As to the application of the 'Brussels I' Regulation and the Brussels Convention to such proceedings see PARA 250 ante.

4 For the meaning of 'Community trade mark courts' see PARA 250 ante.

5 I.e. those referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 92: see PARA 251 ante.

6 Ibid art 102(1).

7 For the meaning of 'Community trade mark' see PARA 206 ante.

8 I.e. under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 90(1) or art 102(2).

9 Ibid art 102(2); Statement by the Council and the Commission on the seat of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ L11, 14.1.94, p 36). See PARA 252 note 6 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(ii) Jurisdiction of National Courts/254. Simultaneous and successive civil actions.

## **254. Simultaneous and successive civil actions.**

Where actions for infringement<sup>1</sup> involving the same cause of action<sup>2</sup> and between the same parties are brought in the courts of different member states, one seized on the basis of a Community trade mark<sup>3</sup> and the other seized on the basis of a national trade mark, the following provisions<sup>4</sup> apply<sup>5</sup>:

- 378 (1) the court other than the court first seized must of its own motion decline jurisdiction in favour of that court, where the trade marks concerned are identical and valid<sup>6</sup> for identical goods or services; and the court which would be required to decline jurisdiction may stay its proceedings if the jurisdiction of the other court is contested<sup>7</sup>;
- 379 (2) the court other than the court first seized may stay its proceedings where the trade marks concerned are identical and valid for similar goods or services<sup>8</sup> and where the trade marks concerned are similar and valid for identical or similar goods or services<sup>9</sup>.

The court hearing an action for infringement on the basis of a Community trade mark must reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of an identical national trade mark valid for identical goods or services<sup>10</sup>. The court hearing an action for infringement on the basis of a national trade mark must reject the action if a final judgment on the merits has been given on the same cause of action and between the same parties on the basis of a Community trade mark valid for identical goods or services<sup>11</sup>.

None of the above applies in respect of provisional, including protective, measures<sup>12</sup>.

1 As to infringement actions see PARA 257 et seq post.

2 The same cause of action means the same cause of action and the same subject matter: Case C-144/86 *Gubisch Maschinenfabrik KG v Palumbo* [1987] ECR 4861, ECJ; Case C-406/92 *The Tatry* [1994] ECR I-5439, sub nom *Maciej Rataj, The, Tatry (cargo owners) v Maciej Rataj* [1995] All ER (EC) 229, ECJ; *Prudential Assurance Co Ltd v Prudential Insurance Co of America* [2003] EWCA Civ 327, [2003] 1 WLR 2295, [2003] IP & T 1070.

3 For the meaning of 'Community trade mark' see PARA 206 ante.

4 Ie the provisions described in the text and notes 6-9 infra.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 105(1).

6 'Valid' should be construed as meaning registered or in force: *Prudential Assurance Co Ltd v Prudential Insurance Co of America* [2002] EWHC 534 (Ch) at [76], [2003] FSR 7 at [76], [2002] IP & T 781 at [76] per Laddie J; affd on other grounds [2003] EWCA Civ 327, [2003] 1 WLR 2295, [2003] IP & T 1070.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 105(1)(a).

8 As to the meaning of 'similar goods or services' see PARA 73 ante.

9 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 105(1)(b).

10 Ibid art 105(2). This provision and art 105(3) (see the text and note 11 infra) only apply where a final judgment has been given by a court seized on the basis of an identical trade mark valid for identical goods or

services; they do not apply where there is no such dual identity: *Prudential Assurance Co Ltd v Prudential Insurance Co of America* [2003] EWCA Civ 327, [2003] 1 WLR 2295, [2003] IP & T 1070. It is not clear whether they apply only where both the earlier proceedings and the later proceedings are proceedings for infringement or whether they apply where the earlier proceedings are concerned with validity: *Prudential Assurance Co Ltd v Prudential Insurance Co of America* supra.

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 105(3). See note 10 supra.

12 Ibid art 105(4).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(ii) Jurisdiction of National Courts/255. Related actions.

## **255. Related actions.**

A Community trade mark court<sup>1</sup> hearing one of the following types of action:

- 380 (1) an infringement action<sup>2</sup>;
- 381 (2) an action in respect of threatened infringement relating to Community trade marks<sup>3</sup>;
- 382 (3) an action brought for reasonable compensation in respect of matters arising after the date of publication of the Community trade mark application, which matters would, after publication of the registration of the trade mark, be prohibited by virtue of that publication<sup>4</sup>; or
- 383 (4) a counterclaim for revocation or for a declaration of invalidity of the Community trade mark<sup>5</sup>,

must, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the parties, stay the proceedings if the validity of the Community trade mark is already in issue before another Community trade mark court on account of a counterclaim or where an application for revocation or for a declaration of invalidity has already been filed at the Office for Harmonisation in the Internal Market<sup>6</sup>.

The Office, when hearing an application for revocation or for a declaration of invalidity must, unless there are special grounds for continuing the hearing, of its own motion after hearing the parties or at the request of one of the parties and after hearing the parties, stay the proceedings if the validity of the Community trade mark is already in issue on account of a counterclaim before another Community trade mark court. However, if one of the parties so requests, the court may, after hearing the other parties to those proceedings, stay the proceedings; the Office must in this instance continue the proceedings pending before it<sup>7</sup>.

In any such case, where the Community trade mark court stays proceedings it may order provisional and protective measures for the duration of the stay<sup>8</sup>.

1 For the meaning of 'Community trade mark courts' see PARA 250 ante.

2 As to infringement actions see PARA 257 et seq post.

3 As to actions for groundless threats of infringement proceedings see PARA 266 post; cf paras 123-125 ante. For the meaning of 'Community trade mark' see PARA 206 ante.

4 I.e. an action brought as a result of the acts referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 9(3), second sentence (see PARA 225 ante).

5 I.e. an action referred to in *ibid* art 92 (see PARA 251 ante), other than an action for a declaration of non-infringement. As to bringing a counterclaim for revocation or for a declaration of invalidity of the Community trade mark see PARA 261 et seq post; as to the grounds for revocation see PARAS 237-240 ante; and as to the grounds for a declaration of invalidity see PARAS 243-245 ante.

6 *Ibid* art 100(1). As to the Office see PARA 180 et seq ante; and as to bringing an application for revocation in the Office see PARA 289 et seq post.

7 *Ibid* art 100(2).

8 Ibid art 100(3). As to provisional and protective measures see PARA 258 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

## **255 Related actions**

NOTE 6--See *Kitfix Swallow Group Ltd v Great Gizmos Ltd* [2007] EWHC 2668 (Ch), [2008] Bus LR 465 (no stay of domestic proceedings where proceedings before Office had been stayed and then resumed).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(ii) Jurisdiction of National Courts/256. Jurisdiction of appeal courts.

## **256. Jurisdiction of appeal courts.**

An appeal to the Community trade mark courts of second instance<sup>1</sup> lies from judgments of the Community trade mark courts in respect of proceedings in respect of which the Community trade mark courts have exclusive jurisdiction<sup>2</sup>. The conditions under which an appeal may be lodged with a Community trade mark court of second instance must be determined by the national law of the member state in which the court is located<sup>3</sup>; and the national rules concerning further appeal are applicable in respect of judgments of Community trade mark courts of second instance<sup>4</sup>.

1 For the meaning of 'Community trade mark court' see PARA 250 ante. As to the duty of member states to appoint Community trade mark courts of first and second instance see PARA 250 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 101(1). For the proceedings in respect of which the Community trade mark courts have exclusive jurisdiction see PARA 251 ante.

3 Ibid art 101(2).

4 Ibid art 101(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iii) Proceedings for Infringement of Community Trade Marks/257. In general.

### **(iii) Proceedings for Infringement of Community Trade Marks**

#### **257. In general.**

The principle underlying the enforcement of Community trade marks<sup>1</sup>, and the other rights relating thereto<sup>2</sup>, is that the courts of the member states must apply the provisions of Community law<sup>3</sup>; and any aspect not covered by Community law, in particular procedural provisions, should be governed by that member state's national law<sup>4</sup>.

Thus the Community trade mark courts<sup>5</sup> must apply the provisions of Community law<sup>6</sup>; but on all other matters not covered by it, such a court must apply its national law, including its private international law<sup>7</sup>. Unless otherwise provided<sup>8</sup>, a Community trade mark court must apply the rules of procedure governing the same type of action relating to a national trade mark in the member state where it has its seat<sup>9</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 Eg the rights created by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 11, 18: see PARA 231 ante.

3 Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

4 See ibid art 97 (see the text and notes 5-9 infra) and art 98(2) (see PARA 258 post).

5 For the meaning of 'Community trade mark courts' see PARA 250 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 97(1). See note 3 supra.

7 Ibid art 97(2).

8 Ie by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

9 Ibid art 97(3). For the procedure in the High Court see PARA 416 et seq post. For a situation where a court of one member state must apply the law of another member state see art 98(2); and PARA 258 note 4 post.

#### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iii) Proceedings for Infringement of Community Trade Marks/258. Remedies for infringement; provisional and protective measures.

## **258. Remedies for infringement; provisional and protective measures.**

Where a Community trade mark court<sup>1</sup> finds that the defendant has infringed or threatened to infringe a Community trade mark<sup>2</sup>, it must, unless there are special reasons for not doing so, issue an order prohibiting the defendant from proceeding with the acts which infringed or would infringe the Community trade mark. It must also take such measures in accordance with its national law as are aimed at ensuring that this prohibition is complied with<sup>3</sup>.

In all other respects the Community trade mark court must apply the law of the member state in which the acts of infringement or threatened infringement were committed, including the private international law<sup>4</sup>. Thus remedies are a matter for national law<sup>5</sup>.

Application may be made to the courts of a member state, including the Community trade mark courts<sup>6</sup>, for such provisional, including protective, measures in respect of a Community trade mark or Community trade mark application<sup>7</sup> as may be available under the law of that state in respect of a national trade mark<sup>8</sup>, even if a Community trade mark court of another member state has jurisdiction<sup>9</sup> as to the substance of the matter<sup>10</sup>.

1 For the meaning of 'Community trade mark court' see PARA 250 ante.

2 For the meaning of 'Community trade mark' see PARA 206 ante; and as to the acts which infringe a Community trade mark see PARA 224 et seq ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 98(1).

4 Ibid art 98(2). Thus a Community trade mark court which has jurisdiction in respect of acts committed or threatened in any member state (ie pursuant to art 93(1), (2), (3) or (4): see PARA 252 ante) must apply the law of the member state or states in which the acts of infringement or threatened infringement were committed, including the private international law, rather than its own domestic law.

5 Save that, as provided for by ibid art 98(2) (see the text to note 4 supra), effective injunctive relief must be available. As to the remedies for infringement of a Community trade mark in the English courts see PARA 436 et seq post.

6 The use of the words 'including the Community trade mark courts' in this provision suggests that courts of the member states other than Community trade mark courts also have jurisdiction to make such provisional orders.

7 As to a Community trade mark application being an object of property see PARA 270 et seq post.

8 Where judicial authorities are called upon to apply national rules with a view to ordering provisional measures for the protection of Community trade marks, they are required to do so as far as possible in the light of the wording and purpose of the Agreement on Trade-Related Aspects of Intellectual Property ('TRIPs') (1994) (Cm 2557) art 50: Joined Cases C-300/98 and C-392/98 *Parfums Christian Dior SA v TUK Consultancy BV* [2000] ECR I-11307, ECJ; Case C-89/99 *Schieving-Nijstad VOF v Groenefeld* [2001] ECR I-5851, [2002] IP & T 353, ECJ; and see also Case C-53/96 *Hermès International v FHT Marketing Choice* [1998] ECR I-3603, [1999] RPC 107, ECJ. As to interim measures available under English law see PARA 450 et seq post. As to TRIPs see PARA 7 ante.

9 Ie under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

10 Ibid art 99(1).

## **UPDATE**

**176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iii) Proceedings for Infringement of Community Trade Marks/259. Prohibition of use of Community trade marks.

## **259. Prohibition of use of Community trade marks.**

The Community Trade Mark Regulation<sup>1</sup> does not, unless otherwise provided for, affect the following:

- 384 (1) the right existing under the laws of the member states to invoke claims for infringement of earlier rights<sup>2</sup> in relation to the use of a later Community trade mark<sup>3</sup>; however, claims for infringement of certain such rights<sup>4</sup> may no longer be invoked if the proprietor of the earlier right can no longer, due to his acquiescence, apply for a declaration that the Community trade mark is invalid<sup>5</sup>;
- 385 (2) the right to bring proceedings under the civil, administrative or criminal law of a member state or under provisions of Community law for the purpose of prohibiting the use of a Community trade mark to the extent that the use of a national trade mark may be prohibited under the law of that member state or under Community law<sup>6</sup>.

1    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    Ie earlier rights within the meaning of *ibid* art 8 (see PARA 222 ante) or art 52(2) (see PARA 245 ante).

3    For the meaning of 'Community trade mark' see PARA 206 ante.

4    Ie those earlier rights within the meaning of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 8(2), (4) (art 8(2) as amended) (see PARAS 218, 222 ante).

5    Ibid art 106(1). As to the loss of the proprietor's entitlement to make an application in such circumstances see art 53(2); and PARA 233 ante.

6    Ibid art 106(2).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iii) Proceedings for Infringement of Community Trade Marks/260. Prior rights applicable to particular localities.

## **260. Prior rights applicable to particular localities.**

The proprietor of an earlier right which only applies to a particular locality<sup>1</sup> may oppose<sup>2</sup> the use<sup>3</sup> of the Community trade mark<sup>4</sup> in the territory where his right is protected in so far as the law of the member state concerned so permits<sup>5</sup>. This ceases to apply if the proprietor of the earlier right has acquiesced<sup>6</sup> in the use of the Community trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the Community trade mark was applied for in bad faith<sup>7</sup>. However, the proprietor of the Community trade mark is not entitled to oppose the use of that earlier right even though that right may no longer be invoked against the Community trade mark<sup>8</sup>.

1 An 'earlier right which only applies to a particular locality' means any non-Community right, whether registered or unregistered: *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch), [2004] RPC 809, [2004] 17 LS Gaz R 32.

2 As to the meaning of 'oppose' see PARA 231 note 3 ante.

3 As to the meaning of 'use' see PARA 229 ante.

4 For the meaning of 'Community trade mark' see PARA 206 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 107(1).

6 As to the meaning of 'acquiesce' see PARA 233 note 2 ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 107(2). As to the meaning of 'bad faith' see PARA 69 note 3 ante.

8 Ibid art 107(3). This provision gives the owner of the earlier right broad protection against being sued by the owner of a subsequently acquired Community trade mark: *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 (Ch), [2004] RPC 809, [2004] 17 LS Gaz R 32.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iv) Challenging Validity of Community Trade Marks in National Courts/261. Presumption of validity; procedures for challenge to validity.

## **(iv) Challenging Validity of Community Trade Marks in National Courts**

### **261. Presumption of validity; procedures for challenge to validity.**

A national court which is dealing with an action relating to a Community trade mark<sup>1</sup>, other than one in respect of which the Community trade mark courts<sup>2</sup> have exclusive jurisdiction<sup>3</sup>, must treat the trade mark as valid<sup>4</sup>. Further, the Community trade mark courts must treat a Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim<sup>5</sup> for revocation or declaration of invalidity<sup>6</sup>, or by challenging it (to the limited extent possible) in an action for threats of infringement proceedings<sup>7</sup>.

Thus a person cannot challenge the validity or apply for revocation of a Community trade mark in a national court unless he is threatened with, or sued for, infringement of that Community trade mark. If he wishes to challenge its validity or apply for revocation of his own motion, he must apply to the Office for Harmonisation in the Internal Market<sup>8</sup> to do so<sup>9</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 For the meaning of 'Community trade mark courts' see PARA 250 ante.

3 As to exclusive jurisdiction see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 92; and PARA 251 ante.

4 Ibid art 103.

5 In certain proceedings (ie actions referred to in ibid art 92(a), (c): see PARA 251 ante), a plea relating to revocation or invalidity of the Community trade mark submitted otherwise than by way of a counterclaim is admissible in so far as the defendant claims that the rights of the proprietor of the community trade mark could be declared invalid on account of an earlier right of the defendant: art 95(3).

6 Ibid art 95(1).

7 In accordance with ibid art 95(3): see note 5 supra. The validity of a Community trade mark may not be put in issue in an action for a declaration of non-infringement: art 95(2).

8 As to the Office see PARA 180 et seq ante.

9 As to challenging the validity of a Community trade mark or applying for revocation in the Office see PARAS 289-290 post; as to the grounds for revocation see PARAS 237-240 ante; as to the additional grounds for revocation of a Community collective mark see PARA 300 post; as to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iv) Challenging Validity of Community Trade Marks in National Courts/262. Bringing of a counterclaim.

## **262. Bringing of a counterclaim.**

A counterclaim<sup>1</sup> for revocation or for a declaration of invalidity may only be made on the grounds for revocation<sup>2</sup> or invalidity<sup>3</sup> prescribed<sup>4</sup>.

The Community trade mark court<sup>5</sup> with which a counterclaim for revocation or for a declaration of invalidity of the Community trade mark<sup>6</sup> has been filed must inform the Office for Harmonisation in the Internal Market<sup>7</sup> of the date on which the counterclaim was filed<sup>8</sup>. A Community trade mark court must reject a counterclaim if a decision taken by the Office relating to the same subject matter and cause of action involving the same parties has already become final<sup>9</sup>.

If the counterclaim is brought in a legal action to which the proprietor of the trade mark is not already a party, he must be informed thereof<sup>10</sup> and may be joined as a party to the action in accordance with the conditions set out in national law<sup>11</sup>.

1 As to the requirement that the application be brought by way of counterclaim see also EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 95(3); and PARA 261 note 5 ante.

2 As to the grounds for revocation see PARAS 237-240 ante. As to the additional grounds for revocation of a Community collective mark see PARA 300 post.

3 As to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 96(1).

5 For the meaning of 'Community trade mark court' see PARA 250 ante.

6 For the meaning of 'Community trade mark' see PARA 206 ante.

7 As to the Office see PARA 180 et seq ante.

8 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 96(4). The Office must record this fact in the register of Community trade marks: art 96(4). The Office may, if it thinks fit, invite the parties to make a friendly settlement: arts 56(4), 96(5) (art 96(5) substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). As to the register see PARA 188 ante.

9 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 96(2). As to the meaning of 'the same cause of action' see PARA 254 note 2 ante.

10 It is not clear who must inform the proprietor that his Community trade mark is under attack. The most appropriate procedure would be to serve the counterclaim on the proprietor.

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 96(3).

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iv) Challenging Validity of Community Trade Marks in National Courts/263. Proof of use of earlier Community and national trade marks on a counterclaim.

### **263. Proof of use of earlier Community and national trade marks on a counterclaim.**

If the proprietor of the Community trade mark<sup>1</sup> so requests, the proprietor of an earlier Community or national trade mark<sup>2</sup>, being a party to the invalidity proceedings, must furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier Community or national trade mark has been put to genuine use in the relevant member state in connection with the goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons for non-use<sup>3</sup>, provided the earlier Community or national trade mark has at that date been registered for not less than five years<sup>4</sup>.

If, at the date on which the Community trade mark application was published, the earlier Community trade mark had been registered for not less than five years, the proprietor of the earlier Community trade mark must furnish proof that, in addition, the prescribed conditions<sup>5</sup> were satisfied at that date<sup>6</sup>.

In the absence of proof to this effect the application for a declaration of invalidity must be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it must, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect only of that part of the goods or services<sup>7</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 I.e. an earlier Community or national trade mark referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 8(2)(a) (as amended): see PARA 218 ante.

3 The following words appear at this point in the published version of *ibid* art 56(2) (which is incorporated into art 56(3)), apparently in error: 'provided the earlier Community trade mark has at that date been registered for non-use'.

4 *Ibid* arts 56(2), (3), 96(5) (art 96(5) substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

5 I.e. that during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark was put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which the proprietor cites as justification for the counterclaim, or that there are proper reasons for non-use: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 43(2); and PARA 282 post.

6 *Ibid* arts 56(2), (3), 96(5) (art 96(5) as substituted: see note 4 *supra*).

7 *Ibid* arts 56(2), (3), 96(5) (art 96(5) as substituted: see note 4 *supra*).

### **UPDATE**

#### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iv) Challenging Validity of Community Trade Marks in National Courts/264. Decision on the merits of a counterclaim.

## **264. Decision on the merits of a counterclaim.**

If the examination of the application for revocation of rights<sup>1</sup> or for a declaration of invalidity<sup>2</sup> reveals that the trade mark should not have been registered<sup>3</sup> in respect of some or all of the goods or services for which it is registered, the rights of the proprietor of the Community trade mark<sup>4</sup> must be revoked or the trade mark must be declared invalid in respect of those goods or services; otherwise the application for revocation of rights or for a declaration of invalidity must be rejected<sup>5</sup>.

Where a Community trade mark court<sup>6</sup> has given judgment which has become final on a counterclaim for revocation or for invalidity of a Community trade mark, a copy of the judgment must be sent to the Office for Harmonisation in the Internal Market<sup>7</sup>.

1 As to the grounds for revocation see PARAS 237-240 ante; and as to the additional grounds for revocation of a Community collective mark see PARA 300 post.

2 As to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

3 It is presumed that there should be read into this part of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 56(5) words to the effect of 'or that the trade mark should be revoked', since revocation relates to events which occur after a registration: ex hypothesi, the trade mark was rightly registered but should now be revoked. See further PARAS 235, 237 et seq ante.

4 For the meaning of 'Community trade mark' see PARA 206 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 56(5), 96(5) (art 96(5) substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

6 For the meaning of 'Community trade mark court' see PARA 250 ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 96(6). Any party may request information about such a transmission (art 96(6)) but it is not clear from whom. The Office must mention the judgment in the register of Community trade marks in accordance with the provisions of EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 96(6). As to the Office see PARA 180 et seq ante. As to the register of Community trade marks see PARA 188 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(iv) Challenging Validity of Community Trade Marks in National Courts/265. Request that counterclaim proceed by way of application to the Office.

## **265. Request that counterclaim proceed by way of application to the Office.**

The Community trade mark court<sup>1</sup> hearing a counterclaim for revocation<sup>2</sup> or for a declaration of invalidity<sup>3</sup> may stay the proceedings on application by the proprietor of the Community trade mark<sup>4</sup> and after hearing the other parties, and may request the defendant to submit an application for revocation or for a declaration of invalidity to the Office for Harmonisation in the Internal Market<sup>5</sup> within a time limit which it must determine<sup>6</sup>.

If such an application is not made within the time limit, the proceedings must continue; and the counterclaim is deemed withdrawn<sup>7</sup>.

Where the Community trade mark court stays the proceedings it may order provisional and protective measures for the duration of the stay<sup>8</sup>.

1 For the meaning of 'Community trade mark court' see PARA 250 ante.

2 As to the grounds for revocation see PARAS 237-240 ante; and as to the additional grounds for revocation of a Community collective mark see PARA 300 post.

3 As to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

4 For the meaning of 'Community trade mark' see PARA 206 ante.

5 As to the Office see PARA 180 et seq ante; and as to applying for revocation or for a declaration of invalidity to the Office see PARAS 289-290 post.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 96(7).

7 Ibid art 96(7).

8 Ibid arts 96(7), 100(3). As to provisional and protective measures see PARA 258 ante.

## **UPDATE**

### **176-265 The Community Trade Mark Regulation ... Request that counterclaim proceed by way of application to the Office**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(v) Miscellaneous Proceedings/266. Groundless threats of infringement proceedings.

## **(v) Miscellaneous Proceedings**

### **266. Groundless threats of infringement proceedings.**

The statutory provisions<sup>1</sup> relating to groundless threats of infringement proceedings apply in relation to a Community trade mark<sup>2</sup> as in relation to a registered trade mark<sup>3</sup>.

1     I.e. the Trade Marks Act 1994 s 21: see PARAS 123-125 ante.

2     For the meaning of 'Community trade mark' see PARA 206 ante.

3     Community Trade Mark Regulations 2006, SI 2006/1027, regs 2, 6(1). The provisions relating to threats also apply with minor modifications to an international trade mark (EC): regs 2(2), 6(2). For the meaning of 'international trade mark (EC)' see PARA 8 note 17 ante. For the meaning of 'registered trade mark' see PARA 127 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(v) Miscellaneous Proceedings/267. Importation of infringing goods, materials or articles.

## **267. Importation of infringing goods, materials or articles.**

The statutory provisions<sup>1</sup> providing that infringing goods<sup>2</sup>, material<sup>3</sup> or articles<sup>4</sup> may be treated as prohibited goods, and relating to the power of the Commissioners for Her Majesty's Revenue and Customs<sup>5</sup> to disclose information, apply in relation to a Community trade mark<sup>6</sup> as they apply in relation to a registered trade mark<sup>7</sup>.

1    I.e. the Trade Marks Act 1994 ss 89, 90, 91 (all as amended): see PARAS 149, 151-152 ante.

2    For the meaning of 'infringing goods' see PARA 150 ante.

3    For the meaning of 'infringing material' see PARA 150 ante.

4    For the meaning of 'infringing articles' see PARA 150 ante.

5    As to the Commissioners for Her Majesty's Revenue and Customs see CUSTOMS AND EXCISE vol 12(3) (2007 Reissue) PARA 900 et seq.

6    For the meaning of 'Community trade mark' see PARA 206 ante.

7    Community Trade Mark Regulations 2006, SI 2006/1027, regs 2, 7(1) (amended by virtue of the Commissioners for Revenue and Customs Act 2005 s 50(1), (7)). The Trade Marks (Customs) Regulations 1994, SI 1994/2625 (see PARA 151 ante) apply in relation to notices given under the provisions of the Trade Marks Act 1994 s 89 (as amended) as so applied: Community Trade Mark Regulations 2006, SI 2006/1027, reg 7(2). These provisions also apply to international trade marks (EC): reg 2(2). For the meaning of 'international trade mark (EC)' see PARA 8 note 17 ante. For the meaning of 'registered trade mark' see PARA 127 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(v) Miscellaneous Proceedings/268. Offences and forfeiture.

## **268. Offences and forfeiture.**

The statutory provisions<sup>1</sup> relating to unauthorised use of a trade mark etc in relation to goods, search warrants, the enforcement function of local weights and measures authorities<sup>2</sup> and forfeiture apply in relation to a Community trade mark<sup>3</sup> as they apply in relation to a registered trade mark<sup>4</sup>.

1 In the Trade Marks Act 1994 s 92 (unauthorised use of a trade mark etc in relation to goods: see PARAS 141-144 ante), s 92A (as added) (search warrants: see PARA 145 ante), s 93 (enforcement function of local weights and measures authorities: see PARA 146 ante), s 97 (forfeiture: see PARA 140 ante).

2 As to local weights and measures authorities see PARA 146 note 1 ante.

3 For the meaning of 'Community trade mark' see PARA 206 ante.

4 Community Trade Mark Regulations 2006, SI 2006/1027, regs 2, 8(1). For the purposes of the provisions mentioned in the text and note 1 supra, references to goods in respect of which a trade mark is registered include goods in respect of which an international trade mark (EC) confers protection in the European Community: reg 8(2). These provisions also apply to international trade marks (EC): reg 2(2). For the meaning of 'international trade mark (EC)' see PARA 8 note 17 ante. For the meaning of 'registered trade mark' see PARA 127 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(6) NATIONAL ACTIONS RELATING TO COMMUNITY TRADE MARKS/(v) Miscellaneous Proceedings/269. Falsely representing trade mark as a Community trade mark.

**269. Falsely representing trade mark as a Community trade mark.**

It is an offence for a person:

- 386 (1) falsely to represent that a mark is a Community trade mark<sup>1</sup>; or
- 387 (2) to make false representations as to the goods or services for which a Community trade mark is registered,

knowing or having reason to believe that the representation is false<sup>2</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante. Cf the similar provision relating to registered trade marks provided by the Trade Marks Act 1994 s 95: see PARA 148 ante.

2 Community Trade Mark Regulations 2006, SI 2006/1027, reg 9(1). A person guilty of an offence under this regulation is liable on summary conviction to a fine not exceeding level 3 on the standard scale: reg 9(2). As to the standard scale see PARA 32 note 13 ante. These provisions also apply to international trade marks (EC): reg 2(2). For the meaning of 'international trade mark (EC)' see PARA 8 note 17 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/270. In general.

## **(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING**

### **270. In general.**

Community trade marks<sup>1</sup>, like trade marks registered under the Trade Marks Act 1994<sup>2</sup>, may be assigned and licensed without substantial restrictions. The proprietor must not allow his mark to become deceptive without risking revocation<sup>3</sup>. Subject to that, a Community trade mark is treated in a similar way to other incorporeal rights as regards the freedom of its owner to deal with it.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to registered trade marks as objects of property, and as to assignment and licensing of the same, see PARA 126 et seq ante.

3 See PARA 240 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/271. Community trade marks as objects of property.

## **271. Community trade marks as objects of property.**

A Community trade mark<sup>1</sup> is to be regarded as an object of property which exists separately from the undertaking whose goods or services are designated by it<sup>2</sup>.

Thus a Community trade mark may, independently of the undertaking, be given as security or be the subject of rights in rem<sup>3</sup> and it may be levied in execution<sup>4</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante. EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 24 provides that the provisions relating to Community trade marks as objects of property (ie arts 16-23) apply to applications for Community trade marks. Therefore, such applications are similarly to be regarded as objects of property. As to the making of an application for a Community trade mark see PARAS 278-283 post.

2 Ibid 10th recital.

3 Ibid art 19(1). At the request of one of the parties, the rights mentioned in art 19(1) must be entered into the register (see PARA 188 ante) and published: art 19(2). As to the consequences of failing to register such rights see art 23; and PARA 276 post.

4 Ibid art 20(1). As regards the procedure for levy of execution in respect of a Community trade mark, the courts and authorities of the member states determined in accordance with art 16 (see PARA 272 post) have exclusive jurisdiction: art 20(2). At the request of one of the parties, levy of execution must be entered into the register and published: art 20(3). The effects vis-à-vis third parties of the levy of execution are governed by the law of the member state determined in accordance with art 16 (see PARA 272 post): art 23(3).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/272. Dealing with Community trade marks as national trade marks.

## **272. Dealing with Community trade marks as national trade marks.**

Unless otherwise provided<sup>1</sup>, a Community trade mark<sup>2</sup> as an object of property<sup>3</sup> must be dealt with in its entirety, and for the whole area of the Community, as a national trade mark<sup>4</sup> registered in:

- 388 (1) the member state in which, according to the register of Community trade marks, the proprietor has his seat or his domicile on the relevant date<sup>5</sup>;
- 389 (2) if head (1) above does not apply, the member state in which, according to the register of Community trade marks, the proprietor has an establishment on the relevant date<sup>6</sup>; or
- 390 (3) in cases which are not provided for by head (1) or head (2) above, Spain<sup>7</sup>.

1 le under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 17-24 (see PARAS 231, 271 ante, 273-276 post).

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 As to applications for Community trade marks as objects of property see PARA 271 note 1 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 16(1).

5 Ibid art 16(1)(a).

6 Ibid art 16(1)(b).

7 Ibid art 16(2). Spain is the state where the Office for Harmonisation in the Internal Market has its seat: art 16(2); Statement by the Council and the Commission on the seat of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ L11, 14.1.94, p 36).

If two or more persons are mentioned in the register of Community trade marks (see PARA 188 ante) as joint proprietors, head (1) in the text or, where that does not apply, head (2) in the text applies to the joint proprietor first mentioned; failing this, it applies to the subsequent joint proprietors in the order in which they are mentioned: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 16(3). Where heads (1) and (2) in the text do not apply to any of the joint proprietors, head (3) in the text applies: art 16(3).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/273. Insolvency proceedings.

### **273. Insolvency proceedings.**

The only insolvency proceedings in which a Community trade mark<sup>1</sup> may be involved are those opened in the member state in the territory of which the debtor has his centre of main interests<sup>2</sup>. However, where the debtor is an insurance undertaking or a credit institution<sup>3</sup>, the only insolvency proceedings in which a Community trade mark may be involved are those opened in the member state where that undertaking or institution has been authorised<sup>4</sup>. In the case of joint proprietorship of a Community trade mark, these provisions apply to the share of the joint proprietor<sup>5</sup>. Where a Community trade mark is involved in insolvency proceedings, on request of the competent national authority an entry to this effect must be made in the register<sup>6</sup> and published in the Community Trade Marks Bulletin<sup>7</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante; and as to the application of these provisions to applications for Community trade marks see PARA 271 note 1 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 21(1) (art 21 substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

3 I.e. as defined in EC Parliament and Council Directive 2001/17 (OJ L110, 20.4.01, p 28) on the re-organisation and winding up of insurance undertakings and in EC Parliament and Council Directive 2001/24 (OJ L25, 5.5.01, p 15) on the re-organisation and winding up of credit institutions respectively.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 21(1) (as substituted: see note 2 supra).

5 Ibid art 21(2) (as substituted: see note 2 supra).

6 As to the register see PARA 188 ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 21(3) (as substituted: see note 2 supra). As to the Community Trade Marks Bulletin see PARA 190 ante.

### **UPDATE**

#### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/274. Transfer of Community trade marks.

## **274. Transfer of Community trade marks.**

In general<sup>1</sup>, an assignment of the Community trade mark<sup>2</sup> must be made in writing and requires the signature of the parties to the contract, except when it is a result of a judgment; otherwise it is void<sup>3</sup>.

A Community trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered<sup>4</sup>.

On request of one of the parties a transfer must be entered in the register<sup>5</sup> and published<sup>6</sup>. As long as the transfer has not been entered in the register, the successor in title may not invoke the rights arising from the registration of the Community trade mark<sup>7</sup>.

1    Ie without prejudice to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 17(2) (which provides that a transfer of the whole of the undertaking includes the transfer of the Community trade mark except where, in accordance with the law governing the transfer, there is agreement to the contrary or circumstances clearly dictate otherwise). Article 17(2) applies to the contractual obligation to transfer the undertaking: art 17(2). The word 'whole' in art 17(2) must be interpreted in a common sense manner, and it is immaterial if the transfer is subject to one or two express exceptions or if the parties transferred the beneficial ownership of parallel UK trade marks but failed to transfer the bare legal title: *My Fotostop Ltd v Fotostop Group Ltd* [2006] EWHC 2729 (Ch), [2007] FSR 453.

2    For the meaning of 'Community trade mark' see PARA 206 ante; and as to the application of these provisions to applications for Community trade marks see PARA 271 note 1 ante.

3    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 17(3).

4    Ibid art 17(1).

5    As to the register see PARA 188 ante.

6    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 17(5). As to the procedure see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 31-32, 35 (all amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). As to the consequences of failing to register a transfer see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 17(6) (see the text and note 7 infra) and art 23 (see PARA 276 post).

Where it is clear from the transfer documents that because of the transfer the Community trade mark is likely to mislead the public concerning the nature, quality or geographical origin of the goods or services in respect of which it is registered, the Office for Harmonisation in the Internal Market must not register the transfer unless the successor agrees to limit registration of the Community trade mark to goods or services in respect of which it is not likely to mislead: art 17(4). As to the Office see PARA 180 et seq ante.

7    Ibid art 17(6). Where there are time limits to be observed vis-à-vis the Office, the successor in title may make the corresponding statements to the Office once the request for registration of the transfer has been received by the Office: art 17(7).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/275. Licensing of Community trade marks.

## **275. Licensing of Community trade marks.**

A Community trade mark<sup>1</sup> may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Community<sup>2</sup>. A licence may be exclusive or non-exclusive<sup>3</sup>. On request of one of the parties the grant or transfer of a licence in respect of a Community trade mark must be entered in the register<sup>4</sup> and published<sup>5</sup>.

Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement<sup>6</sup> of a Community trade mark only if its proprietor consents to it<sup>7</sup>. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period<sup>8</sup>.

For the purpose of obtaining compensation for damage suffered by him, a licensee is entitled to intervene in infringement proceedings brought by the proprietor of the Community trade mark<sup>9</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 22(1). As to the dangers of licensing in this way see PARA 129 note 9 ante. The proprietor of a Community trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form covered by the registration in which the trade mark may be used, the scope of the goods or services for which the licence is granted, the territory in which the trade mark may be affixed, or the quality of the goods manufactured or of the services provided by the licensee: art 22(2).

3 Ibid art 22(1). The Regulation contains no definition of an exclusive licence: cf the Trade Marks Act 1994 s 29(1); and PARA 137 ante.

4 As to the register see PARA 188 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 22(5). As to the procedure see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 33-35 (rr 33, 35 amended, and r 34 substituted, by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). As to the consequences of failing to register a licence see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 23; and PARA 276 post.

6 As to infringement proceedings see PARA 257 et seq ante; and as to the grounds on which such proceedings may be brought see PARA 224 et seq ante.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 22(3).

8 Ibid art 22(3).

9 Ibid art 22(4).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(7) COMMUNITY TRADE MARKS AS OBJECTS OF PROPERTY; ASSIGNMENT AND LICENSING/276. Effects of dealings in Community trade marks vis-à-vis third parties.

## **276. Effects of dealings in Community trade marks vis-à-vis third parties.**

Certain legal acts<sup>1</sup> concerning a Community trade mark<sup>2</sup> only have effects vis-à-vis third parties in all the member states after entry in the register<sup>3</sup>. Nevertheless, such an act, before it is so entered, has effect vis-à-vis third parties who have acquired rights in the trade mark after the date of that act but who knew of the act at the date on which the rights were acquired<sup>4</sup>.

The above provisions<sup>5</sup> do not apply in the case of a person who acquires the Community trade mark or a right concerning the Community trade mark by way of transfer of the whole of the undertaking or by any other universal succession<sup>6</sup>.

1    Ie the legal acts referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 17 (transfer of Community trade marks: see PARA 274 ante), art 19 (security and rights in rem: see PARA 271 ante) and art 22 (licensing of Community trade marks: see PARA 275 ante).

2    For the meaning of 'Community trade mark' see PARA 206 ante; and as to the application of these provisions to applications for Community trade marks see PARA 271 note 1 ante.

3    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 23(1). As to the register see PARA 188 ante.

4    Ibid art 23(1). The effect of these provisions is that a successor in title to a Community trade mark or right in it is bound by a licence already granted if: (1) the licence was registered; (2) he has notice of it; or (3) he acquired the Community trade mark by way of transfer of the whole of the undertaking or by any other universal succession. Accordingly, where EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) refers to the 'consent' of the proprietor, this should be read as including a case where the proprietor is bound by a licence under these provisions. Such a position is expressly provided for by the Trade Marks Act 1994 s 28(3): see PARA 136 notes 3, 6 ante.

As to the effects of levy of execution of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 23(3); and PARA 271 note 4 ante.

5    Ie ibid art 23(1).

6    Ibid art 23(2). See also note 4 supra.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(i) In general/277. Introduction.

## **(8) PROCEDURE IN THE OFFICE**

### **(i) In general**

#### **277. Introduction.**

The Community Trade Mark Regulation<sup>1</sup> and the Implementing Regulation<sup>2</sup> provide for detailed rules of procedure for proceedings in the Office for Harmonisation in the Internal Market<sup>3</sup>, relating to applications<sup>4</sup> for Community trade marks<sup>5</sup>, opposition proceedings<sup>6</sup>, applications for revocation or a declaration of invalidity<sup>7</sup> and appeals<sup>8</sup>. The detail of these procedures is beyond the scope of this work, but a summary follows.

<sup>1</sup> ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

<sup>2</sup> ie EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark. See PARA 178 ante.

<sup>3</sup> As to the Office see PARA 180 et seq ante. General rules of procedure are set out in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 73-78a (arts 78, 81 amended, and arts 77a, 78a added, by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). They provide for the statement of reasons on which decisions are based: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 73. The decision may only be based on reasons or evidence on which the parties concerned have had an opportunity to present their comments: see Case T-79/00 *Rewe Zentral AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-705, [2002] IP & T 533, CFI; Case T-36/01 *Glasverbal v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-3887, [2002] IP & T 684, CFI; but cf Case T-303/03 *Lidl Stiftung & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1917, CFI; Case T-273/02 *Krüger GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1271, [2005] All ER (D) 261 (Apr), CFI). They also provide for the examination of the facts by the Office of its own motion except in proceedings relating to relative grounds for refusal (EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 74(1)); for the Office to have a discretion to disregard facts or evidence not submitted in due time (art 74(2); and see Case C-29/05P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Kaul GmbH* [2007] All ER (D) 226 (Mar), ECJ); for oral proceedings and the taking of evidence (EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 75-76); for notification (art 77); for revocation of decisions where the Office has made an obvious procedural error (art 77a (as so added)); and for the re-establishment of rights or the continuation of proceedings in the event of missed time limits (art 78 (as so amended), art 78a (as so added)). Time limits directly fixed by the legislation, as opposed to those set by the Office, are in principle non-extendible: Case T-232/00 *Chef Revival USA Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-2479, [2002] All ER (D) 60 (Jun), CFI; Case T-388/00 *Institut für Lernsysteme GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-4301, [2002] All ER (D) 340 (Oct), CFI; but see Case T-163/98 *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [1999] ECR II-2383, [1999] All ER (EC) 648 (revsd on other grounds Case C-383/99P *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] Ch 82, [2001] ECR I-6521, ECJ); Case T-308/01 *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-3253, [2003] All ER (D) 155 (Sep), CFI; Case T-164/02 *Kaul GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-3807, [2005] IP & T 392, CFI) (revsd on other grounds Case C-29/05P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Kaul GmbH* [2007] All ER (D) 226 (Mar), ECJ). Provisions relating to costs are provided for in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 81, 82 (art 81 amended by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)); and EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 94 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). Further procedural matters are provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 52-60, 70-73 (rr 53, 59, 72 amended, r 60 substituted, and r 53a added, by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

Detailed provision as to notification by the Office is made by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 61-69 (rr 61, 62, 65, 66 amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)); and provision as to other communications with the Office are provided for by EC Commission



Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 79-80, 82-83 (rr 79-80, 82 amended, and r 83 substituted, by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

In the absence of procedural provisions in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1), EC Commission Regulation 2869/95 (OJ L303, 15.12.95, p 33) on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs), or the rules of procedure of the Boards of Appeal, the Office must take into account the principles of procedural law generally recognised in the member states: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 79.

4 The procedure relating to applications for Community trade marks is provided for by *ibid* arts 25-28 (art 25, 26 as amended), art 36 (as amended), arts 38-41 (art 40 as substituted), arts 44, 44a (as added) and art 45: see PARA 278 *et seq* post.

5 For the meaning of 'Community trade mark' see PARA 206 *ante*.

6 The procedure relating to opposition proceedings is provided for by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 42-43: see PARA 282 post.

7 The procedure relating to applications for revocation or a declaration of invalidity is provided for by *ibid* arts 55-56 (art 56 as amended): see PARAS 289-290 post.

8 The procedure relating to appeals is provided for by *ibid* arts 57-63 (arts 60 as substituted, art 60a as added): see PARAS 291-294 post.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(ii) Applications for a Community Trade Mark/278. Filing of applications.

## **(ii) Applications for a Community Trade Mark**

### **278. Filing of applications.**

An application for a Community trade mark<sup>1</sup> must be filed, at the choice of the applicant:

- 391 (1) at the Office for Harmonisation in the Internal Market<sup>2</sup>; or
- 392 (2) at the central industrial property office of a member state or at the Benelux Trade Mark Office<sup>3</sup>.

Where the application is filed as mentioned in head (2) above, the office mentioned there must take all steps to forward the application to the Office for Harmonisation in the Internal Market within two weeks<sup>4</sup> after filing<sup>5</sup>.

An application<sup>6</sup> for a Community trade mark must contain:

- 393 (a) a request for the registration of a Community trade mark<sup>7</sup>;
- 394 (b) information identifying the applicant<sup>8</sup>;
- 395 (c) a list of the goods or services in respect of which the registration is requested<sup>9</sup>;
- 396 (d) a representation of the trade mark<sup>10</sup>;
- 397 (e) if the applicant has appointed a representative<sup>11</sup>, his name and the address of his place of business<sup>12</sup>;
- 398 (f) where the priority of a previous application is claimed<sup>13</sup>, a declaration to that effect, stating the date on which and the country in or for which the previous application was filed<sup>14</sup>;
- 399 (g) where exhibition priority is claimed<sup>15</sup>, a declaration to that effect, stating the name of the exhibition and the date of the first display of the goods or services<sup>16</sup>;
- 400 (h) where the seniority of one or more earlier trade marks<sup>17</sup> is claimed<sup>18</sup>, a declaration to that effect, stating the member state or member states in or for which the relevant registration was effective, the number of the relevant registration, and the goods or services for which the mark is registered<sup>19</sup>;
- 401 (i) where applicable, a statement that the application is for registration of a Community collective mark<sup>20</sup>;
- 402 (j) specification of languages in which the application has been filed, and the second language<sup>21</sup>;
- 403 (k) the signature of the applicant or his representative in accordance with the relevant rule<sup>22</sup>; and
- 404 (l) where applicable, the request of a search report<sup>23</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to the Office see PARA 180 et seq ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 25(1). An application filed at the central industrial property office of a member state or at the Benelux Trade Mark Office has the same effect as if it had been filed on the same date at the Office for Harmonisation in the Internal Market: art 25(1)(b).

4 Such applications which reach the Office more than two months after filing are deemed to have been filed on the date on which the application reached the Office: *ibid* art 25(3) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 25(2). The central industrial property office or the Benelux Trade Mark Office may charge the applicant a fee which must not exceed the administrative costs of receiving and forwarding the application: art 25(2).

6 The application for a Community trade mark is subject to the payment of the application fee and, when appropriate, of one or more class fees: *ibid* art 26(2). The application fee in the United Kingdom is currently set at £15.00: Community Trade Mark (Fees) Regulations 1995, SI 1995/3175, reg 2.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 26(1)(a), (3); EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(a). If the applicant is applying for a Community collective mark, then the application must indicate this: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 64(1); and PARA 295 post.

8 *Ibid* art 26(1)(b). The application must contain the name, address and nationality of the applicant and the state in which he is domiciled or has his seat or an establishment. Names of natural persons must be indicated by the person's family name and given name or names. Names of legal entities, as well as bodies falling under art 3 (capacity to act: see PARA 192 ante) must be indicated by their official designation and include the legal form of the entity, which may be abbreviated in a customary manner. The telephone numbers, fax numbers, electronic mail address and details of other data communications links under which the applicant accepts to receive communications may be given. Only one address may, in principle, be indicated for each applicant; where several addresses are indicated, only the address mentioned first will be taken into account, except where the applicant designates one of the addresses as an address for service: EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(b) (substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

9 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 26(1)(c). This requirement may be fulfilled by a reference to the list of goods or services of a previous Community trade mark application: EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(c) (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). Goods and services in respect of which Community trade marks are applied for must be classified in conformity with the system of classification provided by the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957 (as revised on 13 May 1977) (Cmnd 6898), as revised and amended: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 28; EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 2(1); Case R 167/1998-1 *San Francisco Challenge's Application* (24 March 1999, unreported), OHIM Board of Appeal; Case R-6/2002-3 *Ratiopharm GmbH's Application* (OJ OHIM 09/03 p 1657), OHIM Board of Appeal. See PARA 370 post. The Office's practice is not to accept descriptions such as 'All goods/services in Class X', but it does accept descriptions comprising the class headings of the Nice Classification which it treats as covering all goods or services comprised within the relevant class or classes (contrary to the view of World Intellectual Property Organisation ('WIPO') and the United Kingdom registry).

The description of goods or services must be comprehensible, clear and precise: Case R 46/1992-2 *Giacomelli Sport SpA's Application* [2000] ETMR 277, OHIM Board of Appeal; *Ratiopharm GmbH's Application* supra; Case C-418/02 *Praktiker Bau- und Heimwerkermärkte AG* [2005] ECR I-5873, ECJ.

10 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 26(1)(d); EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(d). As to the requirement of graphical representation of the trade mark see PARA 57 note 2 ante. As to the method of representing the mark see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 3 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). For example, an application for a three-dimensional mark must contain an indication to that effect and must depict the mark graphically or photographically with no more than six different perspectives (EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 3(4)); similarly, an application for a coloured mark must include a colour representation of the mark and the colours making up the mark must be indicated in words and may include a reference to a recognised colour code (art 1 r 3(5) (as so amended)).

11 As to representation see PARA 192 et seq ante.

12 EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(e). The address of his place of business must be in accordance with art 1 r 1(1)(b): see note 8 supra. If the representative has more than one business address or if there are two or more representatives with different business addresses, the application must indicate which address is the address for service; where such an indication is not made, only the first-mentioned address will be taken into account as an address for service: art 1 r 1(1)(e).

13 *Ie* pursuant to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 30: see PARA 284 post.

14 EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(f).

- 15 le pursuant to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 33: see PARA 285 post.
- 16 EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(g).
- 17 le trade marks registered in a member state, including a trade mark registered in the Benelux countries or registered under international arrangements having effect in a member state.
- 18 le pursuant to EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 34: see PARA 287 post.
- 19 EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 1(1)(h).
- 20 Ibid art 1 r 1(1)(i). As to Community collective marks see PARA 295 et seq post.
- 21 Ibid art 1 r 1(1)(j). As to languages see PARA 185 ante.
- 22 Ibid art 1 r 1(1)(k) (substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). The relevant rule is EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 79: see PARA 277 ante.
- 23 Ibid art 1 r 1(1)(l) (added by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). The search report is referred to in EC Council Regulation 40/94 (OJ L 11, 14.1.94, p 1) art 39(2): see PARA 279 post. The search reports must be prepared using a standard form which contains at least the following information: (1) the name of the central industrial property offices that carried out the search; (2) the number of the trademark applications or registrations mentioned in the search report; (3) the date of application and, if applicable, the date of priority of the trademark applications or registrations mentioned in the search report; (4) the date of registration of the trademarks mentioned in the search report; (5) the name and contact address of the holder of the trademarks applications or registrations mentioned in the search report; (6) a representation of the trademarks applied for or registered mentioned in the search report; and (7) an indication of the classes, according to the Nice Classification, for which the earlier national trademarks are applied for or registered or of the goods and services for which the trademarks mentioned in the search report are either applied for or registered: EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 5a (added by EC Commission Regulation 1041/2005(OJ L172, 5.7.05, p 4)).

The date of filing of a Community trade mark application is the date on which documents containing the information specified in EC Council Regulation 40/94 (OJ L 11, 14.1.94, p 1) art 26(1) (see heads (a)-(d) in the text) are filed with the Office by the applicant or, if the application has been filed with the central office of a member state or with the Benelux Trade Mark Office, with that office, subject to payment of the application fee within a period of one month of filing such documents: art 27; EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 5; and see Case R 7/97-3 *Orange Personal Communications Services Ltd's Application* [1998] ETMR 337, OHIM Board of Appeal.

A Community trade mark application which has been accorded a date of filing is, in the member states, equivalent to a regular national filing, where appropriate with the priority claimed for the Community trade mark application: EC Council Regulation 40/94 (OJ L 11, 14.1.94, p 1) art 32.

## UPDATE

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

### **278 Filing of applications**

NOTE 9--See *Land Securities plc v Registrar of Trade Marks*[2008] EWHC 1744 (Pat), [2009] RPC 159, [2008] All ER (D) 333 (Jul).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(ii) Applications for a Community Trade Mark/279. Consideration of the application.

## **279. Consideration of the application.**

The Office for Harmonisation in the Internal Market<sup>1</sup> must examine whether the Community trade mark<sup>2</sup> application satisfies the prescribed<sup>3</sup> requirements<sup>4</sup>; and provision is made for the correction of deficiencies which can be corrected<sup>5</sup>.

Once the Office has accorded a date of filing to the application<sup>6</sup> and has established that the applicant is entitled to be the proprietor of a Community trade mark<sup>7</sup>, it must:

- 405 (1) examine the application for compliance with the absolute grounds<sup>8</sup> for refusal of registration<sup>9</sup>; and
- 406 (2) conduct a search<sup>10</sup> of earlier trade marks which may be invoked against the application<sup>11</sup>.

Thereafter, the application must be published to the extent that it is not refused<sup>12</sup>, and third parties may comment upon the application<sup>13</sup>.

Where a trade mark is ineligible for registration<sup>14</sup> in respect of some or all of the goods or services covered by the Community trade mark application, the application must be refused as regards those goods or services<sup>15</sup>.

1 As to the Office see PARA 180 et seq ante.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 le (1) the requirements for the accordance of a date of filing in accordance with EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 27 (see PARA 278 note 23 ante); (2) the conditions laid down in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) and in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark; and (3) where appropriate, the payment of the class fees within the prescribed period: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 36(1) (amended by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 36(1) (as amended: see note 3 supra).

5 See ibid art 36(2)-(7). As to the general procedural provisions for proceedings in the Office see PARA 277 note 3 ante. Examination is undertaken by the examiners: see PARA 182 ante.

6 le in accordance with ibid art 27: see PARA 278 note 23 ante. A decision to grant a filing date cannot be revoked: Case R 78/1998-1 *Notetry Ltd's Application* [1999] ETMR 435, OHIM Board of Appeal; Case R 157/1998-3 *Chemisphere UK Inc's Application* [1999] ETMR 999, OHIM Board of Appeal. A refusal to grant a filing date may be challenged on appeal: Case R 227/1998-3 *Beta-Film GmbH & Co's Application* (30 April 1999, unreported), OHIM Board of Appeal; Case R 143/1998-1 *Vitabiotics Ltd's Application* (OJ OHIM 01/00 p 144), OHIM Board of Appeal.

7 As to the persons who may be the proprietor of a Community trade mark see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 5 (as substituted); and PARA 207 ante.

8 For the absolute grounds for refusal of registration see ibid art 7; and PARA 209 et seq ante.

9 See ibid art 38; and EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 9-11 (r 10 amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

Where the trade mark contains an element which is not distinctive, and where the inclusion of the said element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the Office may

request, as a condition for registration of the said trade mark, that the applicant state that he disclaims any exclusive right to such element; and any disclaimer must be published together with the application or the registration of the Community trade mark, as the case may be: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 38(2). Disclaimers are not common in Office practice; cf disclaimers under the Trade Marks Act 1994 s 13: see PARA 83 ante.

The Office is not bound to follow decisions by member states on the absolute grounds prohibiting registrability (see PARA 209 et seq ante), and must in each case make its own assessment as to the existence of such grounds. However such decisions may be taken into account: see Case C-218/01 *Henkel KGaA v Deutsches Patent und Markenamt* [2004] ECR I-1725, ECJ. Nor is the Office bound to follow its own earlier decisions: Case T-106/00 *Streamserve Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-723, [2003] IP & T 439, CFI (affd on other grounds Case C-150/02P *Streamserve Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-1461, ECJ); Case T-323/00 *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market* [2003] ECR II-2839, CFI (revsd on other grounds Case C-329/02P *SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-8317, [2005] IP & T 943, ECJ).

10 Provision for searching is made in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 39: see text and notes 11-12 infra. This provision is substituted as from 10 March 2008 by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

11 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 39(1). This provision is substituted as from 10 March 2008 by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1), removing the requirement that an applicant be eligible to be the proprietor of a Community trade mark under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 5 (as substituted) (see PARA 207 ante).

The Office must, as soon as the Community trade mark application has been accorded a date of filing, transmit a copy thereof to the central industrial property office of each member state which has informed the Office of its decision to operate a search in its own register of trade marks in respect of Community trade mark applications: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 39(2). This provision is substituted as from 10 March 2008 by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1), adding the conditions that, at the time of filing a Community trade mark application, the applicant must request that a search report also be prepared by the central industrial property offices of the member states and that the appropriate search fee must have been paid within the time limit for the payment of the filing fee.

12 If the conditions which the application for a Community trade mark must satisfy have been fulfilled and if the period referred to in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 39(7) has expired, the application must be published to the extent that it has not been refused pursuant to art 38 (see the text and notes 14-15 infra): art 40(1) (art 40 substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). Where, after publication, the application is refused under EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 38, the decision that it has been refused must be published upon becoming final: art 40(2) (as so substituted). As to publication of the application see further EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 12 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

13 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) provides that following the publication of the Community trade mark application, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may submit to the Office written observations, explaining on which grounds under art 7 (absolute grounds for refusal of registration: see PARA 209 et seq ante), in particular, the trade mark must not be registered ex officio: art 41(1). Such persons must not be parties to the proceedings before the Office: art 41(1). The observations mentioned above must be communicated to the applicant, who may comment on them: art 41(2). This is an important procedure, because it is the only way in which third parties can raise absolute grounds for refusal against an application (which cannot be raised in opposition proceedings: see PARA 282 post).

14 *Ibid* under *ibid* art 7: see PARA 209 et seq ante.

15 *Ibid* art 38(1). However, the application may not be refused before the applicant has been given the opportunity of withdrawing or amending his application or submitting his observations: art 38(3).

## UPDATE

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(ii) Applications for a Community Trade Mark/280. Withdrawal, restriction and amendment of the application.

## **280. Withdrawal, restriction and amendment of the application.**

The applicant may at any time<sup>1</sup> withdraw<sup>2</sup> his Community trade mark<sup>3</sup> application or restrict<sup>4</sup> the list of goods or services<sup>5</sup> contained in it. Where the application has already been published, the withdrawal or restriction must also be published<sup>6</sup>.

In other respects, a Community trade mark application may be amended, upon request of the applicant, only by correcting the name and address of the applicant, errors of wording or of copying, or obvious mistakes, provided that such correction does not substantially change the trade mark or extend the list of goods or services<sup>7</sup>. Where the amendments affect the representation of the trade mark or the list of goods or services and are made after publication of the application, the trade mark application must be published as amended<sup>8</sup>.

1 Restrictions and amendments may be made on appeal: Case T-289/02 *Telepharmacy Solutions Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-2851, [2004] All ER (D) 122 (Jul), CFI; Case R 544/2002-1 *EarthLink Network Inc v Stamer Musikanlagen GmbH* (17 December 2003, unreported), OHIM Board of Appeal.

2 The withdrawal of an application for a Community trade mark must be made expressly and unconditionally by the applicant: Case T-219/00 *Ellos v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-753, [2002] IP & T 384, CFI; Joined Cases T-466/04 and T-467/04 *Dami v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR II-183, [2006] All ER (D) 09 (Feb), CFI.

3 For the meaning of 'Community trade mark' see PARA 206 ante.

4 Whether an amendment restricts the list of goods or services is a question of substance not form: see Case R-517/2001-1 *Financial Interactive Inc's Application* (OJ OHIM 01/03 p 33), OHIM Board of Appeal.

5 As to the list of goods or services see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 28; EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 2(1); and PARA 278 note 9 ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 44(1). The procedure for such amendment is provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 13 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). A request to amend the application to restrict the list of goods or services must be made expressly and unconditionally: Case T-219/00 *Ellos v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-753, [2002] IP & T 384, CFI; Case T-396/02 *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-3821, [2004] All ER (D) 157 (Nov), CFI; Case C-412/05 *Alcon Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 238 (Apr), ECJ.

7 As to the circumstances in which a typographical error in the trade mark applied for may be corrected see Case T-128/99 *Signal Communications Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2001] ECR II-3273, CFI (TELEYE amended to TELEEYE). Cf the approach under the Trade Marks Act 1994 s 39: see PARA 375 post.

8 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 44(2). As to the procedure for such amendment see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 14. As to publication see PARA 190 ante.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**



Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(ii) Applications for a Community Trade Mark/281. Division of the application.

## **281. Division of the application.**

The applicant may divide the application by declaring that some of the goods or services included in the original application will be the subject of one or more divisional applications<sup>1</sup>. The goods or services in the divisional application must not overlap with the goods or services which remain in the original application or those which are included in other divisional applications<sup>2</sup>.

Division is not permissible:

- 407 (1) if, where an opposition<sup>3</sup> has been entered against the original application, such a divisional declaration has the effect of introducing a division amongst the goods or services against which the opposition has been directed, until the decision of the Opposition Division<sup>4</sup> has become final or the opposition proceedings are finally terminated otherwise<sup>5</sup>;
- 408 (2) during the periods laid down in the Implementing Regulation<sup>6</sup>.

1 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 44a(1) (art 44a added by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). The declaration must comply with the provisions set out in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark (the 'Implementing Regulation'): EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 44a(3) (as so added). The declaration is subject to a fee and must be deemed not have been made until the fee is paid: art 44a(4) (as so added). As to the procedure for the division of an application see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 13a (added by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

Division of a Community trade mark registration is also possible: see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 48a(1) (as added); and PARA 249 ante. Under the Trade Marks Act 1994 s 41(1) only division of an application, and not division of a registration, is permitted: see PARA 367 post.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 44a(1) (as added: see note 1 ante).

3 As to oppositions see PARA 282 post.

4 As to the Opposition Division see PARA 182 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 44a(2)(a) (as added: see note 1 ante).

6 Ibid art 44a(2)(b) (as added: see note 1 ante). As to the Implementing Regulation see note 1 supra.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

## **281 Division of the application**

NOTE 1-- Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 13a amended: EC  
Commission Regulation 355/2009 (OJ L109, 30.4.2009, p 3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(ii) Applications for a Community Trade Mark/282. Opposition.

## **282. Opposition.**

Within a period of three months following the publication<sup>1</sup> of a Community trade mark<sup>2</sup> application<sup>3</sup>, notice of opposition to registration of the trade mark may be given on the grounds that it may not be registered by reason of one of the relative grounds for refusal of registration<sup>4</sup>:

- 409 (1) by the proprietors of earlier trade marks<sup>5</sup>, as well as licensees authorised by the proprietors of those trade marks, in respect of the relevant grounds<sup>6</sup>;
- 410 (2) by the proprietors of trade marks, whose agents or representatives have applied to register the trade mark in their own names<sup>7</sup>;
- 411 (3) by the proprietors of earlier marks or signs<sup>8</sup> and by persons authorised under the relevant national law to exercise such rights<sup>9</sup>.

Opposition must be expressed in writing and must specify the grounds on which it is made<sup>10</sup>.

If the applicant so requests,<sup>11</sup> the proprietor of an earlier Community trade mark or an earlier national trade mark who has given notice of opposition must furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier trade mark had been put to genuine use<sup>12</sup> in the Community<sup>13</sup> or in the member state in question, as the case may be, in connection with goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons<sup>14</sup> for non-use, provided that the earlier trade mark has been registered for not less than five years<sup>15</sup>. In absence of proof to that effect, the opposition must be rejected<sup>16</sup>. If the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it is, for the purposes of the examination of the opposition, deemed to be registered in respect of only that part of the goods or services<sup>17</sup>.

The Office for Harmonisation in the Internal Market may, if it thinks fit, invite the parties to an opposition to make a friendly settlement<sup>18</sup>; otherwise it must consider and rule upon the opposition<sup>19</sup>. If examination of the opposition reveals that the trade mark may not be registered in respect of some or all of the goods or services for which the Community trade mark application has been made, the application must be refused in respect of those goods or services; otherwise, the opposition must be rejected<sup>20</sup>.

1 As to publication of Community trade mark applications see PARA 279 note 12 ante.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 Notice of opposition to registration of the trade mark may also be given, subject to the same conditions, in the event of the publication of an amended application in accordance with EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 44(2): see PARA 280 text and note 8 ante.

4 Ibid art 42(1). As to the relative grounds of refusal see art 8; and PARA 218 et seq ante. Absolute grounds for refusal (ie under art 7: see PARA 209 et seq ante) cannot be raised in opposition proceedings, instead they must be raised by way of third party observations under art 41: see PARA 279 note 13 ante.

5 Ie trade marks referred to in ibid art 8(2): see PARA 218 ante. An earlier trade mark is presumed to be valid, and it is not open to the applicant to argue that the earlier trade mark is invalid eg by virtue of other national rights in the member state concerned: Case R 723/2001-2 *Barocco Roma Srl v Moda Nuova Fashion AB* (16 December 2003, unreported), OHIM Board of Appeal.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 42(1)(a). The relevant grounds are those under art 8(1) (see PARAS 219-220 ante) and art 8(5) (see PARA 221 ante): art 42(1)(a).

7 Ibid art 42(1)(b). The trade marks concerned are those referred to in art 8(3) (see PARA 223 ante): art 42(1)(b).

8 I.e. earlier marks or sign referred to in ibid art 8(4): see PARA 222 ante.

9 Ibid art 42(1)(c). As to the form and contents of the notice of opposition see further EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 15 (substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). An earlier trade mark is sufficiently identified in the notice of opposition if the notice states the registration number and the member state in which it is registered: Case T-186/04 *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-2333, [2005] All ER (D) 143 (Jun), CFI. The Office for Harmonisation in the Internal Market treats questions of national law (such as passing off) as issues of fact which must be proved by evidence: Guidelines concerning proceedings before OHIM Part C, Ch 4, PARA 5.4 (OJ OHIM 05/03 p 1097). As to the Office see PARA 180 et seq ante.

10 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 42(3). It must not be treated as duly entered until the opposition fee has been paid: art 42(3). Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments: art 42(3). The notice of opposition must state the grounds on which opposition is based, whereas the submission of facts, evidence and arguments is, at this stage, merely optional: Case T-232/00 *Chef Revival USA Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-2749, [2002] All ER (D) 60 (Jun), CFI; Case T-53/05 *Calavo Growers Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 80 (Jan), CFI. It is sufficient for this purpose to state 'the opposition is based on a likelihood of confusion' or to tick the relevant box on the official form: Case T-53/05 *Calavo Growers Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* supra. Where black and white copies of notices of opposition were transmitted to the Office by fax before the expiry of the opposition period and colour originals were sent by post promptly thereafter, the oppositions were in time even though the originals arrived after the expiry of the period: Joined Cases T-239/05, T-240/05, T-245/05 to T-247/05, T-255/05, T-274/05 to T-280/05 *Black & Decker Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 221 (May).

In the examination of the opposition the Office must invite the parties, as often as necessary, to file observations within a period set them by the Office, on communications issued by the other parties or issued by itself: art 43(1). Failure by the applicant to file observations may be interpreted as an implied withdrawal of the application: Case R 406/2004-2 *Erico International Corp v Laytoncrest Ltd* (26 April 2006, unreported), OHIM Board of Appeal.

11 The applicant must make any such request within the period specified by the Office for filing his observations on the opposition: EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 22(1) (art 1 r 22 substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). See also Case T-112/03 *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-949, [2005] All ER (D) 267 (Mar), CFI; affd on other grounds Case C-235/05P *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-57, ECJ.

12 As to genuine use see PARA 114 note 6 ante.

13 As to the meaning of 'in the Community' see PARA 237 note 5 ante.

14 As to the meaning of 'proper reasons' see PARA 114 note 10 ante.

15 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 43(2), (3). As to the procedure to be followed in the event of a request for proof of use, and the nature and form that evidence of use must take, see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 22 (as substituted: see note 11 supra). These provisions are of considerable practical importance and there are a number of decisions of the CFI interpreting them. See in particular Case T-334/01 *MFE Marienfelde GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-2787, [2004] All ER (D) 125 (Jul), CFI; Case T-203/02 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-2811, [2004] All ER (D) 129 (Jul), CFI (affd Case C-416/04P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4267, [2006] All ER (D) 178 (May), ECJ); Case T-356/02 *Vitakraft-Werke Wuhrmann & Sohn GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-3445, [2004] All ER (D) 54 (Oct), CFI; Case T-303/03 *Lidl Stiftung & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1917, CFI. It should be noted that the Office takes a very exacting view indeed of what is required to prove use of a trade mark, and in particular that it considers that evidence in the form of an affidavit or witness statement by a representative of the proprietor is of little weight unless corroborated by independent evidence: see eg Case R 1075/2005-2 *Rodcraft Pneumatic Tools*

*GmbH & Co KG v Rolson Tools Ltd* (8 June 2006, unreported), OHIM Board of Appeal; and cf *Rolson Tools Ltd's Trade Mark Application* (O/011/06), Appointed Person.

16 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 43(2), (3).

17 Ibid art 43(2), (3).

18 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 43(4).

19 Procedural provisions for oppositions are provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 16-22 (rr 16-20, 22 substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). These provide inter alia for a two month 'cooling off period' once the opposition has been ascertained to be admissible: EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 r 19 (as so substituted). Oppositions are the responsibility of the Opposition Divisions of the Office: see PARA 182 ante. As to the general procedural provisions for proceedings in the Office see PARA 277 note 3 ante. The opposition division is not obliged to reject an opposition as unfounded where the opponent's grounds of opposition contain the essential information for assessing its objection, even if the explanation of those grounds has not been translated into the correct language: Case T-53/05 *Calavo Growers Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 80 (Jan), CFI.

20 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 43(5). The decision refusing the application must be published upon becoming final: art 43(6). If an opposition based upon several earlier trade marks or rights is upheld with regard to one such trade mark or right, the Office is not required to rule upon the remaining trade marks or rights: Case T-342/02 *Metro-Goldwyn-Mayer Lion Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-3191, [2004] All ER (D) 113 (Sep), CFI; Case R 497/2004-1 *Teletch Holdings Inc v Teletch International SA* (3 March 2005, unreported), OHIM Board of Appeal.

## UPDATE

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(ii) Applications for a Community Trade Mark/283. Registration and renewal.

### **283. Registration and renewal.**

Where an application meets the prescribed requirements<sup>1</sup> and where no notice of opposition<sup>2</sup> has been given within the prescribed period<sup>3</sup>, or where opposition has been rejected by a definitive decision<sup>4</sup>, the trade mark must be registered<sup>5</sup> as a Community trade mark<sup>6</sup>.

Community trade marks are registered for a period of ten years from the date of filing<sup>7</sup> of the application; and registration may be renewed<sup>8</sup> for further periods of ten years<sup>9</sup>.

1    Ie the requirements of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark.

2    As to the notice of opposition see *ibid* art 42; and PARA 282 ante.

3    Ie the period referred to in *ibid* art 42(1): see PARA 282 ante.

4    As to the examination of the opposition see *ibid* art 43; and PARA 282 text and note 15 ante.

5    No definition of 'registered' is provided for by EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), although that term is used extensively (cf the Trade Marks Act 1994 s 63(1): see PARA 19 note 2 ante). 'Registered' in the context of a Community trade mark must therefore mean registered in accordance with these provisions, in particular EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 45. As to the register of Community trade marks see PARA 188 ante.

6    *Ibid* art 45. The trade mark will only be registered provided that the registration fee has been paid within the period prescribed; if the fee is not paid within this period the application is deemed to be withdrawn: art 45. Further provision for registration is provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1)) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 23-24 (r 24 amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). For the meaning of 'Community trade mark' see PARA 206 ante.

7    As to the date of filing see PARA 278 note 23 ante.

8    Ie in accordance with the following provisions: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 46. The Office for Harmonisation in the Internal Market must inform the proprietor of the Community trade mark, and any person having a registered right in respect of the Community trade mark, of the expiry of the registration in good time before the said expiry; but failure to give such information does not involve the responsibility of the Office: art 47(2). Registration of the Community trade mark must be renewed at the request of the proprietor of the trade mark or any person expressly authorised by him, provided that the fees have been paid: art 47(1). Renewal takes effect from the day following the date on which the existing registration expires; and the renewal must be registered: art 47(5). As to the Office see PARA 180 et seq ante.

The request for renewal must be submitted within a period of six months ending on the last day of the month in which protection ends; the fees must also be paid within this period; failing this, the request may be submitted and the fees paid within a further period of six months following the last day of the month in which protection ends, provided that an additional fee is paid within this further period: art 47(3). Where the request is submitted or the fees paid in respect of only some of the goods or services for which the Community trade mark is registered, registration must be renewed for those goods or services only: art 47(4).

Further procedural rules relating to notification of expiry and renewal are provided for by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 29, 30 (r 30 substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

9    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 46.

### **UPDATE**

**271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(iii) Priority and Seniority/284. Right of priority.

### **(iii) Priority and Seniority**

#### **284. Right of priority.**

A person who has duly filed an application for a trade mark in or for any state party to the Paris Convention<sup>1</sup> or to the WTO Agreement<sup>2</sup>, or his successors in title, enjoys, for the purpose of filing a Community trade mark<sup>3</sup> application for the same trade mark in respect of goods or services which are identical with or contained within those for which the application has been filed, a right of priority<sup>4</sup> during a period of six months from the date of filing of the first application<sup>5</sup>.

Every filing that is equivalent to a regular national filing<sup>6</sup> under the national law of the state where it was made or under bilateral or multilateral agreements must be recognised as giving rise to a right of priority<sup>7</sup>.

If the first filing has been made in a state which is not a party to the Paris Convention or the WTO Agreement, the provisions described above<sup>8</sup> apply only in so far as that state, according to published findings<sup>9</sup>, grants, on the basis of a first filing made at the Office for Harmonisation in the Internal Market<sup>10</sup> and subject to equivalent conditions<sup>11</sup>, a right of priority having equivalent effect<sup>12</sup>.

An applicant desiring to take advantage of the priority of a previous application must file a declaration of priority and a copy of the previous application<sup>13</sup>.

1 As to the Paris Convention see PARA 6 ante.

2 As to the WTO Agreement see PARA 7 ante.

3 For the meaning of 'Community trade mark' see PARA 206 ante.

4 As to the effect of the priority right see PARA 286 post.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 29(1) (amended by EC Council Regulation 3288/94 (OJ L349, 31.12.94, p 83)). A subsequent application for a trade mark which was the subject of a previous first application in respect of the same goods or services, and which is filed in or in respect of the same state must be considered as the first application for the purposes of determining priority, provided that, at the date of filing of the subsequent application, the previous application has been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and has not served as a basis for claiming a right of priority; and the previous application may not thereafter serve as a basis for claiming a right of priority: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 29(4).

6 A regular national filing means any filing that is sufficient to establish the date on which the application was filed, whatever may be the outcome of the application: *ibid* art 29(3). As to filing an application under the Trade Marks Act 1994 see PARA 363 et seq post.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 29(2).

8 *le ibid* art 29(1)-(4).

9 As to the publication of such findings see PARA 204 ante.

10 As to the Office see PARA 180 et seq ante.

11 *le* conditions equivalent to those laid down in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

12 Ibid art 29(5) (amended by EC Council Regulation 3288/94 (OJ L349, 31.12.94, p 83)).

13 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 30. If the language of the latter is not one of the languages of the Office, the applicant must file a translation of the previous application in one of those languages: art 30. As to the languages of the Office see PARA 185 ante. Further procedural requirements are laid down in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 6 (amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(iii) Priority and Seniority/285. Exhibition priority.

## **285. Exhibition priority.**

If an applicant for a Community trade mark<sup>1</sup> has displayed goods or services under the mark applied for, at a recognised international exhibition<sup>2</sup>, he may, if he files the application within a period of six months from the date of the first display of the goods or services under the mark applied for, claim a right of priority<sup>3</sup> from that date<sup>4</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 I.e. an official or officially recognised international exhibition: (1) falling within the terms of the Convention relating to International Exhibitions (Paris, 22 November 1928; TS 9 (1931); Cmd 3776), as amended and supplemented by any Protocol to that Convention which is in force; or (2) falling within the terms of any subsequent treaty or convention replacing that Convention: Patents Act 1977 s 130(1). The Convention has been supplemented by Protocols, all signed at Paris, dated 10 May 1948 (TS 57 (1951); Cmd 8311), 16 November 1966 (TS 14 (1968); Cmd 3557), and 30 November 1972 (Misc 14 (1973); Cmd 5317), although the latest Protocol is not in force.

3 As to the effect of a right of priority see PARA 286 post.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 33(1). Further procedural requirements are laid down in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 7. An applicant who wishes to claim priority pursuant to this provision must file evidence of the display of goods or services under the mark applied for under the conditions laid down in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1): EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 33(2).

An exhibition priority granted in a member state or in a third country does not extend the period of priority laid down in art 29 (see PARA 284 ante): art 33(3).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(iii) Priority and Seniority/286. Effect of priority right.

## **286. Effect of priority right.**

The right of priority<sup>1</sup> has the effect that the date of priority counts as the date of filing of the Community trade mark application for the purposes of establishing which rights take precedence<sup>2</sup>.

1 As to the claiming of a right of priority see EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 29-30 (see PARA 284 ante), art 33 (see PARA 285 ante).

2 Ibid art 31. It is necessary to establish rights to priority for the purpose of resolving conflicts with other applications or with conflicting national rights such as those mentioned in art 8: see PARA 218 et seq ante.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(iii) Priority and Seniority/287. Claiming the seniority of a national trade mark.

### **287. Claiming the seniority of a national trade mark.**

The proprietor<sup>1</sup> of an earlier trade mark<sup>2</sup> registered in a member state<sup>3</sup>, or registered under international arrangements having effect in a member state<sup>4</sup>, who applies for an identical trade mark for registration as a Community trade mark<sup>5</sup> for goods or services which are identical with or contained within those for which the earlier trade mark has been registered, may claim for the Community trade mark the seniority<sup>6</sup> of the earlier trade mark in respect of the member state in or for which it is registered<sup>7</sup>.

The proprietor of a Community trade mark who is the proprietor of an earlier identical<sup>8</sup> trade mark registered in a member state<sup>9</sup> or of an earlier identical trade mark with an international registration effective in a member state<sup>10</sup> for goods or services which are identical with those for which the earlier trade mark has been registered or contained within them may claim the seniority of the earlier trade mark in respect of the member state in or for which it is registered<sup>11</sup>.

1 In this context the proprietor is the legal owner of the senior mark, whether or not he is also the registered proprietor: Case R 5/97-1 *BatMark Inc's Application* [1998] ETMR 448, OHIM Board of Appeal.

2 For the meaning of 'earlier trade mark' see PARA 218 ante.

3 I.e. including a trade mark registered in the Benelux countries.

4 I.e. such as international trade marks which are protected in member states pursuant to the Madrid Agreement or Madrid Protocol: see PARA 8 ante.

5 For the meaning of 'Community trade mark' see PARA 206 ante.

6 For the effect of seniority see PARA 288 post.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 34(1). As to the procedure for the claiming of seniority see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 8, 28 (both amended by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

8 In Case R-10/1998-2 *International Business Machines Corp'n's Application* [1998] ETMR 642, OHIM Board of Appeal, it was held that THINKPAD was identical to THINK PAD for this purpose. This is consistent with the subsequent jurisprudence of the European Court of Justice as to the meaning of 'identical': see PARA 71 note 3 ante.

9 See note 3 supra.

10 See note 4 supra.

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 35(1) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). Thus seniority may be claimed either when the Community trade mark is applied for (i.e. under art 34(1): see the text and notes 1-7 supra) or at any time after registration (i.e. under art 35(1) (as substituted)). The right to claim the seniority of an earlier national trade mark continues to exist, without limitation of time, after the registration of the mark: see Case R 5/97-1 *BatMark Inc's Application* [1998] ETMR 448, OHIM Board of Appeal.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(iii) Priority and Seniority/288. Effect of seniority.

## 288. Effect of seniority.

Seniority<sup>1</sup> has the sole effect that, where the proprietor of the Community trade mark<sup>2</sup> surrenders the earlier trade mark<sup>3</sup> or allows it to lapse, he is deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered<sup>4</sup>.

Where the proprietor of a Community trade mark claims the seniority of a registered trade mark<sup>5</sup> which has been removed from the register<sup>6</sup> or has been surrendered<sup>7</sup>, application may be made to the registrar<sup>8</sup> or to the court<sup>9</sup> by any person for a declaration that, if the registered trade mark had not been so removed or surrendered, it would have been liable to be revoked<sup>10</sup> or declared<sup>11</sup> invalid<sup>12</sup>.

The seniority claimed for the Community trade mark lapses if the earlier trade mark the seniority of which is claimed is declared to have been revoked or to be invalid or if it is surrendered prior to the registration of the Community trade mark<sup>13</sup>.

1 As to claiming seniority see PARA 287 ante.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 Ie the trade mark upon which seniority is based: see PARA 287 ante.

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 34(2), 35(2). See also Case R1219/2000-3 *Sara Lee/DE Espana SA v Health Products Ltd* (17 October 2001, unreported), OHIM Board of Appeal; *RAPIER Trade Mark* (O/170/07), Appointed Person.

5 Ie a trade mark registered under the Trade Marks Act 1994. As to the meaning of 'registered trade mark' see PARA 127 ante.

6 Ie under *ibid* s 43: see PARA 29 ante. As to the register (ie the register maintained pursuant to s 63) see PARA 19 ante.

7 Ie pursuant to *ibid* s 45: see PARA 395 ante.

8 As to the registrar see PARA 17 ante.

9 For the meaning of 'the court' see PARA 349 post.

10 Ie under the Trade Marks Act 1994 s 46: see PARA 114 et seq ante.

11 Ie under *ibid* s 47: see PARA 118 et seq ante.

12 Community Trade Mark Regulations 2006, SI 2006/1027, reg 3(1), (3). Application may likewise be made where such a proprietor claims the seniority of an international trade mark (UK) (see PARA 8 note 17 ante): reg 3(2). Where a registered trade mark has been surrendered in respect of some only of the goods or services for which it is registered, these provisions apply in relation to those goods or services: reg 3(5). An address for service (see PARA 357 post) must be filed by the person making the application and by the proprietor of the Community trade mark unless the registrar otherwise directs: reg 3(4). The Trade Mark Rules 2000, SI 2000/136, rr 31-37, 54-62, 67-69, 72 (see PARAS 354 et seq post and 398 et seq post) apply to such proceedings before the registrar with the necessary modifications: Community Trade Mark Regulations 2006, SI 2006/1027, reg 4(2).

13 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) arts 34(3), 35(2).

## UPDATE

## **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

## **288 Effect of seniority**

NOTE 12--SI 2006/1027 amended: SI 2008/1959. SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(iv) Proceedings relating to Revocation or Invalidity/289. Application for revocation or for a declaration of invalidity.

#### **(iv) Proceedings relating to Revocation or Invalidity**

##### **289. Application for revocation or for a declaration of invalidity.**

An application for revocation<sup>1</sup> of the rights of the proprietor of a Community trade mark<sup>2</sup> or for a declaration that the trade mark is invalid<sup>3</sup> may be submitted<sup>4</sup> to the Office for Harmonisation in the Internal Market<sup>5</sup> by the following persons<sup>6</sup>:

- 412 (1) where the application is for revocation<sup>7</sup> or for a declaration of invalidity on absolute grounds<sup>8</sup>, by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, which under the terms of the law governing it has the capacity in its own name to sue and be sued<sup>9</sup>;
- 413 (2) where the application is for a declaration of invalidity on relative grounds relating to an earlier trade mark or protected sign<sup>10</sup>, by the relevant persons<sup>11</sup>;
- 414 (3) where the application is for a declaration of invalidity on relative grounds relating to some other earlier right<sup>12</sup>, by the owners of the earlier rights or by the persons who are entitled under the law of the member state concerned to exercise the rights in question<sup>13</sup>.

The application must be filed in a written reasoned statement<sup>14</sup>.

1 As to the grounds for revocation see PARAS 237-240 ante; and as to the additional grounds for revocation of a Community collective mark see PARA 300 post.

2 For the meaning of 'Community trade mark' see PARA 206 ante.

3 As to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

4 An application for a declaration of invalidity may only be submitted after the Community trade mark has been entered on the register: Decision 89C/000317701/1 *Avensa SA v Mikkelsen* (15 December 1999, unreported), OHIM Cancellation Division.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 55(1). As to the Office see PARA 180 et seq ante. As to the procedure on such an application see PARA 290 post.

6 The list in the text is not exhaustive, because it does not indicate who may make an application for revocation of a Community collective mark on the additional ground specified in *ibid* art 71 (see PARA 300 post) or an application for a declaration of invalidity of a Community collective mark on the additional ground specified in art 72 (see PARA 301 post). Article 71 is similar in concept to art 50(1)(c) (mark liable to mislead in consequence of use: see PARA 240 ante), while art 72 is similar in concept to art 51 (registration granted in breach of absolute grounds: see PARA 243 ante); so perhaps they should both fall within head (1) in the text. An alternative view is that there is no restriction on who may bring an application under arts 71, 72.

7 *Ie* where *ibid* art 50 applies: see PARA 238 et seq ante.

8 *Ie* where *ibid* art 51 applies: see PARA 243 ante.

9 *Ibid* art 55(1)(a).

10 *Ie* where *ibid* art 52(1) applies: see PARA 244 ante.

11 Ibid art 55(1)(b). The relevant persons are those referred to in art 42(1) (see PARA 282 ante): art 55(1)(b). An earlier decision of the Office in opposition proceedings does not preclude a later application for a declaration of invalidity based on the same earlier trade marks or rights: Decision 337C/000510313/1 *Henkel KGaA v Gan* (1 August 2003, unreported), OHIM Cancellation Division. Where the earlier trade mark relied upon falls due for renewal during the cancellation proceedings, the onus is upon the applicant to file evidence that it has been renewed: Decision 58C/000743799/1 *MasterCard International Inc v Regent Associates Ltd* (31 January 2002, unreported), OHIM Cancellation Division.

12 Ie where EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 52(2) applies: see PARA 245 ante.

13 Ibid art 55(1)(c).

14 Ibid art 55(2). The application is not deemed to have been filed until the fee has been paid: art 55(2). An application for revocation or for a declaration of invalidity is inadmissible if an application relating to the same subject matter and cause of action, and involving the same parties, has been adjudicated on by a court in a member state and has acquired the authority of a final decision: art 55(3).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(iv) Proceedings relating to Revocation or Invalidity/290. Examination of the application.

## 290. Examination of the application.

The Office for Harmonisation in the Internal Market<sup>1</sup> may, if it thinks fit, invite the parties to make a friendly settlement<sup>2</sup>; otherwise it must examine and adjudicate upon the application<sup>3</sup>.

If the proprietor of the Community trade mark<sup>4</sup> so requests,<sup>5</sup> the proprietor of an earlier Community trade mark or an earlier national trade mark<sup>6</sup> who is party to the proceedings must furnish proof that, during the period of five years preceding the date of an application for a declaration of invalidity<sup>7</sup>, the earlier trade mark had been put to genuine use<sup>8</sup> in the Community<sup>9</sup> or in the member state in question, as the case may be, in connection with goods or services in respect of which it is registered and which he cites as justification for his application, or that there are proper reasons<sup>10</sup> for non-use, provided that the earlier trade mark has been registered for not less than five years<sup>11</sup>. If, at the date on which the Community trade mark application was published<sup>12</sup>, the earlier trade mark had been registered for not less than five years, the proprietor of the earlier trade mark must furnish proof that, in addition, the specified conditions<sup>13</sup> were satisfied at that date<sup>14</sup>. In the absence of proof to that effect, the application must be rejected<sup>15</sup>. If the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it is, for the purposes of the examination of the application, deemed to be registered in respect of only that part of the goods or services<sup>16</sup>.

If the examination of the application for revocation of rights<sup>17</sup> or for a declaration of invalidity<sup>18</sup> reveals that the trade mark should not have been registered in respect of some or all of the goods or services for which it is registered<sup>19</sup>, the rights of the proprietor of the Community trade mark must be revoked<sup>20</sup> or it must be declared invalid<sup>21</sup> in respect of those goods or services; otherwise the application for revocation of rights or for a declaration of invalidity must be rejected<sup>22</sup>. A record of the Office's decision on the application for revocation of rights or for a declaration of invalidity must be entered in the register<sup>23</sup> once it has become final<sup>24</sup>.

1 As to the Office see PARA 180 et seq ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 56(4).

3 Provision for examination of the application is made by ibid art 56; and by EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 37-41 (r 38 amended, and r 39 substituted, by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). As to the general procedural provisions for proceedings in the Office see PARA 277 note 3 ante. Applications for revocation or for a declaration of invalidity are the responsibility of the Cancellation Divisions: see PARA 182 ante. If the application is withdrawn the proceedings will be terminated; there is no basis for the Office to consider the application ex officio: Decision 55C/000142158/1 *Groupe Sepcon SA v Ziff Davis Publishing Holdings Inc* (5 November 2001, unreported), OHIM Cancellation Division. If, however, the proprietor applies to surrender the Community trade mark, the proceedings must continue: Decision 69C/000670042/1 *Lancôme Parfums et Beauté & Cie's Application* [2001] ETMR 89, OHIM Cancellation Division.

4 For the meaning of 'Community trade mark' see PARA 206 ante.

5 It is presumed that the proprietor must make any such request within the period specified by the Office for making observations on the application: cf Case T-112/03 *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-949, [2005] All ER (D) 267 (Mar), CFI; affd on other grounds Case C-235/05P *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-57, ECJ.

6 This includes national trade marks which do not have to be used under national law because they are defensive registrations: Case T-194/03 *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market*

(*Trade Marks and Designs*) [2006] ECR II-445, CFI. In the United Kingdom defensive registrations were abolished by the Trade Marks Act 1994 s 46(1)(a) (see PARA 114 text and note 9 ante), and it is questionable whether they are consistent with EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the law of the member states relating to trade marks.

7 le where the application is based on relative grounds (as to which see PARA 218 et seq ante).

8 As to genuine use see PARA 114 note 6 ante.

9 As to the meaning of 'in the Community' see PARA 237 note 5 ante.

10 As to the meaning of 'proper reasons' see PARA 114 note 10 ante.

11 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 56(2). Use does not have to be proved if the five year period expires during the course of the cancellation proceedings: Decision 336C/000633214/1 *Parfums Givenchy SA v Flotique NV* (27 October 2003, unreported), OHIM Cancellation Division. As to the procedure to be followed in the event of a request for proof of use, and the nature and form that evidence of use must take, see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) art 1 rr 22(3), (4), 40(6) (all substituted by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)). See also PARA 282 note 15 ante.

12 As to publication see PARA 190 ante.

13 le those in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 43(2): see PARA 282 ante.

14 Ibid art 56(2). In such a case the applicant must prove use in both periods: Decision 332C/000208686/1 *Gorina & Sauquet SA v Performance Sailcraft Europe Ltd* (11 November 2003, unreported), OHIM Cancellation Division; Case R 627/2003-2 *McDonald's International Property Co Ltd v Andros Food SA* (5 July 2004, unreported), OHIM Board of Appeal.

15 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 56(2).

16 Ibid art 56(2).

17 As to the grounds for revocation see PARAS 237-240 ante; and as to the additional grounds for revocation of a Community collective mark see PARA 300 post.

18 As to the grounds of invalidity see PARAS 243-245 ante; and as to the additional ground of invalidity of a Community collective mark see PARA 301 post.

19 Presumably there should be read into this part of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 56(5) words to the effect of 'or that the trade mark should be revoked', since revocation relates to events which occur after a registration: ex hypothesi, the trade mark was rightly registered but should now be revoked. See further PARAS 235, 237 et seq ante.

20 As to the date from which revocation takes effect see PARA 242 ante.

21 As to the effect of a declaration of invalidity see PARA 247 ante.

22 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 56(5).

23 As to the register see PARA 188 ante.

24 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 56(6) (substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

## UPDATE

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(v) Appeals/291. Appeals to the Board of Appeal.

## **(v) Appeals**

### **291. Appeals to the Board of Appeal.**

An appeal lies from decisions<sup>1</sup> of the examiners<sup>2</sup>, the Opposition Divisions<sup>3</sup>, the Administration of Trade Marks and Designs and Legal Division<sup>4</sup>, and the Cancellation Divisions<sup>5</sup>. It has suspensive effect<sup>6</sup>.

Any party to proceedings adversely affected by a decision may appeal; and any other parties to the proceedings are parties to the appeal proceedings as of right<sup>7</sup>.

Notice of appeal must be filed in writing at the Office for Harmonisation in the Internal Market<sup>8</sup> within two months after the date of notification of the decision appealed from<sup>9</sup>. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed<sup>10</sup>.

1 A decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 57(2).

2 As to the examiners see PARA 182 ante.

3 As to the Opposition Divisions see PARA 182 ante.

4 As to the Administration of Trade Marks and Designs and Legal Division see PARA 182 ante.

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 57(1). As to the Cancellation Divisions see PARA 182 ante.

6 Ibid art 57(1).

7 Ibid art 58.

8 As to the Office see PARA 180 et seq ante.

9 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 59. As to the form and content of a notice of appeal see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 48.

The notice is deemed to have been filed only when the fee for appeal has been paid: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 59. As to fees see PARA 184 ante.

10 Ibid art 59. Failure to file a written statement of grounds of appeal is fatal to the admissibility of the appeal: Case T-71/02 *Classen Holding KG v Office for Harmonisation of the Internal Market* [2003] ECR II-3181, [2003] All ER (D) 109 (Sep), CFI.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(v) Appeals/292. Revision of decisions.

## **292. Revision of decisions.**

If the party which has lodged the appeal is the sole party to the proceedings, and if the department whose decision is contested considers the appeal to be admissible and well founded, the department must rectify its decision<sup>1</sup>. If the decision is not rectified within one month after receipt of the statement of grounds, the appeal must be remitted to the Board of Appeal<sup>2</sup> without delay and without comment as to its merit<sup>3</sup>.

Where the party which had lodged the appeal is opposed by another party and if the department whose decision is contested considers the appeal to be admissible and well founded, the department must rectify its decision<sup>4</sup>. The decision may only be rectified if the department whose decision is contested notifies the other party of its intention to rectify it and that party accepts it within two months of the date on which it received the notification<sup>5</sup>. If within two months of receiving such notification the other party does not accept that the contested decision is to be rectified and makes a declaration to that effect or does not make any declaration within the period laid down, the appeal must be remitted to the Board of Appeal without delay and without comment as to its merit<sup>6</sup>. If the department whose decision is contested does not consider the appeal to be admissible and well founded within one month after receipt of the statement of grounds, it must remit the appeal to the Board of Appeal without delay and without comment as to its merit<sup>7</sup>.

1 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 60(1) (art 60 substituted by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)). These provisions provide for a system of so-called 'interlocutory revision' similar to that operated by the European Patent Office which enables first instance departments to change their minds, thereby short-circuiting an appeal.

2 As to appeals to the Board of Appeal see PARA 291 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 60(2) (as substituted: see note 1 supra).

4 Ibid art 60a(1) (art 60a added by EC Council Regulation 422/2004 (OJ L70, 9.3.04, p 1)).

5 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 60a(2) (as added: see note 4 supra).

6 Ibid art 60a(3) (as added: see note 4 supra).

7 Ibid art 60a(4) (as added: see note 4 supra).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(v) Appeals/293. Examination of, and decisions in respect of, appeals.

### **293. Examination of, and decisions in respect of, appeals.**

Provision is made for the consideration of and adjudication upon appeals by the Board of Appeal<sup>1</sup>. There is also a further regulation laying down the rules of procedure of the Boards of Appeal<sup>2</sup>.

<sup>1</sup> See in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 61, 62; EC Commission Regulation 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 rr 49-51 (r 50 amended, and r 51 substituted, by EC Commission Regulation 1041/2005 (OJ L172, 5.7.05, p 4)).

As to the Board of Appeal see PARA 182 ante; and as to the general procedural provisions for proceedings in the Office see PARA 277 note 3 ante.

There is a continuity of function between the first instance departments and the Boards of Appeal and therefore the Board of Appeal must re-examine the first instance decision: Case C-29/05P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Kaul GmbH* [2007] All ER (D) 226 (Mar), ECJ; Case T-163/98 *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [1999] ECR II-2383, [1999] All ER (EC) 648 (revsd on other grounds Case C-383/99P *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] Ch 82, [2001] ECR I-6251, ECJ); Case T-63/01 *Procter and Gamble v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-5255, (2002) Times, 28 December, CFI; Case T-308/01 *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-3253, [2003] All ER (D) 155 (Sep), CFI (affd on other grounds Joined Cases C-456/01P and C-457/01P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-5089, [2005] IP & T 1, ECJ). The Board of Appeal has a discretion as to whether or not to take into account facts or evidence which have not been submitted at first instance: Case C-29/05P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Kaul GmbH* supra. The Board of Appeal must consider all the appellant's arguments, even if not raised below: Case T-163/98 *Procter & Gamble Co v Office for Harmonisation in the Internal Market* supra. The Board of Appeal must also consider of its own motion all relevant matters of law and fact even if not raised by a specific ground of appeal: Case T-308/01 *Henkel KGaA v Office for Harmonisation in the Internal Market* supra. On an appeal from the examiner the Board of Appeal is entitled to raise a ground of refusal which had not been raised at first instance: Case T-122/99 *Procter and Gamble v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2000] ECR II-265, [2000] 2 CMLR 303, CFI. Where the appellant has missed a time limit at first instance, the Board of Appeal is entitled, but not obliged, to dismiss the appeal on the same ground: Case T-112/03 *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-949, [2005] All ER (D) 267 (Mar), CFI; affd on other grounds Case C-235/05P *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-57, ECJ.

<sup>2</sup> See EC Commission Regulation 216/96 (OJ L28, 6.2.1996, p 11) laying down the rules of procedure of the Boards of Appeal of the Office for Harmonisation in the Internal Market.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(8) PROCEDURE IN THE OFFICE/(v) Appeals/294. Appeals to the European Court of First Instance and Court of Justice.

## **294. Appeals to the European Court of First Instance and Court of Justice.**

Actions may be brought<sup>1</sup> before the European Court of Justice against decisions of the Boards of Appeal<sup>2</sup> on appeals<sup>3</sup>. Such actions are brought in the Court of First Instance which is attached to the Court of Justice<sup>4</sup>. A further appeal lies from the Court of First Instance to the Court of Justice itself on points of law<sup>5</sup>.

The action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the EC Treaty, of the Community Trade Mark Regulation or of any rule of law relating to their application or misuse of power<sup>6</sup>.

The Court of First Instance or the Court of Justice has jurisdiction to annul or to alter the contested decision<sup>7</sup>.

1 The action is open to any party to proceedings before the Board of Appeal adversely affected by its decision: EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark (the 'Community Trade Mark Regulation') art 63(4). Where the applicant is appealing against a decision of the Board of Appeal the primary defendant is the Office for Harmonisation in the Internal Market even in inter partes disputes, although the other party may intervene to support the Board of Appeal's decision. As to the Office see PARA 180 et seq ante.

2 As to the Board of Appeal see PARA 182 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 63(1). As to appeals to the Board of Appeal see PARA 291 ante. The action must be brought before the European Court of Justice within two months of the date of notification of the decision of the Board of Appeal: art 63(5).

4 Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') art 225 (formerly art 168a; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ); EEC/ECSC/Euratom Council Decision 88/591 (OJ L319, 25.11.88, p 1) establishing a Court of First Instance of the European Communities, art 5. The rules of procedure of the Court of First Instance (OJ L136, 30.5.91, p 1) have been amended to make provision for proceedings arising from the Office for Harmonisation in the Internal Market (OJ L172, 22.7.95, p 3), adding arts 130-136. Only independent lawyers authorised to practice before the court of a member state may represent parties before the Court of First Instance and European Court of Justice: Case T-79/99 *Euro-lex European Law Expertise GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [1999] ECR II-3555, CFI; Case T-315/03 *Wilfer v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1981, CFI; Case T-123/04 *Cargo Partner AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR II-3979, [2006] ETMR 35, CFI.

5 EC Treaty art 225(1) (as renumbered: see note 4 supra). Since the Court of First Instance has exclusive jurisdiction to assess the evidence and find the facts, these matters do not form a point of law subject to review by the Court of Justice unless the Court of First Instance has distorted the evidence: Case C-104/00 *DKV Deutsche Krankenversicherung AG v Office for Harmonisation in the Internal Market* [2002] ECR I-7561, [2002] All ER (D) 100 (Sep), ECJ; Case C-37/03P *BioID AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR I-7975, ECJ; Case C-214/05P *Sergio Rossi SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-7057, ECJ.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 63(2). The Court of First Instance may annul or alter a decision of the Board of Appeal only if, at the time the decision was adopted, it was vitiated by one of these grounds; it may not annul or alter a decision on grounds which come into existence subsequently: Case C-416/04P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, [2006] All ER (D) 178 (May), ECJ; Case C-29/05P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Kaul GmbH* [2007] All ER (D) 226 (Mar), ECJ. The purpose of appeals to the Court of First Instance is to review the legality of decisions of the Boards of Appeal, and not to re-examine the facts in the light of documents produced for the first time before it; accordingly new evidence is not admissible on such appeals: Case C-214/05P *Sergio Rossi SpA v Office for Harmonisation in the Internal Market (Trade Marks and*

*Designs*) [2006] ECR I-7057, ECJ; Case C-29/05P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Kaul GmbH* supra. On appeal to the Court of First Instance, the Office for Harmonisation in the Internal Market is not obliged to defend the Board of Appeal's decision, but it cannot seek forms of order annulling or altering the decision of the Board of Appeal on a point not raised by the appeal or put forward pleas not raised in the appeal: Case C-106/03 *Vedial SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR I-9573, ECJ; Case T-107/02 *GE Betz Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-1845, [2004] All ER (D) 360 (Jun), CFI; Case T-379/03 *Peek & Cloppenburg KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR II-4633, sub nom *Peek & Cloppenburg's Application* [2006] ETMR 33, CFI. The Office for Harmonisation in the Internal Market is entitled to depart from the reasoning of the Board of Appeal provided that its arguments do not amount to new grounds for annulment of the decision: Case T-6/05 *DEF-TEC Defense Technology GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] All ER (D) 23 (Sep), CFI.

7 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 63(3). The Office for Harmonisation in the Internal Market must take the necessary measures to comply with the judgment of the Court of First Instance or the European Court of Justice: art 63(6); and see Case T-163/98 *Procter & Gamble Co v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [1999] ECR II-2383, [1999] ETMR 767, CFI. The appellant or intervener cannot request the court to, for example, direct the Office for Harmonisation in the Internal Market to declare the trade mark in suit invalid: Case T-331/99 *Mitsubishi HiTec Paper Bielefeld GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2001] ECR II-433, [2001] IP & T 459, CFI; Case T-34/00 *Eurocool Logistik GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-683, [2002] IP & T 756, CFI; Case T-129/01 *Alejandro v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2003] ECR II-2251, CFI; Joined Cases T-160/02 to T-162/02 *Naipes Heraclio Fournier SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2005] ECR II-1634, [2005] All ER (D) 136 (May), CFI.

## UPDATE

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

### **294 Appeals to the European Court of First Instance and Court of Justice**

NOTE 4--By virtue of art 97, the ECSC Treaty has now expired. Since 24 July 2002, the sectors previously covered by this Treaty, and the procedural rules and other secondary legislation derived from it, have been subject to the rules of the EC Treaty as well as the procedural rules and other secondary legislation derived from the EC Treaty.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(9) COMMUNITY COLLECTIVE MARKS/(i) In general/295. Introduction.

## **(9) COMMUNITY COLLECTIVE MARKS**

### **(i) In general**

#### **295. Introduction.**

A Community collective mark is a Community trade mark<sup>1</sup> which is described as such when the mark is applied for<sup>2</sup> and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings<sup>3</sup>.

Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for Community collective marks<sup>4</sup>.

The provisions of the Community Trade Mark Regulation<sup>5</sup> apply to Community collective marks, unless it provides<sup>6</sup> otherwise<sup>7</sup>.

1 For the meaning of 'Community trade mark' see PARA 206 ante.

2 As to applications for Community trade marks see PARAS 278-283 ante.

3 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 64(1). The rules contained in EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1, apply to Community collective marks, subject to r 43 (see PARA 298 note 4 post).

4 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 64(1).

5 Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

6 Ie by ibid arts 65-72: see PARA 297 et seq post.

7 Ibid art 64(3).

#### **UPDATE**

#### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(9) COMMUNITY COLLECTIVE MARKS/(i) In general/296. Geographical indications.

## **296. Geographical indications.**

In derogation from the relevant provision<sup>1</sup>, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute Community collective marks<sup>2</sup>.

A collective mark does not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters<sup>3</sup>; in particular, such a mark may not be invoked against a third party who is entitled to use a geographical name<sup>4</sup>.

<sup>1</sup> I.e. EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 7(1)(c): see PARA 211 ante.

<sup>2</sup> Ibid art 64(2). In the case of such a mark, the regulations governing use (see PARA 298 post) must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark: see art 65(2); and PARA 298 note 3 post. For the meaning of 'Community collective mark' see PARA 295 ante. As to protected designations of origin, protected geographical indications and traditional specialities guaranteed see PARA 302 post.

<sup>3</sup> As to the meaning of 'honest practices in industrial or commercial matters' see PARA 96 ante.

<sup>4</sup> EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 64(2).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(9) COMMUNITY COLLECTIVE MARKS/(i) In general/297. Application for a Community collective mark.

## **297. Application for a Community collective mark.**

In addition to the grounds provided for refusal of a Community trade mark application<sup>1</sup>, an application for a Community collective mark<sup>2</sup> must be refused:

- 415 (1) where the additional provisions relating to Community collective marks<sup>3</sup> are not satisfied<sup>4</sup>;
- 416 (2) where the regulations governing use<sup>5</sup> are contrary to public policy or to accepted principles of morality<sup>6</sup>; or
- 417 (3) if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark<sup>7</sup>.

Apart from the general rules on observations by third parties<sup>8</sup>, any person, group or body referred to in those general rules may submit to the Office for Harmonisation in the Internal Market<sup>9</sup> written observations based on the particular grounds on which the application for a Community collective mark should be refused<sup>10</sup>.

<sup>1</sup> I.e. EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 36, 38: see PARA 279 ante.

<sup>2</sup> For the meaning of 'Community collective mark' see PARA 295 ante.

<sup>3</sup> I.e. EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 64 (see PARAS 295-296 ante) or art 65 (see PARA 298 post).

<sup>4</sup> Ibid art 66(1).

<sup>5</sup> As to the regulations governing the use of a Community collective mark see PARA 298 post.

<sup>6</sup> EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 66(1).

<sup>7</sup> Ibid art 66(2). An application must not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of art 66(1), (2): art 66(3).

<sup>8</sup> I.e. the cases mentioned in ibid art 41: see PARA 279 ante.

<sup>9</sup> As to the Office see PARA 180 et seq ante.

<sup>10</sup> EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 67.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(9) COMMUNITY COLLECTIVE MARKS/(ii) Regulations/298. Regulations governing use of a Community collective mark.

## **(ii) Regulations**

### **298. Regulations governing use of a Community collective mark.**

An applicant for a Community collective mark<sup>1</sup> must submit regulations governing its use within the prescribed period<sup>2</sup>. Such regulations must specify: (1) the persons authorised to use the mark; (2) the conditions of membership of the association<sup>3</sup>; and (3) where they exist, the conditions of use of the mark including sanctions<sup>4</sup>.

The proprietor of a Community collective mark must submit to the Office for Harmonisation in the Internal Market<sup>5</sup> any amended regulations governing use<sup>6</sup>. The amendment must not be mentioned in the register<sup>7</sup> if the amended regulations do not satisfy the relevant<sup>8</sup> requirements<sup>9</sup>.

For these purposes<sup>10</sup>, amendments to the regulations governing use take effect only from the date of entry of the mention of the amendment in the register<sup>11</sup>.

1 For the meaning of 'Community collective mark' see PARA 295 ante.

2 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 65(1).

3 The regulations governing use of a mark as a sign or indication which may serve, in trade, to designate the geographical origin of the goods or services (ie a mark referred to in *ibid* art 64(2): see PARA 296 ante) must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark: art 65(2).

4 *Ibid* art 65(2). As to what the regulations must specify see EC Commission Regulation 2868/95 (OJ L303, 15.12.95, p 1) implementing Council Regulation (EC) No 40/94 on the Community trade mark, art 1 r 43.

5 As to the Office see PARA 180 et seq ante.

6 EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 69(1). The provisions permitting observations by third parties (ie art 67: see PARA 297 ante) apply to amended regulations governing use: art 69(3).

7 As to the register see PARA 188 ante.

8 Ie the requirements of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 65 (see the text and notes 1-4 supra) or the grounds for refusal referred to in art 66 (see PARA 297 ante).

9 *Ibid* art 69(2).

10 Ie for the purposes of applying EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1).

11 *Ibid* art 69(4).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation



should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(9) COMMUNITY COLLECTIVE MARKS/(iii) Infringement, Revocation and Invalidity/299. Persons who are entitled to bring an action for infringement of a Community collective mark.

### **(iii) Infringement, Revocation and Invalidity**

#### **299. Persons who are entitled to bring an action for infringement of a Community collective mark.**

The provisions concerning the rights of licensees<sup>1</sup> apply to every person who has authority to use a Community collective mark<sup>2</sup>.

The proprietor of a Community collective mark is entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorised use of the mark<sup>3</sup>.

<sup>1</sup> I.e. EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 22(3), (4): see PARA 275 ante.

<sup>2</sup> Ibid art 70(1). For the meaning of 'Community collective mark' see PARA 295 ante.

<sup>3</sup> Ibid art 70(2). For the grounds on which an infringement action may be brought see PARA 224 et seq ante. As to the procedural and jurisdictional issues concerning infringement actions see PARA 250 et seq ante.

#### **UPDATE**

#### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(9) COMMUNITY COLLECTIVE MARKS/(iii) Infringement, Revocation and Invalidity/300. Revocation of a Community collective mark.

### **300. Revocation of a Community collective mark.**

Apart from the grounds provided for revocation<sup>1</sup>, the rights of the proprietor of a Community collective mark<sup>2</sup> must be revoked<sup>3</sup> on application to the Office for Harmonisation in the Internal Market<sup>4</sup> or on the basis of a counterclaim<sup>5</sup> in infringement proceedings<sup>6</sup>, if:

- 418 (1) the proprietor does not take reasonable steps to prevent the mark being used in a manner incompatible with the conditions of use, where these exist, laid down in the regulations governing use<sup>7</sup>, amendments to which have, where appropriate, been mentioned in the register<sup>8</sup>;
- 419 (2) the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public<sup>9</sup>;
- 420 (3) an amendment to the regulations governing use of the mark has been mentioned in the register in breach of the relevant provisions<sup>10</sup>, unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of those provisions<sup>11</sup>.

1    Ie in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 50: see PARA 237 et seq ante. One of the grounds provided for revocation of a Community trade mark is non-use: see art 50(1)(a); and PARA 238 ante. It is provided that use of a Community collective mark by any person who has authority to use it satisfies the requirements of EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1), provided that the other conditions imposed with regard to the use of Community trade marks are fulfilled: art 68.

2    For the meaning of 'Community collective mark' see PARA 295 ante.

3    As to the date from which revocation takes effect see PARA 242 ante.

4    As to the Office see PARA 180 et seq ante. As to bringing an application for revocation in the Office see PARAS 289-290 ante.

5    As to bringing an application for revocation by way of counterclaim see PARA 261 et seq ante.

6    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 71.

7    As to the regulations governing use see PARA 298 ante.

8    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 71(a). As to the register see PARA 188 ante.

9    Ibid art 71(b), which refers to art 66(2): see PARA 297 ante. Head (2) in the text will overlap with the ground for revocation provided for by art 50(1)(c) (see PARA 240 ante).

10   Ie ibid art 69(2): see PARA 298 ante.

11   Ibid art 71(c).

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation

should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(9) COMMUNITY COLLECTIVE MARKS/(iii) Infringement, Revocation and Invalidity/301. Invalidity of a Community collective mark.

### **301. Invalidity of a Community collective mark.**

Apart from the grounds provided for a declaration of invalidity<sup>1</sup>, a Community collective mark<sup>2</sup> which is registered in breach of the requirements for registration as a Community collective mark<sup>3</sup> must be declared invalid<sup>4</sup> on application to the Office for Harmonisation in the Internal Market<sup>5</sup> or on the basis of a counterclaim<sup>6</sup> in infringement proceedings, unless the proprietor of the mark, by amending the regulations governing use<sup>7</sup>, complies with the requirements of those provisions<sup>8</sup>.

1    Ie in EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 51, 52: see PARA 243 et seq ante.

2    For the meaning of 'Community collective mark' see PARA 295 ante.

3    Ie EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 66: see PARA 297 ante.

4    As to the effect of a declaration of invalidity see PARA 247 ante.

5    As to the Office see PARA 180 et seq ante. As to bringing an application for a declaration of invalidity in the Office see PARAS 289-290 ante.

6    As to bringing an application for a declaration of invalidity by way of counterclaim see PARA 261 et seq ante.

7    As to the regulations governing use see PARA 298 ante.

8    EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) art 72.

## **UPDATE**

### **271-301 Community trade marks as objects of property ... Invalidity of a Community collective mark**

Regulation 40/94 (the 'Community Trade Mark Regulation') replaced: EC Council Regulation 207/2009 (OJ L78, 24.3.2009, p 1); references to the repealed regulation should be construed as references to Regulation 207/2009 and read in accordance with the correlation table in Annex II: art 166.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(10) PROTECTED DESIGNATIONS OF ORIGIN, PROTECTED GEOGRAPHICAL INDICATIONS AND TRADITIONAL SPECIALITIES GUARANTEED/302. In general.

## **(10) PROTECTED DESIGNATIONS OF ORIGIN, PROTECTED GEOGRAPHICAL INDICATIONS AND TRADITIONAL SPECIALITIES GUARANTEED**

### **302. In general.**

There is no provision for Community certification marks as distinct from Community collective marks<sup>1</sup>. Instead, European Community law provides for three types of protection<sup>2</sup> for the names of foods and agricultural products which denote foods and agricultural products made in a particular region or in a traditional way, namely:

- 421 (1) a protected designation of origin ('PDO')<sup>3</sup>;
- 422 (2) a protected geographical indication ('PGI')<sup>4</sup>; and
- 423 (3) a traditional speciality guaranteed ('TSG'), formerly known as a certificate of specific character ('CSC')<sup>5</sup>.

These forms of protection are distinct from trade marks<sup>6</sup> although there are certain similarities<sup>7</sup>.

1 By contrast the Trade Marks Act 1994 provides for both collective marks (see PARA 155 et seq ante) and certification marks (see PARA 165 et seq ante). For the meaning of 'Community collective mark' see PARA 295 ante. Signs which may serve in trade to designate the geographical origin of the goods or services may constitute Community collective marks: see PARA 296 ante.

2 In addition to these three general types of protection, there are various regimes for the protection of names of specific products: see eg EC Council Regulation 1493/99 (OJ L179, 14.7.99, p 1) on the common organisation of the market in wine, arts 47-53, Annex VII (amended by EC Council Regulation 2585/2001 (OJ L345, 29.12.01, p 10); and by EC Council Regulation 2165/2005 (OJ L345, 28.12.05, p 1)) and EC Council Regulation 1493/99 (OJ L179, 14.7.99, p 1) Annex VIII (amended by EC Council Regulation 2165/2005 (OJ L345, 28.12.05, p 1)), which implement the Agreement on Trade-Related Aspects of Intellectual Property ('TRIPs') (1994) (Cm 2557) art 23. As to TRIPs see PARA 7 ante. Such legislation may require certain names to be used as well as prohibiting others: see *Antonio Munoz Y Cia SA v Frumar Ltd* [1999] 3 CMLR 684, [1999] FSR 872 (grape varieties). As to the relationship between trade marks and such legislation see Case C-303/97 *Verbraucherschutzverein EV v Sektkellerei GC Kessler GmbH & Co* [1999] ECR I-513, [1999] 1 CMLR 756, ECJ; *MEZZACORONA Trade Mark* [2003] EWCA Civ 1861, [2004] RPC 537, sub nom *Miguel Torres SA v Cantine Mezzacorona SCARL* [2003] All ER (D) 407 (Dec).

3 See EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12) on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, which implements TRIPs arts 22, 24. Since the Regulation has direct effect it creates rights which individuals may rely upon against other individuals before national courts, subject to the requirement of legal certainty: C-108/01 *Consorzio del Prosciutto di Parma v Asda Stores Ltd* [2003] ECR I-5121, [2003] 2 CMLR 639, ECJ.

4 See EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12).

5 See EC Council Regulation 509/2006 (OJ L93, 31.3.06, p 1) on agricultural products and foodstuffs as traditional specialities guaranteed.

6 As to these forms of protection see FOOD vol 18(2) (Reissue) PARA 417 et seq.

7 PDOs and PGIs fall within the definition of 'industrial property' in the Paris Convention art 1 and the ECJ has held that they constitute 'industrial and commercial property' (ie intellectual property) rights when analysing the compatibility of the legislation with the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') art 29: Case C-469/00 *Ravil SARL v Bellon Import SARL* [2003]

ECR I-5053, [2003] All ER (D) 296 (May), ECJ; C-108/01 *Consorzio del Prosciutto di Parma v Asda Stores Ltd* [2003] ECR I-5121, [2003] 2 CMLR 639, ECJ. As to the Paris Convention see PARA 6 ante.

## **UPDATE**

### **302 In general**

NOTE 5--As to detailed rules for the implementation of Regulation 509/2006, see EC Commission Regulation 1216/2007 (OJ L275, 19.10.2007, p 3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/3. COMMUNITY TRADE MARKS/(10) PROTECTED DESIGNATIONS OF ORIGIN, PROTECTED GEOGRAPHICAL INDICATIONS AND TRADITIONAL SPECIALITIES GUARANTEED/303.  
Relationship between trade marks, designations of origin and geographical indications.

### **303. Relationship between trade marks, designations of origin and geographical indications.**

A designation of origin or geographical indication must not be registered<sup>1</sup> where, in the light of a trade mark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product<sup>2</sup>.

Registration of a designation of origin or geographical indication may be objected to if the objector shows that the registration of the name proposed would jeopardise the existence of an entirely or partly identical name or of a trade mark or the existence of products which have been legally on the market for at least five years preceding the publication of the application for registration<sup>3</sup>.

Where a designation of origin or geographical indication is registered, an application for registration of a trade mark corresponding to one of the protected situations<sup>4</sup> and relating to the same class of product must be refused if the application for registration of the trade mark is submitted after the date of submission of the application for registration of the designation of origin or geographical indication<sup>5</sup>. Trade marks registered in breach of this provision must be declared invalid<sup>6</sup>.

A trade mark the use of which corresponds to one of the protected situations<sup>7</sup> which has been applied for, registered or established by use, if that possibility is provided for by the legislation concerned<sup>8</sup>, in good faith<sup>9</sup> within the territory of the Community before either the date of protection of the designation of origin or geographical indication or 1 January 1996 may continue to be used notwithstanding the registration of a designation of origin or geographical indication provided that no grounds for its invalidity or revocation exist as specified by the Trade Marks Directive<sup>10</sup> or the Community Trade Mark Regulation<sup>11</sup>.

1    Ie under EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12) on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

2    Ibid art 3(4).

3    Ibid art 7(3)(c). Publication is provided for under art 6(2): art 7(3)(c).

4    Ie under ibid art 13. Registered names are protected against: (1) any direct or indirect commercial use of a registered name in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name; (2) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by any expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar; (3) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin; (4) any other practice liable to mislead the consumer as to the true origin of the product: art 13.

'Evocation' of a protected designation within head (2) supra covers a situation where the term used to designate a product incorporates part of a protected designation, so that when a consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected; it is possible for a protected designation to be evoked where there is no likelihood of confusion between the products concerned: Case C-87/97 *Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co KG* [1999] ECR I-1301, [1999] 1 CMLR 1203, ECJ (CAMBOZOLA for a soft blue cheese evoked GORGONZOLA).



5 EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12) art 14(1). See also PARA 217 ante.

6 Ibid art 14(1).

7 See ibid art 13; and note 4 supra.

8 It would appear that this would cover the law of passing off, which is provided for by the Trade Marks Act 1994 s 2(2); see PARA 416 post. As to passing off see PARA 304 et seq post.

9 The concept of good faith must be viewed in the light of the entire body of legislation, both national and international, in force at the time when the application for registration of the trade mark was lodged; in principle the proprietor of the trade mark cannot benefit from a presumption of good faith if the legislation in force at the material time clearly precluded acceptance of his registration: Case C-87/97 *Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co KG* [1999] ECR I-1301, [1999] 1 CMLR 1203, ECJ.

10 Ie EC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks. As to the grounds of invalidity or revocation under the provisions of the Trade Marks Act 1994 corresponding to the relevant provisions of EC Council Directive 89/104 (OJ L40, 11.2.89, p 1) see PARA 114 et seq ante.

11 EC Council Regulation 510/2006 (OJ L93, 31.3.06, p 12) art 14(2). The Community Trade Mark Regulation is EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark. As to the grounds of invalidity or revocation under the Community Trade Mark Regulation see PARA 237 et seq ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(i) Introduction/304. Elements of the action for passing off.

## **4. PASSING OFF**

### **(1) THE ELEMENTS OF PASSING OFF**

#### **(i) Introduction**

##### **304. Elements of the action for passing off.**

The necessary elements of the action for passing off have been restated by the House of Lords<sup>1</sup> as being three in number:

- 424 (1) that the claimant's goods or services have acquired a goodwill in the market and are known by some distinguishing name, mark or other indicium;
- 425 (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the claimant; and
- 426 (3) that the claimant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation<sup>2</sup>.

The restatement of the elements of passing off in the form of this classical trinity<sup>3</sup> has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House<sup>4</sup>. This latest statement, like the House's previous statements, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off'<sup>5</sup>, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House<sup>6</sup>.

<sup>1</sup> See note 3 infra.

<sup>2</sup> *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873 at 880, [1990] 1 WLR 491 at 499, [1990] RPC 341 at 406, HL, per Lord Oliver of Aylmerton, and at 889, 510 and 417 per Lord Jauncey of Tullichettle ('Jif Lemon').

<sup>3</sup> It was described as the 'classical trinity' in *Consorzio del Prosciutto di Parma v Marks & Spencer plc* [1991] RPC 351 at 368-369, CA, per Nourse LJ ('Parma ham'). See also *County Sound plc v Ocean Sound plc* [1991] FSR 367 at 372, CA, per Nourse LJ.

<sup>4</sup> See in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL ('Advocaat'), where Lord Diplock at 742, 932-933 and 93 and Lord Fraser of Tullybelton at 755-756, 943-944 and 105-106 each formulated the elements of the action in markedly differing terms, with the remaining three members of the House agreeing with both Lord Diplock and Lord Fraser of Tullybelton.

<sup>5</sup> *My Kinda Bones Ltd v Dr Pepper's Stove Co Ltd* [1984] FSR 289. As to the dangers of treating speeches in the House of Lords as if they were statutory definitions see *Cassell & Co Ltd v Broome* [1972] AC 1027 at 1085, [1972] 1 All ER 801 at 836, HL, per Lord Reid.

<sup>6</sup> *Bristol Conservatories Ltd v Conservatories Custom Built Ltd* [1989] RPC 455 at 466, CA, per Ralph Gibson LJ (a case of 'reverse' passing off: see PARA 320 post); *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* [1987] RPC 189 at 206, CA, per Slade LJ (where the misrepresentation was to suppliers rather than to customers).

## **UPDATE**

### **304 Elements of the action for passing off**

NOTE 6--The tort could not and should not be extended into some general law of unfair competition: *L'Oreal SA v Bellure NV* [2007] EWCA Civ 936, [2007] All ER (D) 122 (Oct).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(i) Introduction/305. History and legal nature of the action for passing off.

### **305. History and legal nature of the action for passing off.**

The action for passing off may have been recognised at common law as long ago as during the reign of Elizabeth I<sup>1</sup>. It seems that the action for passing off at common law originally grew out of the action for deceit, and, like the action for deceit, required a false representation made fraudulently, but differed from it in that the persons deceived were the plaintiff's customers rather than the plaintiff himself<sup>2</sup>. The action at common law was extended to cases where the defendant's customers were not themselves deceived but the defendant sold fraudulently marked goods to retail dealers with the express purpose of the goods being resold to ultimate purchasers as the plaintiff's goods<sup>3</sup>. Although at first equity followed the common law in requiring fraudulent intent on the part of the defendant<sup>4</sup>, it was later accepted that an injunction could be granted in equity in the absence of intention to deceive if the defendant's actions would in fact result in deception<sup>5</sup>. It was soon accepted, both at law<sup>6</sup> and in equity<sup>7</sup>, that it was unnecessary that the goods passed off had to be inferior to the plaintiff's<sup>8</sup>.

Equity's willingness to protect the exclusive right to use a trade name or mark even in the absence of fraud was recognised as being based on a right of property, by contrast with the purely personal right to relief at law based on fraud<sup>9</sup>. Equity came to recognise and develop an exclusive property in a trade mark applied to goods acquired by first public use of the mark, which was distinct from the action for passing off founded on misrepresentation; these so-called 'unregistered trade marks' have been superseded by the statutory registration of trade marks and can no longer be enforced, but this does not affect rights of action for passing off<sup>10</sup>. The common law courts maintained the requirement that fraudulent intent had to be proved in an action for passing off until the fusion of the courts of common law and equity<sup>11</sup>, and subsequent judicial observations have maintained that passing off in the absence of fraudulent intent is actionable in equity only<sup>12</sup>. Although the practical consequences of this distinction have diminished<sup>13</sup> and it has on occasion been overlooked<sup>14</sup>, the equitable principles underlying the grant of injunctions in passing off cases may still be of significance in some circumstances<sup>15</sup>.

1 An unreported case was mentioned in the judgment of Doderidge J in *Southern v How* (1618) Poph 143 at 144, where a defendant fraudulently counterfeited the mark of a clothier from Gloucester; but another report says that the plaintiff was the deceived customer rather than the owner of the mark (Cro Jac 468 at 471), and another that Doderidge J did not make clear which of them was the plaintiff (2 Roll Rep 26 at 28).

2 *Singer Manufacturing Co v Wilson* (1876) 2 ChD 434 at 453, CA, per Mellish LJ.

3 *Sykes v Sykes* (1824) 3 B & C 541.

4 *Blanchard v Hill* (1742) 2 Atk 484 at 485 per Lord Hardwicke LC. See also *Motley v Downman* (1837) 3 My & Cr 1 at 10 (argument) and at 14 per Lord Cottenham LC.

5 *Millington v Fox* (1838) 3 My & Cr 338.

6 *Blofeld v Payne* (1833) 4 B & Ad 410.

7 *Edelsten v Edelsten* (1863) 1 De GJ & Sm 185.

8 See *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15 at 30, HL, per Lord Blackburn.

9 *Hall v Barrows* (1863) 4 De GJ & Sm 150 at 158 per Lord Westbury LC.

10 Trade Marks Act 1994 s 2(2). As to the statutory registration of trade marks see PARA 2 et seq ante.

11 *Crawshay v Thompson* (1842) 4 Man & G 357; *Rodgers v Nowill* (1847) 5 CB 109; and see *Dixon v Fawcus* (1861) 3 E & E 537. For a summary of the development of passing off at law and in equity see *Singer Manufacturing Co v Wilson* (1876) 2 ChD 434 at 453-455, CA, per Mellish LJ.

12 *Singer Manufacturing Co v Wilson* (1876) 2 ChD 434, CA; *Birmingham Small Arms Co Ltd v Webb & Co* (1906) 24 RPC 27 at 31 per Parker J; *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 283, HL, per Lord Parker of Waddington; *Marengo v Daily Sketch and Sunday Graphic Ltd* (1948) 65 RPC 242 at 253, HL, per Lord du Parc.

13 *Habib Bank Ltd v Habib Bank AG Zurich* [1981] 2 All ER 650 at 666, [1981] 1 WLR 1265 at 1284-1285, [1982] RPC 1 at 36, CA, where it was said that it is irrelevant whether the cause of action arises at law or in equity for the purposes of the defences of estoppel or acquiescence. As to whether damages or accounts of profits are recoverable in the absence of fraudulent intent see PARA 442 et seq post.

14 See *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79 at 135, CA.

15 *Elida Gibbs Ltd v Colgate-Palmolive Ltd* [1983] FSR 95 at 100. As to the use of a trader's own name and concurrent use see PARA 344 et seq post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/306. Nature of goodwill.

## (ii) Goodwill

### 306. Nature of goodwill.

An action for passing off is now recognised as being a remedy for the invasion of a right of property<sup>1</sup>, the property being in the goodwill likely to be injured by the misrepresentation rather than in the mark, name or get-up improperly used<sup>2</sup>. 'Goodwill' has been defined as the benefit and advantage of the good name, reputation and connection of a business, the attractive force which brings in custom, and the one thing which distinguishes an old-established business from a new business at its first start<sup>3</sup>. Although goodwill usually runs hand in hand with reputation, goodwill and reputation are not identical concepts<sup>4</sup>.

1 As to the development by the courts of equity of the concept that passing off, in the absence of fraudulent intent, could be restrained as an interference with a right of property, by contrast with the personal action at common law based on the intentional fraud of the defendant, see PARA 305 ante.

2 *Frank Reddaway & Co Ltd v George Banham & Co Ltd* [1896] AC 199, 13 RPC 218, HL, per Lord Herschell; *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 284, HL, per Lord Parker of Waddington; *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* [1976] FSR 256 at 269, PC; *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 740-741, [1979] 2 All ER 927 at 931-932, [1980] RPC 31 at 92, HL, per Lord Diplock; *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 at 711, CA, per Millet LJ; *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669 at 701, CA, per Scott V-C; *Premier Luggage & Bags Ltd v Premier Co (UK) Ltd* [2002] EWCA Civ 387 at [37], [2003] FSR 69 at [37] per Chadwick LJ; *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at [9], [2007] RPC 83 at [9] per Jacob LJ. The concept of future goodwill is not helpful for this purpose: *Teleworks Ltd v Telework Group plc* [2002] RPC 535.

3 *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 at 223-224, HL, per Lord Macnaghten. As to goodwill generally see PERSONAL PROPERTY vol 35 (Reissue) PARAS 1206-1210.

4 Thus it may be possible for a trade mark to have a reputation in the United Kingdom but for the proprietor of the trade mark not to own any goodwill here because he does not have any trade or business here: see PARA 312 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/307. Required proof and extent of goodwill etc.

### **307. Required proof and extent of goodwill etc.**

For there to be goodwill and reputation under a name, mark or other indicium there must be customers or prospective customers who recognise the name, mark or other indicium as distinctive of the claimant's goods or services<sup>1</sup>. Thus the key evidence for proof of goodwill is to show the court what was actually done to publicise the name or badge relied on; the amount spent on advertising and promotion is not of great significance<sup>2</sup>.

An action for passing off can be maintained by a small trader with a limited clientele provided that he has built up sufficient goodwill that he will suffer substantial damage by reason of the misrepresentation complained of<sup>3</sup>. If the geographical extent of the goodwill is confined, then the claimant's ability to maintain a claim may be similarly confined<sup>4</sup>.

In order to succeed in a claim for passing off, the claimant must have established a goodwill under the relevant name, mark or indicium as at the date the defendant commenced the activities complained of<sup>5</sup>.

1 See *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873 at 880, [1990] 1 WLR 491 at 499, [1990] RPC 341 at 406, HL, per Lord Oliver of Aylmerton. The test for proving goodwill in a passing off action is not the same as that for proving that an inherently descriptive trade mark has acquired a distinctive character: *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at [25]-[26], [32]-[34], [2007] RPC 83 at [25]-[26], [32]-[34] per Jacob LJ.

2 *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at [6] and [33], [2007] RPC 83 at [6] and [33] per Jacob LJ. By contrast turnover figures are highly pertinent.

3 See *Stannard v Reay* [1967] RPC 589 (fish and chip van); *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* [1985] FSR 567 (affd [1987] RPC 189, CA) (small clothing business); *Sutherland v V2 Music Ltd* [2002] EWHC 14 (Ch), [2002] IP & T 904 (band with no recording contract); *IN Newman Ltd v Adlem* [2005] EWCA Civ 741, [2006] FSR 253 (village funeral directors business); and cf *Hart v Relentless Records Ltd* [2002] EWHC 1984 (Ch), [2003] FSR 647 (goodwill too small for any likelihood of damage).

4 This is particularly so in cases involving the supply of services: *Clock Ltd v Clock House Hotel Ltd* (1936) 53 RPC 269; *Stannard v Reay* [1967] RPC 589. Cf *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* [1985] FSR 567; affd [1987] RPC 189, CA (nationwide injunction granted although plaintiff's trade in clothing geographically restricted).

5 *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] 1 All ER 213, [1981] 1 WLR 193, [1981] RPC 429, PC; *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [1984] FSR 413, CA. It is arguable that this is the date on which the defendant starts actually using the name or mark in issue rather than eg the date upon which he registers a domain name incorporating that name or mark: *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at [15], [2007] RPC 83 at [15] per Jacob LJ.

## **UPDATE**

### **307 Required proof and extent of goodwill etc**

NOTE 1--See also *Knight v Beyond Properties Pty Ltd* [2007] EWHC 1251 (Ch), [2007] All ER (D) 406 (May).

NOTE 5--See *Hotel Cipriani SRL v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 173, [2008] All ER (D) 94 (Dec) (claimant had substantial reputation and goodwill before defendant began trading).





Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/308. Whether actual trade need have commenced.

### **308. Whether actual trade need have commenced.**

An action for passing off can be sustained prior to the actual commencement of trading by the claimant. A claimant may acquire a substantial reputation prior to making sales of a product or service because of advance advertising and press publicity and, in such a case, may sue others who seek to trade on the reputation which he has acquired<sup>1</sup>. A company may in some circumstances acquire a reputation and goodwill that is able to be protected even before its formal incorporation and within hours of the announcement of its intended formation<sup>2</sup>. Where a claimant has incurred considerable expense making preparations for the launch of a product which will rapidly acquire a reputation once launched, a defendant who commences advertising before the claimant with the intention of defeating the claimant's acquisition of an exclusive right to the mark concerned may be restrained by a quia timet injunction<sup>3</sup>.

1 *WH Allen & Co v Brown Watson Ltd* [1965] RPC 191; *BBC v Talbot Motor Co Ltd* [1981] FSR 228; cf *S Chivers & Sons v S Chivers & Co Ltd* (1900) 17 RPC 420 at 431 per Farwell J; *Athletes Foot Marketing Associates Inc v Cobra Sports Ltd* [1980] RPC 343 at 357 per Walton J. See also *My Kinda Bones Ltd v Dr Pepper's Stove Co Ltd* [1984] FSR 289 per Slade J (where an application to strike out an action where the claimant relied only on pre-launch publicity was dismissed).

2 See *Fletcher Challenge Ltd v Fletcher Challenge Pty Ltd* [1982] FSR 1 (where the announcement of an intended merger of Challenge Corp Ltd and Fletcher Holdings Ltd under the name 'Fletcher Challenge' gave rise to sufficient reputation to restrain the defendants who adopted that name the day after the announcement); *Glaxo plc v Glaxowellcome Ltd* [1996] FSR 388 (where the announcement of an intended merger of Glaxo plc and Wellcome plc under the name gave rise to sufficient reputation to restrain the defendants who adopted the name 'Glaxowellcome' the day after the announcement). In each of these cases, however, the goodwill and reputation of each of the antecedent entities would have sufficed to found a claim for passing off on the basis that the name being used by the defendant misrepresented that it was the product of a merger between that entity and the other.

3 *Elida Gibbs Ltd v Colgate-Palmolive Ltd* [1983] FSR 95 (where it was shown that, had the defendant's advertisements continued after the launch of the plaintiff's product, there would have been confusion and, in placing the advertisements, the defendant company had no motive of promoting an existing trade of its own).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/309. Cessation or suspension of trade.

### **309. Cessation or suspension of trade.**

The cessation or suspension of trade, or of the use of a name, mark or other indicium in a trade, will often leave a residual reputation and goodwill in the public mind which the trader may sue to protect, particularly if it is intended to resume the trade after a temporary interruption<sup>1</sup>. Whether sufficient residual reputation still exists to maintain an action for passing off is a question of fact<sup>2</sup>. It seems, however, that an action cannot be maintained when the goodwill is positively abandoned by the breaking up of the business<sup>3</sup>; nor can an action be maintained by the former trader when the goodwill is assigned to another person<sup>4</sup>.

1 *Poiret v Jules Poiret Ltd* (1920) 37 RPC 177 (where the plaintiff was called up for military service and his dressmaking establishment was converted into a shirt factory for the French army); *Music Corp'n of America v Music Corp'n (Great Britain) Ltd* (1946) 64 RPC 41 (where the plaintiff found it impracticable to continue the business during the war but fully intended to revive it as soon as conditions allowed); *Berkeley Hotel Co Ltd v Berkeley International (Mayfair) Ltd* [1972] RPC 237 (where the plaintiff's hotel had been sold and demolished but the plaintiffs were in the course of rebuilding on another site); *Ad-Lib Club Ltd v Granville* [1971] 2 All ER 300, [1972] RPC 673 (where the plaintiff's club had been forced to close by a noise-nuisance injunction but the plaintiffs were looking for alternative premises); *Levey v Henderson-Kenton (Holdings) Ltd* [1974] RPC 617 (where the plaintiff's department store was closed after a fire and other premises belonging to him were compulsorily acquired); *Thermawear Ltd v Vedonis Ltd* [1982] RPC 44 (plaintiff still had goodwill five years after ceasing to use mark on its goods); and see also *Sutherland v V2 Music Ltd* [2002] EWHC 14 (Ch), [2002] IP & T 904 (band which achieved limited success in 1993 still in existence and had some goodwill in 2001).

2 *Norman Kark Publications Ltd v Odhams Press Ltd* [1962] 1 All ER 636, [1962] 1 WLR 380, [1962] RPC 163 (where it was held that an intention not to abandon the goodwill is insufficient if the reputation of the plaintiff's mark has in fact dwindled).

3 *Pink v JA Sharwood & Co Ltd* (1913) 30 RPC 725 (where the business was broken up and the plant and assets sold by the plaintiff's receiver in lunacy); cf *Second Sight Ltd v Novell UK Ltd and Novell Inc* [1995] RPC 423.

4 *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* [1976] FSR 256, PC.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/310. Meaning of 'trader'; actions by non-traders.

### 310. Meaning of 'trader'; actions by non-traders.

The action for passing off concerns business or trading activities, so actions by non-traders for misrepresentations damaging to them<sup>1</sup> do not in general fall within the scope of passing off<sup>2</sup>. 'Trader' is, however, very widely interpreted and includes persons engaged in professional, literary and artistic occupations<sup>3</sup>. Actions for passing off may also be sustained by professional associations<sup>4</sup> and non-profit trade associations or chambers of commerce<sup>5</sup>. The courts have been willing to extend protection to claimants who are not engaged in trading activities in the ordinary sense of the word, such as charitable bodies<sup>6</sup>, whether incorporated or unincorporated<sup>7</sup>, and political organisations<sup>8</sup>. There have been cases where an individual has been entitled to restrain the use of his name in a business in a way which might potentially expose him to liability, apparently without regard to whether or not he is himself engaged in a trading activity<sup>9</sup>.

1 Other causes of action, such as injurious falsehood or defamation, may be applicable in some circumstances: see generally LIBEL AND SLANDER.

2 *Day v Brownrigg* (1878) 10 ChD 294, CA (where it was held that there could be no action by a private individual to prevent a neighbour adopting the same name for his house); *Earl Cowley v Countess Cowley* [1901] AC 450, HL (where no action lay to restrain continued use of a title by the former wife of a peer after her remarriage); *Kean v McGivan* [1982] FSR 119, CA (where one political party had no right of action to prevent a new party adopting the same name).

3 See eg *Lord Byron v Johnston* (1816) 2 Mer 29 (author's name); *Hines v Winnick* [1947] Ch 708, [1947] 2 All ER 517, 64 RPC 113 (musician's assumed name); *Marengo v Daily Sketch and Sunday Graphic Ltd* [1948] 1 All ER 406, 65 RPC 242, HL (cartoonist's nom de plume); *Clark v Associated Newspapers Ltd* [1998] 1 All ER 959, [1998] RPC 261 (false attribution of authorship). Authors, artists and composers may also be protected by the statutory right of a person to sue in respect of a false attribution to him of the authorship of a literary, dramatic, musical or artistic work: see the Copyright, Designs and Patents Act 1988 s 84 (as amended); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 471 et seq.

4 *Society of Accountants in Edinburgh v Corpn of Accountants Ltd* (1893) 20 R 750, Ct of Sess; *Society of Accountants and Auditors v Goodway and London Association of Accountants Ltd* [1907] 1 Ch 489; *Institute of Chartered Accountants of England and Wales v Hardwick* (1919) 35 TLR 342, CA; *Society of Incorporated Accountants v Vincent* (1954) 71 RPC 325; *British Association of Aesthetic Plastic Surgeons v Cambright Ltd* [1987] RPC 549; *Law Society of England & Wales v Society of Lawyers* [1996] FSR 739; cf *Society of Architects v Kendrick* (1910) 26 TLR 433. See also *British Medical Association v Marsh* (1931) 48 RPC 565 (chemist held himself out as being a branch of the association). Under the Trade Marks Act 1994 statutory protection is now afforded to trade associations by the registration of collective marks: see PARA 155 et seq ante.

5 *Lagos Chamber of Commerce Inc v Registrar of Companies and Association of Merchants and Industrialists* (1955) 72 RPC 263, PC.

However, a trade association cannot maintain an action in a representative capacity on behalf of its members who use a particular descriptive appellation (see PARA 319 post), because if the trade association does not itself use that appellation it has no goodwill to protect and thus does not have the same interest as its members: *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1999] RPC 826, CA; *Scotch Whisky Association v JD Vintners Ltd* [1997] Eu LR 446. See, however, *Artistic Upholstery Ltd v Art Forma (Furniture) Ltd* [1999] 4 All ER 277, [2000] FSR 311, where a trade association was held able to own, through its members, goodwill which could found an action for passing off.

6 *British Legion v British Legion Club (Street) Ltd* (1931) 48 RPC 555; *Re Dr Barnardo's Homes, National Incorporated Association v Barnardo Amalgamated Industries Ltd and Benardout* (1949) 66 RPC 103; *Old Apostolic Church Of Africa v Non-white Old Apostolic Church of Africa* [1975] (2) SA 684, SAHC; *Holy Apostolic and Catholic Church of the East (Assyrian) Australia NSW Parish Association v A-G* (1986) 16 IPR 619, NSWCA; *British Diabetic Association v Diabetic Society* [1995] 4 All ER 812, [1996] FSR 1.

7 *British Legion v British Legion Club (Street) Ltd* (1931) 48 RPC 555 at 562-563.

8 *Burge v Haycock* [2001] EWCA Civ 900, [2002] RPC 553, [2002] IP & T 213 (holding that *Kean v McGivan* [1982] FSR 119, CA (in which relief was refused) was a case on its own facts).

9 *Routh v Webster* (1847) 10 Beav 561 (where the unauthorised use of an individual's name in the promotion of a joint stock company was restrained). See also *Gray v Smith* (1889) 43 ChD 208, CA (where a successor to a partnership's business was held not entitled to use the name of a retired partner in a way which might expose him to continuing liabilities). It is not clear whether these actions are a species of passing off or a separate type of action.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/311. Shared reputations.

### **311. Shared reputations.**

In order to maintain an action for passing off a claimant need not be the only person entitled to make use of a particular mark or name<sup>1</sup>. Thus where the goodwill connected with the use of a trade name originally used in a single business is divided between different persons, each of those persons has an independent right to sue a third person for passing off by use of the trade name<sup>2</sup>. The same result may follow where different traders independently build up goodwill under the same name<sup>3</sup>.

Where the claimant is one of a class of persons involved in trading in goods under a descriptive name, he can maintain an action for passing off against a defendant misusing the name if his business or goodwill is likely to suffer more than minimal damage as a result of the defendant's activities<sup>4</sup>. The nature of the reputation and goodwill in this instance is different in kind from that enjoyed where the reputation in a trade name has been divided, for example a descriptive name, such as 'advocaat', which is non-proprietary in nature can be used by any trader to describe his goods which possess its qualities<sup>5</sup>, whereas the trade name indicates the origin of the goods rather than any particular standard of quality and can be used only by the persons who share the reputation<sup>6</sup>.

Where two or more parties share reputation in a mark, one may be restrained from making a misrepresentation which damages the goodwill owned by the other or others<sup>7</sup>.

1 As to concurrent rights of use see PARA 346 post.

2 *Dent v Turpin, Tucker v Turpin* (1861) 2 John & H 139; *Southorn v Reynolds* (1865) 12 LT 75.

3 *Parker & Son (Reading) Ltd v Parker* [1965] RPC 323; *Byford v Oliver* [2003] EWHC 295 (Ch), sub nom *SAXON Trade Mark* [2003] FSR 704, [2003] EMLR 416. See also *Sutherland v V2 Music Ltd* [2002] EWHC 14 (Ch), [2002] IP & T 904.

4 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 748, [1979] 2 All ER 927 at 937, [1980] RPC 31 at 98, HL. See also PARA 319 post.

5 See *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 747, [1979] 2 All ER 927 at 937, [1980] RPC 31 at 97, HL.

6 As to assignment and transmission see PARA 314 post.

7 *Sir Robert McAlpine Ltd v Alfred McAlpine plc* [2004] EWHC 630 (Ch), [2004] RPC 711.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/312. Ownership of goodwill by foreign traders.

### **312. Ownership of goodwill by foreign traders.**

A number of considerations arise when a claimant seeks to restrain the use in the United Kingdom of a name, mark or other indicium under which he has carried on business abroad<sup>1</sup>. A claimant in any case of passing off must prove a reputation extending to the geographical area in which the defendant's use of the name, mark or other indicium complained of is taking place<sup>2</sup>, whether this is in another part of the country in which the claimant trades or in a different country, because, if he has no reputation in that area, the defendant's use of a similar name or mark cannot involve any misrepresentation<sup>3</sup>. If the claimant can establish that a substantial number of persons with whom the defendant intends to trade in the United Kingdom know of the claimant and will believe that the defendant's business is a branch of or connected with the claimant's business, so that the element of misrepresentation is established, the claimant must further show, as in any action for passing off, that the misrepresentation poses a real and tangible risk of injury to his business or goodwill<sup>4</sup>.

It is unclear, however, whether there is an additional requirement that the claimant must carry on business in, or at least have a trade extending to, the country in which he seeks to restrain the defendant from using the mark or name, or whether the geographical separation of the claimant's business from the defendant's is a factual element which merely makes it difficult, but not impossible in all circumstances, for a claimant to show that the defendant's activities are likely to cause him substantial damage. What is clear is that a claimant who has no place of business in the United Kingdom and does not directly trade there, but whose goods are imported either by consumers or by intermediaries, can acquire<sup>5</sup> a reputation and goodwill that is able to be protected<sup>6</sup>. A business carried on abroad but which corresponds with customers in the United Kingdom can likewise acquire a reputation and goodwill able to be protected<sup>7</sup>.

It is more doubtful whether passing off can be established where the claimant's goods or services are neither marketed in the United Kingdom nor purchased by customers in the United Kingdom, but his customers who have come across his goods or services abroad reside in or come to the United Kingdom, although in one such case an interlocutory injunction was granted<sup>8</sup>. It has, however, been held<sup>9</sup> that a claimant whose establishment in Paris had been advertised in England through travel agents, and who had some customers in England who had visited Paris, could not maintain an action for passing off in England against a defendant who had adopted the name of the claimant's establishment and used similar advertising with the intent of exploiting the claimant's reputation, because goodwill could not be acquired without actual user in England<sup>10</sup>. This decision has been criticised as wrongly decided<sup>11</sup>, and tenuous user in the United Kingdom has been treated as justification for protection of a reputation primarily acquired by trade abroad<sup>12</sup>, but the case has been cited with approval by the Court of Appeal<sup>13</sup>.

The extent to which a reputation acquired by trading abroad may be protected in the United Kingdom may depend to some extent upon whether a trader is to be treated as a matter of law as having a separate goodwill in each country in which he trades<sup>14</sup> or whether the confining of goodwill to a particular country or area is a question of fact depending on the trading patterns and circumstances involved<sup>15</sup>. If goodwill is to be treated as a matter of law as stopping at frontiers, there may still be cases where the defendant's activities are likely to cause damage to the claimant's business in the country or countries where he trades<sup>16</sup>. However, even if the claimant has no protectable goodwill in the United Kingdom for the purpose of founding an action for passing off, he may have a statutory right to restrain by injunction the use in the

United Kingdom of a mark protected as a well known trade mark under the Paris Convention<sup>17</sup>. There may also be a statutory right where a foreign trader's mark is misappropriated by an agent or representative of his in the United Kingdom<sup>18</sup>.

1 As to passing off by the use of a name or mark see PARA 326 et seq post; and as to passing off by similarity of get-up or shape of goods see PARA 338 et seq post.

2 This is not necessarily the same country or area as that in which the defendant carries on business, in cases where the defendant applies a deceptive mark to goods for sale to ultimate purchasers in a different area or country: see PARA 307 ante. As to enabling passing off by others see PARA 331 post.

3 *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326, 16 RPC 397, HL, per Lord Shand; *Lee v Haley* (1869) 5 Ch App 155 (where the injunction was limited to a single street); *Barber v Manico* (1893) 10 RPC 93; *George Outram & Co Ltd v London Evening Newspapers Co Ltd* (1911) 28 RPC 308; *Brestian v Try* [1958] RPC 161, CA.

4 As to the requirement to show damage see PARA 333 post.

5 In some circumstances the importer, rather than the foreign manufacturer, may acquire ownership of the goodwill: see PARA 313 post. There is, however, nothing to prevent the defendant's own acts, in importing the claimant's goods, from creating a protectable goodwill in the United Kingdom belonging to the claimant which then entitles the claimant to sue the defendant (or others) for passing off: *Nishika Corpn v Goodchild* [1990] FSR 371.

6 *Collins Co v Brown* (1857) 3 K & J 423 (where the basis of the decision was that the defendant's fraud gave rise to a personal cause of action based on property); *SA des Anciens Etablissements Panhard et Levassor v Panhard Levassor Motor Co Ltd* [1901] 2 Ch 513, 18 RPC 405 (approved in *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [1984] FSR 413, CA); *Poiret v Jules Poiret Ltd* (1920) 37 RPC 177 (where the plaintiff had no place of business in England but he or his agents had made visits to sell dresses and had given a display at 10 Downing Street); *Roberts Numbering Machine Co v Davis* (1935) 53 RPC 79 (where the plaintiff had never had a business in England or an agency in the strict sense of the word but had sold to a sole importer); *Nishika Corpn v Goodchild* [1990] FSR 371 (where the defendant had imported the plaintiff's goods); *Jian Tools for Sale Inc v Roderick Manhattan Group Ltd* [1995] FSR 924 (where the American plaintiff had sold goods to customers in the United Kingdom through magazines circulating there); *Mecklermedia Corpn v DC Congress GmbH* [1998] Ch 40, [1998] 1 All ER 148, [1997] FSR 627 (where the plaintiff had organised trade shows in the United Kingdom); and see *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 at 233, HL, per Lord Robertson.

7 *Grant (t/a Globe Furnishing Co) v Levitt* (1901) 18 RPC 361 (where the plaintiff carried on business in Liverpool and corresponded with customers in Ireland); *Pete Waterman Ltd v CBS United Kingdom Ltd* [1993] EMLR 27 (where the defendant operated a recording studio in New York which was booked by, and which rendered invoices to, United Kingdom customers).

8 *Sheraton Corpn of America v Sheraton Motels Ltd* [1964] RPC 202 (where the owners of an international chain of hotels were able to restrain the defendant from opening a hotel under the same name at Prestwick Airport, although they had no hotel in the United Kingdom; the plaintiffs took some bookings for their hotels abroad through an office established in London, but this fact was not treated as significant).

9 *le in Alain Bernardin & Cie v Pavilion Properties Ltd* [1967] RPC 581.

10 *Alain Bernardin & Cie v Pavilion Properties Ltd* [1967] RPC 581 at 584, based principally on a dictum of Jenkins LJ in *T Oertli AG v EJ Bowman (London) Ltd* [1957] RPC 388 at 397, CA (affd [1959] RPC 1, HL), and on an extract from the speech of Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 at 223-224, HL.

11 See *Maxim's Ltd v Dye* [1978] 2 All ER 55 at 58, [1977] 1 WLR 1155 at 1158, [1977] FSR 364 at 367 per Graham J (not following *Alain Bernardin & Cie v Pavilion Properties Ltd* [1967] RPC 581; but explaining *IRC v Muller & Co's Margarine Ltd* [1901] AC 217, HL; and applying *Baskin-Robbins Ice Cream Co v Gutman* [1976] FSR 545 at 548 per Graham J); *Pete Waterman Ltd v CBS United Kingdom Ltd* [1993] EMLR 27 at 53 per Browne-Wilkinson V-C. See also *C and A Modes v C and A (Waterford) Ltd* [1978] FSR 126, Ir CA; *Orkin Exterminating Co Inc v Pestco of Canada Ltd* (1985) 19 DLR 90, Ont CA; *Dominion Rent A Car Ltd v Budget Rent A Car Systems (1970) Ltd* [1987] 2 NZLR 395, NZ CA; *ConAgra Inc v McCain Foods (Aust) Pty Ltd* (1992) 23 IPR 193, Aust HC; *Calvin Klein Inc v International Apparel Syndicate* [1995] FSR 515, Calcutta HC; *Yahoo! Inc v Akash Akora* [1999] FSR 931, Delhi HC. In *Metric Resources Corpn v Leasemetrix Ltd* [1979] FSR 571, Megarry V-C considered that the correctness of the decision in *Alain Bernardin & Cie v Pavilion Properties Ltd* supra was a difficult point of law fully arguable on either side; and in *Athletes Foot Marketing Associates Inc v Cobra Sports Ltd* [1980] RPC 343, Walton J adopted the intermediate position that it was sufficient for a plaintiff to have some customers in

the United Kingdom but insufficient to have a reputation but no customers, a position which was followed in *Pete Waterman Ltd v CBS United Kingdom Ltd* supra.

12 *Globelegance BV v Sarkissian* [1974] RPC 603. See also *JC Penney Co Inc v Punjabi Nick* [1979] FSR 26, Hong Kong SC; *Tan-Ichi Co v Jancar Ltd* [1990] FSR 151, Hong Kong SC (commenting on changes in modern day trading conditions resulting from increased numbers of travellers and tourists).

13 *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [1984] FSR 413, CA (where the plaintiffs had some reputation, but no trade, in the United Kingdom except that they made considerable sales to American personnel through United States service stores, and it was held that the sale of the defendants' beer on the general market would cause the plaintiffs no damage as they had no trade in that market to be interfered with).

14 See *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* [1976] FSR 256 at 269, PC; *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 752, [1979] 2 All ER 927 at 941, [1980] RPC 31 at 102, HL, per Lord Fraser of Tullybelton, citing *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* supra. In *Metric Resources Corpn v Leasemetrix Ltd* [1979] FSR 571 at 579, Megarry V-C considered that in no sense was *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* supra a decision that the owner of a business carried on outside the jurisdiction could not establish goodwill capable of protection within the jurisdiction before beginning to trade there, although literal application of what was said in that case provided support for that proposition.

15 See *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 at 224, HL, per Lord Macnaghten, at 228 per Lord James of Hereford and at 233-234 per Lord Robertson, who considered that, if the trade of the German margarine factory had been diffused over several countries, the question of the location of the goodwill would have been more complex, and cf Lord Lindley at 235 who considered that goodwill was located at the place where the business was carried on; *Lacteosote Ltd v Alberman* [1927] 2 Ch 117, 44 RPC 211 (where the French and British markets were supplied from a single factory in France and the goodwill in the United Kingdom was held not severable from that of the French business); *Ingenohl v Wing On & Co (Shanghai) Ltd* (1927) 44 RPC 343, PC (where expropriation of the goodwill of part of a business in the Philippines was held to carry with it the right to use the marks of the business in other countries in competition with the original owner); *Maxim's Ltd v Dye* [1978] 2 All ER 55 at 59, [1977] 1 WLR 1155 at 1159-1160, [1977] FSR 364 at 368 per Graham J; *C and A Modes v C and A (Waterford) Ltd* [1978] FSR 126 at 138, Ir CA, per Henchy J (where the plaintiff's business in Northern Ireland had many customers from the Republic of Ireland); *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [1984] FSR 413, CA (where goodwill attached to the plaintiff's trade in United States service bases in the United Kingdom was treated as an extension of the plaintiff's American goodwill); *Pete Waterman Ltd v CBS United Kingdom Ltd* [1993] EMLR 27 at 53-58 per Browne-Wilkinson V-C, who questioned the need for a severable goodwill locally situate within the jurisdiction.

16 See eg *Sheraton Corpn of America v Sheraton Motels Ltd* [1964] RPC 202 (cited in note 8 supra). In an appropriate case it may be possible for the claimant to sue the defendant in England for a wrong actionable under the law of the country in question by virtue of the Private International Law (Miscellaneous Provisions) Act 1995 Pt III (ss 9-15) (see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 368 et seq).

17 See PARA 153 ante. As to the Paris Convention see PARA 6 ante.

18 See PARA 154 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/313. Ownership of goodwill attached to names, marks etc.

### **313. Ownership of goodwill attached to names, marks etc.**

Questions often arise as to the ownership of the goodwill attached to names, marks and other indicia used in relation to goods or services with which two or more persons have been connected in different capacities<sup>1</sup>.

Thus, when goods made by a foreign manufacturer are imported by a dealer, the goodwill in the name or mark applied to them may belong, depending on the circumstances<sup>2</sup>, either to the manufacturer<sup>3</sup> or to the dealer<sup>4</sup>. Where the foreign manufacturer is from a country which belongs to the Paris Convention<sup>5</sup>, he may have a statutory right to restrain the unauthorised use by an agent or representative of his in the United Kingdom of a trade mark of which he is proprietor in his own country<sup>6</sup>. A name or mark initially belonging to and denoting goods of the manufacturer can become distinctive of the dealer if he is allowed over a sufficient period to sell goods made by himself or acquired from other sources under the name or mark<sup>7</sup>. Where the mark is the manufacturer's mark, an importer cannot maintain an action against a third person for the passing off of goods as those of the manufacturer by the use of the mark, even though he has by contract with the manufacturer the exclusive right to import the goods and suffers pecuniary damage as a result of the passing off<sup>8</sup>. Although by contract the dealer and manufacturer may regulate the ownership of a name or mark as between themselves, their contractual arrangements will not necessarily bind a third person, so that, if the name or mark in fact denotes goods of a foreign manufacturer, the purported assignment of the goodwill attached to the mark in the United Kingdom to the importer will not prevent a third person from importing goods to which the manufacturer has applied the name or mark<sup>9</sup>. Similarly, a purported assignment of goodwill in a mark to the manufacturer may not give him good title to sue a third person if the mark in fact denotes goods originating from the business of the dealer<sup>10</sup>.

Similar questions arise as to the ownership of goodwill in names and marks as between licensors and licensees of patented and other manufacturing processes, where it seems essential in order for the licensor to retain ownership of the goodwill that he should exercise sufficient control over the manufacture and sale of products by the licensee<sup>11</sup>.

Questions as to the ownership of the goodwill in a name can arise between employer and employee where the employee's name, either real or assumed, is used in the course of the employer's business. It is possible for the employee's name to be so used in the course of the employer's business that it becomes distinctive of the employer rather than of the employee<sup>12</sup>.

The nom de plume of a writer or the assumed name of a performer or musician prima facie belongs to the individual concerned<sup>13</sup>.

Where various members of a group of companies use trading styles which embody a common element distinctive of the group, or are associated in various capacities with goods bearing trade marks used by the group, the ownership of the goodwill attached to the names or marks as between members of the group may be uncertain<sup>14</sup>. It would appear that, in the absence of contrary agreement, a subsidiary or associated company which is permitted by the group to build up a business acquires an interest in the goodwill sufficient to enable it to continue to trade under the same style after its connection with the group is severed<sup>15</sup>. Where an international group of companies trades in a particular country through a particular company, the goodwill enjoyed in that country may belong to that company in the sense that the company is the appropriate claimant in an action for passing off, but nevertheless the goodwill

and reputation may remain that of the international group so that other members of the group can also trade in that country without transfer of the goodwill or licence, express or implied<sup>16</sup>.

1 Similar questions arose under the old law relating to registered trade marks, and the cases are still of relevance in connection with ownership of goodwill in an action for passing off, since only the person entitled to ownership of the goodwill attached to the mark was entitled to register it: *Re Apollinaris Co's Trade Marks* [1891] 2 Ch 186 at 226, 8 RPC 137 at 160-161, CA, per Fry LJ. The question of ownership often arose as between importers and overseas manufacturers: see *European Blair Camera Co's Trade Mark* (1896) 13 RPC 600; *Re New Atlas Rubber Co Ltd's Trade Mark* (1918) 35 RPC 269 ('Talisman'); *Re Warschauer's Application* (1925) 43 RPC 46 ('Obermeier'); *Re Elaine Inescourt's Trade Mark* (1928) 46 RPC 13; *Re Lesquendieu Trade Marks* (1934) 51 RPC 273. See also *Re Wood's Trade Mark* (1886) 32 ChD 247, 3 RPC 81, CA; *Walker & Sons Ltd v Kego* (1921) 38 RPC 25; *Re Impex Electrical Ltd's Trade Marks, Impex Electrical Ltd v Weinbaum* (1927) 44 RPC 405; *JH Coles Pty Ltd v Need* [1934] AC 82, 50 RPC 379, PC; *Re Kidax (Shirts) Ltd's Applications* [1960] RPC 117 at 124, CA; *Re Diehl KG's Application* [1969] 3 All ER 338, [1970] 2 WLR 944, [1970] RPC 435.

2 The issue of ownership of goodwill always turns on the facts on the case, such that reference to previous decisions is unlikely to be helpful: *Scandecor Development AB v Scandecor Marketing AB* [1999] FSR 26, CA; on appeal [2001] UKHL 21, [2001] IP & T 676.

3 *Richards v Butcher* [1891] 2 Ch 522, 7 RPC 288 (affd [1891] 2 Ch 522 at 540, 8 RPC 249, CA); *Van Zeller v Mason, Cattley & Co* (1907) 25 RPC 37; *Dental Manufacturing Co Ltd v C De Trey & Co* [1912] 3 KB 76, 29 RPC 617, CA; *Imperial Tobacco Co of India Ltd v Bonnan* [1924] AC 755, 41 RPC 441, PC; *Edison Storage Battery Co v Britannia Batteries Ltd* (1931) 48 RPC 350; *Roberts Numbering Machine Co v Davis* (1935) 53 RPC 79; *A/B Helsingfors Manus v RJ Fullwood & Bland Ltd* [1949] Ch 208, [1949] 1 All ER 205, CA.

4 See eg *J Defries & Sons Ltd and Helios Manufacturing Co v Electric and Ordnance Accessories Co Ltd* (1906) 23 RPC 341 (where the name was chosen by the dealer and the articles were made up by the manufacturer to the dealer's order and it was held that the dealer was entitled to restrain the manufacturer from applying the mark to other goods); *Ullman & Co v Cesar Leuba* [1908] AC 443, 25 RPC 673, PC; *DIEHL Trade Mark* [1970] RPC 435; *MedGen Inc v Passion for Life Products Ltd* [2001] FSR 496 (product developed in the United States by claimant but exclusively marketed in the United Kingdom by defendant).

5 As to the Paris Convention see PARA 6 ante.

6 See the Trade Marks Act 1994 s 60(1), (4); and PARA 154 ante.

7 *Jaeger v Jaeger & Co Ltd* (1927) 44 RPC 437, CA; *Sturtevant Engineering Co Ltd v Sturtevant Mill Co of USA Ltd* [1936] 3 All ER 137, 53 RPC 430; *Adrema Ltd v Adrema-Werke GmbH and BEM Business Efficiency Machines Ltd* [1958] RPC 323; *Scandecor Development AB v Scandecor Marketing AB* [1999] FSR 26, CA (on appeal [2001] UKHL 21, [2001] IP & T 676). See also *T Oertli AG v EJ Bowman (London) Ltd* [1959] RPC 1, HL. Cf *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 (where a distributor had sold a supplier's goods for a number of years in co-operation with the supplier it was held that goodwill in the mark was jointly owned).

8 *Richards v Butcher* [1891] 2 Ch 522 at 540, 8 RPC 249, CA; *Dental Manufacturing Co Ltd v C De Trey & Co* [1912] 3 KB 76, 29 RPC 617, CA. There is some doubt as to how rigid this rule is after the decision in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL. See PARA 319 post.

9 It is not clear whether the basis of this rule is that the purported assignment of goodwill is altogether ineffective because there is no assignment of the goodwill in the business (ie the manufacturing business) to which the mark in fact relates (see *Lacteosote Ltd v Alberman* [1927] 2 Ch 117, 44 RPC 211), or whether the importer would have good title to sue for true piracy but cannot restrain importation of goods bearing the manufacturer's mark because that use of the mark involves no misrepresentation (see *Imperial Tobacco Co of India Ltd v Bonnan* [1924] AC 755 at 762, 41 RPC 441 at 448, PC). As to parallel imports generally see PARA 347 post.

10 *Ullman & Co v Cesar Leuba* [1908] AC 443, 25 RPC 673, PC.

11 *T Oertli AG v EJ Bowman (London) Ltd* [1959] RPC 1 at 7, HL, per Lord Reid; and see *Freeman Bros v Sharpe Bros & Co Ltd* (1899) 16 RPC 205; cf *JH Coles Pty Ltd v Need* [1934] AC 82, 50 RPC 379, PC.

12 *Birmingham Vinegar Brewery Co v Liverpool Vinegar Co and Holbrook* (1888) 4 TLR 613 (where an employer was held entitled to restrain an ex-employee and persons to whom the employee purported to assign the right to sell sauce bearing the ex-employee's name); cf *Franke v Chappell* (1887) 3 TLR 524 (where the name 'Richter concerts' was held to be associated with the conductor Richter and not with the person who had

first organised concerts with Richter under that name, so that he could not prevent others from announcing concerts by Richter as 'Richter concerts').

13 See *Landa v Greenberg* (1908) 24 TLR 441; *Hines v Winnick* [1947] Ch 708 at 713, [1947] 2 All ER 517 at 520, 64 RPC 113 at 117 per Vaisey J; *Modern Fiction Ltd v Fawcett* (1949) 66 RPC 230; *Forbes v Kemsley Newspapers Ltd* (1951) 68 RPC 183; *Sykes v John Fairfax & Sons Ltd* [1978] FSR 312.

14 It is rarely of practical importance in actions for passing off against third persons whether the goodwill is owned by the parent company, its subsidiaries or is shared between them, since the general practice when in doubt is to join as claimants the parent and all relevant subsidiaries in order to prevent the defendant from taking a technical point on title to sue.

As to the ownership of goodwill as between franchisor and franchisee see PARA 316 note 1 post.

15 *Habib Bank Ltd v Habib Bank AG Zurich* [1981] 2 All ER 650, [1981] 1 WLR 1265, [1982] RPC 1, CA; and see also *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669, CA (where the agreement was that the subsidiary could use the name 'Dawnay Day' only for so long as it remained a company in the Dawnay Day group). Cf *Anderson & Lembke Ltd v Anderson & Lembke Inc* [1989] RPC 124 (United Kingdom branch of foreign corporation which had common origin to separate United Kingdom company entitled to state its affiliation on notepaper and business cards; but it had adopted a different trading style).

16 *Habib Bank Ltd v Habib Bank AG Zurich* [1981] 2 All ER 650 at 661, [1981] 1 WLR 1265 at 1278, [1982] RPC 1 at 30, CA, per Oliver LJ. See also *Revlon Inc v Cripps and Lee Ltd* [1980] FSR 85, CA; *Imperial Tobacco Co of India Ltd v Bonnan* [1924] AC 755 at 762, 41 RPC 441 at 448, PC.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/314. Assignment and transmission of goodwill and rights in marks, names etc.

### **314. Assignment and transmission of goodwill and rights in marks, names etc.**

The goodwill<sup>1</sup> of a business, and with it the appendant right to restrain others from using names, marks or other indicia confusingly similar to those used in the business, generally passes by devolution upon death<sup>2</sup>, by operation of law<sup>3</sup> or by assignment<sup>4</sup>. Some names or marks, for example an artist's name, may so denote a particular individual and his personal skills as to be incapable of assignment<sup>5</sup>. However, the courts generally consider that names, marks and other indicia, even if originally derived from an individual's name used in a business, may come to denote goods or services originating from that business without being a representation as to the persons by whom the business is from time to time carried on, so that a successor to the business is entitled to continue to represent by the use of such names or marks that his goods or services come from that business, and to restrain a stranger from using them in a way which will lead to deception<sup>6</sup>. However, it follows from this that a mere right to use a name or mark cannot be validly assigned so as to confer rights against the public<sup>7</sup> without the goodwill of the business concerned<sup>8</sup> or at least of a severed or severable part of it<sup>9</sup>. Goodwill in distinct geographical areas is in general divisible<sup>10</sup>, but in some circumstances the goodwill in one country cannot be severed from that of the business as a whole<sup>11</sup>.

By statute, registered trade marks may now be assigned without the goodwill of the business to which they relate<sup>12</sup>. When a registered trade mark is assigned, it is not clear whether or to what extent the common law rights attaching to the mark, or the rights to an unregistered mark used in the same business in relation to the same goods, may be assigned with it without the goodwill of the business<sup>13</sup>.

1 As to goodwill see PARA 306 et seq ante.

2 *Croft v Day* (1843) 7 Beav 84.

3 Eg upon the bankruptcy of an individual the goodwill vests in his trustee in bankruptcy: see BANKRUPTCY AND INDIVIDUAL INSOLVENCY vol 3(2) (2002 Reissue) PARAS 424-425.

4 *Churton v Douglas* (1859) John 174; *Hall v Barrows* (1863) 4 De GJ & Sm 150; *Levy v Walker* (1879) 10 ChD 436, CA. See also *Harrods Ltd v Harrods (Buenos Aires) Ltd* [1999] FSR 187, CA (English retailer giving South American company irrevocable permission to use the name 'Harrods' in South America); *Tin Tin Yat Pao (International) Ltd v Tin Tin Publication Development Ltd* [2000] 3 HKC 1, [2000] IP & T 1109, HK CFA (licence to carry on licensor's business for a limited period akin to assignment and reversion back).

5 See *Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at 545 per Lord Kingsdown; *Thorneloe v Hill* [1894] 1 Ch 569 at 575, 11 RPC 61 at 70 per Romer J. The statutory right of a person to sue in respect of a false attribution of ownership of a literary, dramatic, musical or artistic work under the Copyright, Designs and Patents Act 1988 s 84 appears to be a personal right exercisable by the individual concerned, or by his personal representatives up to 20 years after his death: see s 86(2); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 480.

6 *Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at 534 per Lord Cranworth, who said that the question in every such case must be whether the purchaser in continuing the use of the original trade mark would, according to the ordinary usages of trade, be understood as saying more than that he was carrying on the same business as had been formerly carried on by the person whose name constituted the trade mark; *Thorneloe v Hill* [1894] 1 Ch 569 at 575, 11 RPC 61 at 70 per Romer J; *Rickerby v Reay* (1903) 20 RPC 380.

7 A purported assignment may be effective between the parties to it.

8 This is because the successor's use of the name or mark, in falsely passing off his goods and services as coming from the source from which the public is accustomed to receive them, is itself deceptive, and he has no better right than a stranger to restrain the use of such name or mark by a third person: *Thorneloe v Hill* [1894] 1 Ch 569, 11 RPC 61. This was also the old position in relation to registered trade marks, although that law has now been radically altered by statute to facilitate assignments of registered marks with or without the goodwill of the business: see the Trade Marks Act 1994 s 24(1); and PARA 129 ante. The old cases relating to assignments of registered marks are, however, still relevant in the context of assignment of common law goodwill. Any assignment of trade marks in gross, ie dissociated from the goodwill of their business of origin, was invalid: *Pinto v Badman* (1891) 8 RPC 181, CA. A mark could not be assigned for parts of a wholesale business or for selling rights without manufacturing rights: *Lacteosote Ltd v Alberman* [1927] 2 Ch 117, 44 RPC 211; *Re John Sinclair Ltd's Trade Mark* [1932] 1 Ch 598, 49 RPC 123, CA; *Re Dobie & Sons Ltd's Trade Mark* (1935) 52 RPC 333. See also *Re Berna Commercial Motors Ltd* [1915] 1 Ch 414, 32 RPC 113; *Re GH Mumm & Co's Applications* (1922) 39 RPC 379; *Re Cranbux Ltd's Application* [1928] Ch 829, 45 RPC 281. A mark which in fact never had been used was not assignable: see *Re Ducker's Trade Mark* [1929] 1 Ch 113, 45 RPC 397, CA.

9 *Thorneloe v Hill* [1894] 1 Ch 569 at 577, 11 RPC 61 at 72.

10 *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* [1976] FSR 256, PC.

11 *Lacteosote Ltd v Alberman* [1927] 2 Ch 117, 44 RPC 211 (where French and British markets were supplied from a single factory in France and it was held that the goodwill in Britain was not separately assignable). See also *Ingenohl v Wing On & Co (Shanghai) Ltd* (1927) 44 RPC 343, PC.

12 See the Trade Marks Act 1994 s 24(1); and PARA 129 ante.

13 The provisions of the Trade Marks Act 1938 s 22(3) (repealed), which explicitly authorised the conveyance of rights to an unregistered mark without the goodwill of the business when assigned together with a registered mark, have not been replaced. The Trade Marks Act 1994 s 24(6) (see PARA 129 ante) merely states that the Act does not affect the assignment of an unregistered trade mark as part of the goodwill of the business.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/315. Effect of transfer of goodwill.

### 315. Effect of transfer of goodwill.

The transfer of the goodwill of a business generally gives to the successor the right, as against the predecessor, to use the name, marks<sup>1</sup> and other indicia of the business, even if the name of the business includes the predecessor's own name<sup>2</sup>. However, there may be some circumstances in which, because continued use of the name under which the business was previously carried out could amount to a misrepresentation<sup>3</sup>, continued use of the name can be restrained by the predecessor in title or other parties formerly associated with the business<sup>4</sup>.

Generally, following a transfer of goodwill, the predecessor is not entitled to represent by the use of the name or marks of the firm, or otherwise, that he is carrying on the same business as before<sup>5</sup>, although in the absence of a contractual restriction he is entitled to continue in the same line of business in the same area<sup>6</sup>, and to make plain his former connection with the business<sup>7</sup>.

If the name of the business concerned is the personal name of the transferor, the transfer of the goodwill does not of itself deprive him of the right enjoyed by any other person of trading under his own name<sup>8</sup>, although it seems that in such circumstances there may be a positive obligation upon the transferor to make plain in advertisements or by other means that his connection with the former business has ceased<sup>9</sup>. Goodwill and the appendant rights to use names or marks are usually assigned expressly, but may be conveyed by implication in the sale of the assets of a business as a going concern<sup>10</sup>.

1 The rights to trade marks, whether registered or unregistered, generally pass with the goodwill of a business in the absence of an express stipulation to the contrary: *William Currie & Co v Currie* (1898) 15 RPC 339. See also PARA 314 ante.

2 *Churton v Douglas* (1859) John 174; *Melrose-Drover Ltd v Heddle* (1901) 4 F (Ct of Sess) 1120; *Wood v Hall* (1915) 33 RPC 16. See also *Levy v Walker* (1879) 10 ChD 436, CA. In using the name or mark the successor is, however, not entitled to use the predecessor's name in such a way as to represent that the predecessor is still carrying on the business: *Thynne v Shove* (1890) 45 ChD 577. As to goodwill generally see PERSONAL PROPERTY vol 35 (Reissue) PARAS 1206-1210.

3 Eg that the defendant is part of the corporate group who previously carried on that business.

4 Eg a former parent company once the connection with it implied by the name of the subsidiary has ceased: *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669, CA.

5 *Churton v Douglas* (1859) John 174; *Mrs Pomeroy Ltd v Scalé* (1906) 24 RPC 177 at 181 per Buckley J; *May v May* (1914) 31 RPC 325, DC; *IN Newman Ltd v Adlem* [2005] EWCA Civ 741, [2006] FSR 253.

6 *Hall v Barrows* (1863) 4 De GJ & Sm 150; *Labouchere v Dawson* (1872) LR 13 Eq 322.

7 *Trego v Hunt* [1896] AC 7 at 27, HL, per Lord Davey; *Anderson & Lembke Ltd v Anderson & Lembke Inc* [1989] RPC 124; *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669, CA. See also *Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at 540-541.

8 *Mrs Pomeroy Ltd v Scalé* (1906) 24 RPC 177 at 181 per Buckley J, and at 188 per Parker J. As to the right of an individual to trade under his own name, notwithstanding that confusion may result, see PARA 344 post.

9 *Mrs Pomeroy Ltd v Scalé* (1906) 24 RPC 177 at 192 per Parker J; *May v May* (1914) 31 RPC 325, DC; *IN Newman Ltd v Adlem* [2005] EWCA Civ 741, [2006] FSR 253. In this respect the transferor may be under a slightly higher duty than a third person in the same situation by virtue of an implied contractual duty arising between a vendor and purchaser of goodwill. A person who voluntarily sells the goodwill of a business may also have an implied duty to the purchaser not to solicit his former customers: *Trego v Hunt* [1896] AC 7, HL. No

such duty can be implied where goodwill has been transferred compulsorily, eg by a sale by a trustee in bankruptcy of part of a bankrupt's assets: *Walker v Mottram* (1881) 19 ChD 355, CA.

10     *Rickerby v Reay* (1903) 20 RPC 380.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(ii) Goodwill/316. Licensing of goodwill and rights in marks, names etc.

### 316. Licensing of goodwill and rights in marks, names etc.

The use of names, marks and other indications of origin of goods or services may be licensed to others<sup>1</sup> but, as in relation to assignments<sup>2</sup>, a person who licenses or purports to license the use of a name or mark in gross, namely without exercising quality control over, or otherwise retaining sufficient connection with, the goods or business concerned<sup>3</sup>, may lose the right to sue third persons for passing off since the names or marks will have ceased in fact to denote the claimant's goods or business<sup>4</sup>.

The Trade Marks Act 1994 has greatly liberalised the rights of the proprietor of a registered trade mark to license his mark as compared with the more restrictive registered user requirements under the Trade Marks Act 1938<sup>5</sup>. The provisions of the Trade Marks Act 1938 which deemed use by a registered user to be use by the proprietor for the purposes of both that Act and the common law<sup>6</sup> have, however, not been replaced in the Trade Marks Act 1994, thereby rendering it unclear whether licensing in gross of a registered trade mark will cause loss of the proprietor's concurrent common law right to sue for passing off<sup>7</sup>.

1 An increasingly common form of licence of goodwill is a franchise agreement. Such an agreement is best regarded as a lease of goodwill by the franchisee to the franchisor, which reverts back to the franchisor (hopefully enhanced by the activities of the franchisee) at the end of the period of the franchise: *Kall Kwik Printing (UK) Ltd v Rush* [1996] FSR 114; *Dyno-Rod plc v Reeve* [1999] FSR 148. See also *Tin Tin Yat Pao (International) Ltd v Tin Tin Publication Development Ltd* [2000] IP & T 1109, HK CFA, [2000] 3 HKC 1.

2 As to the assignment of rights in marks and names see PARA 314 ante.

3 See *T Oertli AG v EJ Bowman (London) Ltd* [1959] RPC 1 at 7, HL, per Lord Reid. Cf *JH Coles Pty Ltd v Need* [1934] AC 82, 50 RPC 379, PC (where the franchising of the name of the plaintiff's store to the defendant on condition that the defendant acquired his goods from the plaintiff did not prevent the trade name from remaining distinctive of the plaintiff); *Tin Tin Yat Pao (International) Ltd v Tin Tin Publication Development Ltd* [2003] 3 HKC 1, [2000] IP & T 1109, HK CFA (where the licensor licensed the licensee to carry on the very business formerly carried on by the licensor for a limited period, the mark under which the mark was conducted remained distinctive of that business; in any event the licence contained an implied negative covenant that the licensee would not operate the business after the expiry of the licence).

4 *Thorneloe v Hill* [1894] 1 Ch 569, 11 RPC 61. See also *Star Industrial Co Ltd v Yap Kwee Kor (t/a New Star Industrial Co)* [1976] FSR 256 at 271, PC (criticising *Warwick Tyre Co Ltd v New Motor and General Rubber Co Ltd* [1910] 1 Ch 248, 27 RPC 161).

The law relating to the licensing of registered trade marks has now been relaxed freely to permit licensing (see PARA 136 ante) and this will not generally render the trade mark deceptive (see PARA 116 ante), but the old cases relating to invalidity of registered trade marks through licensing are still relevant to passing off. Before the Trade Marks Act 1938 the grant of a licence to use a trade mark for goods other than those of the proprietor invalidated a registered trade mark: *Bowden Wire Co Ltd v Bowden Brake Co Ltd* (1913) 30 RPC 580; affd (1914) 31 RPC 385, HL. Cf *Manus Akt v RJ Fullwood and Bland Ltd* [1949] Ch 208, [1949] 1 All ER 205, 66 RPC 71, CA (where it was held that a clause in a patent licence requiring the defendants to use the registered mark did not invalidate the mark). See also *Somerlite Ltd v Brown* (1934) 51 RPC 205 at 224, CA. Such licensing was held to be deceptive in the same way as an assignment divorced from the goodwill of the business was considered deceptive: *Bowden Wire Co Ltd v Bowden Brake Co Ltd* (1914) 31 RPC 385 at 392, HL, per Lord Loreburn. In other words, a licence of a trade mark was thought to be contrary to the very purpose of such a mark, namely to denote the trade origin of goods. After the passage of the Trade Marks Act 1938, however, it was held that the exercise of effective quality control was generally sufficient to save a licensed mark from invalidity: *Bostitch Trade Mark* [1963] RPC 183 at 195-197 (where there was a licence of design and know-how together with a trade mark licence and the trade mark was held valid), referred to with apparent approval in *Re American Greetings Corp'n's Application* [1984] 1 All ER 426, [1984] 1 WLR 189, HL. Cf *Weston Trade Mark* [1968] RPC 167 (where the trade connection had long been destroyed and the mark denoted the goods of an ex-licensee); *British Petroleum Co Ltd v European Petroleum Distributors Ltd* [1968] RPC 54 (where the fact that



a licence to a wholly-owned subsidiary was unregistered was held to be irrelevant); *GE Trade Mark* [1969] RPC 418 at 457, 459 per Graham J (on appeal [1970] RPC 339 at 372, CA, per Salmon LJ, and at 391-395 per Cross LJ) (where a joint venture company was subject to the quality control of the registered proprietor); and *McGREGOR Trade Mark* [1979] RPC 36 (where the trade mark was revoked because it had been licensed without any quality control).

5 See PARA 136 ante.

6 le the Trade Marks Act 1938 s 28(2) (repealed).

7 It is not clear whether the registered trade mark would be rendered invalid for this reason: see PARA 116 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/317. Nature of the misrepresentation.

### (iii) Misrepresentation

#### 317. Nature of the misrepresentation.

The earliest recognised type of misrepresentation in an action for passing off is a false representation that the defendant's goods are the claimant's<sup>1</sup>. The action also embraces a wide range of more subtle misrepresentations<sup>2</sup>, such as:

- 427 (1) that the claimant's goods of one class or quality are of another class or quality<sup>3</sup>;
- 428 (2) that the claimant's goods of a type or quality sold abroad which is different from the type or quality of the claimant's goods normally sold in the home market are goods of the type or quality normally sold in the home market<sup>4</sup>;
- 429 (3) that secondhand or used goods of the claimant are new<sup>5</sup>;
- 430 (4) that seconds or rejects of the claimant's manufacture to which the claimant has chosen not to apply his mark are goods of the claimant's ordinary manufacture<sup>6</sup>;
- 431 (5) that stale or deteriorated goods are in the state of freshness in which purchasers would ordinarily receive the claimant's goods<sup>7</sup>;
- 432 (6) that outmoded or superseded goods are the claimant's current production<sup>8</sup>;
- 433 (7) that altered or adulterated goods are goods of the claimant's original manufacture<sup>9</sup>;
- 434 (8) that goods are covered by the claimant's guarantee when they are not so covered<sup>10</sup>; or
- 435 (9) that the defendant's goods belong to a class of goods with a discrete reputation, when they do not<sup>11</sup>.

The same principles as apply to goods apply to misrepresentations relating to businesses or services, so that the misrepresentation may be that the defendant's business is the business of the claimant<sup>12</sup>, or is a branch or department or subsidiary company of the claimant<sup>13</sup>, or that the defendant is authorised to act as agent for<sup>14</sup> the claimant or is a member of<sup>15</sup>, or has some special relationship with, the claimant, such as that of authorised dealer<sup>16</sup>.

A mere representation that the defendant is sponsored by the claimant or that the claimant provides financial support to the defendant is not sufficient to found an action for passing off, where there is no likelihood of persons to whom the representation has been made relying upon the exercise by the claimant of control over the defendant's trading standards or the quality of the defendant's goods or services<sup>17</sup>. On the other hand, a misrepresentation that a celebrity has endorsed the defendant's goods or services is actionable<sup>18</sup>.

1 *Frank Reddaway & Co Ltd v George Banham & Co Ltd* [1896] AC 199 at 204, 13 RPC 218 at 224, HL, per Lord Halsbury. It is unnecessary for this purpose that purchasers should be aware of the actual identity of the claimant so long as they are induced to believe that the defendant's goods are from a source which they recognise and which is in fact the claimant: see PARA 318 post.

2 However, a false representation cannot found an action in passing off unless it relates to the claimant's goods: *Schulke & Mayr (UK) Ltd v Alkapharm (UK) Ltd* [1999] FSR 161; and see PARA 319 note 12 post.

3 *Teacher v Levy* (1905) 23 RPC 117; *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273, HL.

4 *Champagne Heidsieck & Cie v Scotto and Bishop* (1926) 43 RPC 101 (labels on the plaintiff's continental quality champagne bottles were replaced with imitations of the labels on the plaintiff's English quality champagne). It has been held that a defendant can make an implied representation to this effect even when he does no more than import goods and sell them under the marks and labels which the claimant himself has applied to them, if the claimant sells differing qualities of goods under similar labels in territorially distinct markets: *Colgate-Palmolive Ltd v Markwell Finance Ltd* [1989] RPC 497, CA; *Microsoft Corp v Computer Future Distribution Ltd* [1998] All ER (D) 78; cf *Revlon Inc v Cripps and Lee Ltd* [1980] FSR 85 at 112, CA (where Templeman LJ held that there could be no passing off when products manufactured, named, labelled and put into circulation by a member of the plaintiff's group of companies were sold by the defendants without any alteration to the contents, name or label). As to parallel imports see PARA 347 post.

5 *Gillette Safety Razor Co and Gillette Safety Razor Ltd v Franks* (1924) 41 RPC 499; *Morris Motors Ltd v Lilley (t/a G and L Motors)* [1959] 3 All ER 737, [1959] 1 WLR 1184. The circumstances in which goods are sold, such as the nature of the trade outlet, and the appearance of the goods themselves, may, however, mean that customers would realise the goods were secondhand, in which case there is no passing off: *General Electric Co Ltd v Pryce's Stores* (1933) 50 RPC 232.

6 *Britains Ltd v M Morris & Co (London) Ltd* [1961] RPC 217. This extends to excess or unauthorised goods manufactured by a contractor which the trade mark owner has not adopted as his own: *Primark Stores Ltd v Lollypop Clothing Ltd* [2001] FSR 637, [2000] All ER (D) 2099.

7 *Wilts United Dairies Ltd v Thomas Robinson Sons & Co Ltd* [1958] RPC 94, CA.

8 See *Harris v Warren and Phillips* (1918) 35 RPC 217; *Paquin Ltd v John Barker & Co Ltd* (1934) 51 RPC 431 (where such a misrepresentation was held to be not made out on the facts).

9 *Westinghouse Brake and Saxby Signal Co Ltd v Varsity Eliminator Co Ltd* (1935) 52 RPC 295; *Rolls-Royce Motors Ltd v Zanelli* [1979] RPC 148 (revsd [1979] RPC 152, CA).

10 *Morris Motors Ltd v Lilley (t/a G and L Motors)* [1959] 3 All ER 737, [1959] 1 WLR 1184; *Sony KK v Saray Electronics (London) Ltd* [1983] FSR 302, CA.

11 See PARA 319 post.

12 *Joseph Rodgers & Sons Ltd v WN Rodgers & Co* (1924) 41 RPC 277 at 291; *Law Society of England and Wales v Griffiths* [1995] RPC 16.

13 *Walter v Ashton* [1902] 2 Ch 282; *Lloyd's v Lloyd's (Southampton) Ltd* (1912) 29 RPC 433, CA; *Ewing v Buttercup Margarine Co Ltd* [1917] 2 Ch 1, 34 RPC 232, CA; *FW Woolworth & Co Ltd v Woolworths (Australasia) Ltd* (1930) 47 RPC 337 (subsidiary); *Kimberley-Clark v Fort Sterling Ltd* [1997] FSR 877; *Dawnay Day & Co Ltd v Cantor Fitzgerald International* [2000] RPC 669 at 701, CA (member of corporate group).

14 *Wheeler and Wilson Manufacturing Co v Shakespear* (1869) 39 LJ Ch 36.

15 *Society of Accountants and Auditors v Goodway and London Association of Accountants Ltd* [1907] 1 Ch 489.

16 *Morris Motors Ltd v Lilley (t/a G and L Motors)* [1959] 3 All ER 737, [1959] 1 WLR 1184; *Sony KK v Saray Electronics (London) Ltd* [1983] FSR 302, CA.

17 *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, CA; cf *Tavener Rutledge Ltd v Trexapalm Ltd* [1977] RPC 275 at 280 per Walton J.

18 *Irvine v TalkSport Ltd* [2003] EWCA Civ 423, [2003] 2 All ER 881. As to merchandising of names etc see PARA 340 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/318. Claimant's identity need not be known.

**318. Claimant's identity need not be known.**

There is no necessity in an action for passing off that the persons deceived should be aware of the claimant's identity, so long as they are accustomed to the claimant's goods or services and are induced by the defendant's misrepresentation to believe that the defendant's goods or services come from the accustomed source<sup>1</sup>.

<sup>1</sup> *Birmingham Vinegar Brewery Co Ltd v Powell* [1897] AC 710, 14 RPC 720, HL; *William Edge & Sons Ltd v William Niccolls & Sons Ltd* [1911] AC 693 at 705, 28 RPC 582 at 593-594, HL; *T Oertli AG v EJ Bowman (London) Ltd* [1957] RPC 388 at 397, CA, per Jenkins LJ (affd [1959] RPC 1, HL); *F Hoffmann-La Roche & Co AG v DDSA Pharmaceuticals Ltd* [1972] RPC 1, CA (coloured drug capsules); *United Biscuits (UK) Ltd v Asda Stores Ltd* [1997] RPC 513 at 533 per Robert Walker J. See also *Copydex Ltd v Noso Products Ltd* (1952) 69 RPC 38 (where a rival glue was advertised 'as shown on television', referring to a programme in which the plaintiff's product had been used but the plaintiff's name not mentioned). See also 'reverse' passing off; and PARA 320 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/319. Misuse of descriptive terms.

### **319. Misuse of descriptive terms.**

It was long considered essential in an action for passing off that the misrepresentation should relate specifically to the claimant<sup>1</sup>, in the sense of representing that the goods or business concerned were his goods or business, or at least in some way connected with or guaranteed by him<sup>2</sup>, as opposed to being a misrepresentation about the nature or quality of the defendant's goods or services which did not imply that the claimant was in any way responsible for them or for the defendant<sup>3</sup>. Thus no action lay where the defendant falsely asserted that his goods were as good as or better than those of the claimant<sup>4</sup>, or misapplied a descriptive term to his own goods which was genuinely descriptive of the claimant's goods<sup>5</sup>.

It has, however, been decided by the House of Lords<sup>6</sup> that a defendant who falsely applies to his goods a descriptive appellation to which they are not entitled is liable to an action for passing off at the suit of persons whose business or goodwill will be damaged by the misuse of the descriptive appellation concerned<sup>7</sup>. In such cases the claimant must show that the appellation has a sufficiently definite meaning<sup>8</sup>, which denotes a particular group of products, and that those products have a discrete reputation as a group<sup>9</sup>, such that the appellation has a significance greater than its literal, descriptive<sup>10</sup> meaning<sup>11</sup>. Thus it remains the law that a representation which does not relate to the claimant's goods or services, even in this extended sense of relating to them as part of such a group with a discrete reputation, cannot found an action in passing off<sup>12</sup>.

In the classic form of passing off action, the only person entitled to bring the action is the person to whom the name, mark or other indicium misused by the defendant refers, so that other persons legitimately trading in goods bearing that name or mark, such as exclusive importers or distributors, cannot maintain an action for passing off even though the defendant's activities cause damage to their trade<sup>13</sup>. Where, however, there is passing off of a product which has a character intrinsic to and inseparable from its descriptive name, for example 'advocaat'<sup>14</sup>, such a limitation seems inappropriate in view of the non-proprietary nature of the name or mark misused, and it appears that any person manufacturing or dealing in the genuine product whose business or goodwill will suffer more than minimal damage as a result of the defendant's activities may maintain an action<sup>15</sup>. Indeed, the decision of the House of Lords in the 'advocaat' case<sup>16</sup> may open the way for persons other than the proprietor of the goodwill attached to a mark or name to sue in respect of a misuse of the mark or name which is damaging to them<sup>17</sup>.

1 This was required whether or not his actual identity was known: see PARA 318 ante.

2 As to the nature of the misrepresentation see PARA 317 ante.

3 *Native Guano Co Ltd v Sewage Manure Co* (1889) 8 RPC 125, HL. What mattered was that goods were accepted on the faith of the plaintiff's reputation: see *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79 at 117, CA, per Goff LJ. Cases such as *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273, HL (passing off one quality of the plaintiff's own goods as another) and *Wilts United Dairies Ltd v Thomas Robinson Sons & Co Ltd* [1958] RPC 94, CA (passing off old goods of the plaintiffs as fresh) did not represent a departure from this general principle, since, in effect, the defendant was attributing to or placing in the mouth of the plaintiff a statement, express or implied, as to the origin, class or quality of goods.

4 *White v Mellin* [1895] AC 154, HL; *Hubbuck & Sons Ltd v Wilkinson, Heywod and Clark Ltd* [1899] 1 QB 86, CA; cf *Masson Seeley & Co Ltd v Embosotype Manufacturing Co* (1924) 41 RPC 160. See also *Irving's Yeast-Vite*

*Ltd v Horsenail* (1934) 51 RPC 110, HL. An action for trade libel may, however, lie where the defendant falsely and maliciously disparages the claimant's goods in a way likely to result in pecuniary damage: see LIBEL AND SLANDER vol 28 (Reissue) PARA 277 et seq.

5 *Canham v Jones* (1813) 2 Ves & B 218; *Native Guano Co Ltd v Sewage Manure Co* (1889) 8 RPC 125, HL.

6 lie in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL.

7 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL (approving *Bollinger v Costa Brava Wine Co Ltd* [1960] Ch 262, [1959] 3 All ER 800, [1960] RPC 16 (champagne); *Vine Products Ltd v Mackenzie & Co Ltd* [1969] RPC 1 (sherry); *John Walker & Sons Ltd v Henry Ost & Co Ltd* [1970] 2 All ER 106, [1970] 1 WLR 917, [1970] RPC 489 (whisky)). See also *Scotch Whisky Association v JD Vintners Ltd* [1997] Eu LR 446 (Scotch whisky); *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] RPC 826, CA (Swiss chocolate); *Matthew Gloag & Son Ltd v Welsh Distillers Ltd* [1998] FSR 718, [1998] ETMR 504 (arguable application of 'Welsh Whisky' to Scotch whisky could be restrained as reverse passing off: see PARA 320 post). As to descriptive names see also PARA 336 post.

8 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 739, 754, [1979] 2 All ER 927 at 930, 942, [1980] RPC 31 at 91, 104, HL; *Consorzio del Prosciutto di Parma v Marks & Spencer plc* [1991] RPC 351 at 364, CA ('Parma ham') (where it was alleged that Parma ham pre-sliced and packaged would deteriorate to an extent that it could no longer be classed as genuine Parma ham; allegation struck out); *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] RPC 117 at 129 per Laddie J (affd [1999] RPC 826 at 832, CA, per Chadwick LJ). See also *Lang Bros Ltd v Goldwell Ltd* [1977] FSR 353, Ct of Sess (where the meaning implied by a Scottish-looking get-up of a drink consisting of Scotch whisky mixed with English ginger wine was insufficiently definite).

9 The necessary reputation involves some perceived quality; it does not matter if there are other goods outside the class which have identical characteristics or have the same or higher quality: *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] RPC 117 at 128 per Laddie J; affd [1999] RPC 826, CA.

10 Thus in the case of geographical appellations, if the description means no more than that the goods come from that place, there is no reputation to protect: see *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] RPC 117 at 129 per Laddie J (giving the example of English pencils or French ball-bearings); affd [1999] RPC 826, CA. The converse of this is that it would be passing off to use the appellation which, although true in its geographical sense, falsely suggested that the goods were of the class in question (eg it would be passing off to call wine 'champagne' even if from the Champagne region, if it was not made in accordance with the traditional recipe).

11 *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] RPC 117 at 129 per Laddie J; affd [1999] RPC 826 at 832, CA, per Chadwick LJ. See also *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 742, [1979] 2 All ER 927 at 933, [1980] RPC 31 at 93, HL, per Lord Diplock (for reasons of policy the action for passing off is not necessarily available in all types of misrepresentation in the course of trade which may cause damage to the business or goodwill of rival traders).

The status of cases such as *Combe International Ltd v Scholl (UK) Ltd* [1980] RPC 1 (where it was held arguable that a misrepresentation that the defendant's goods were the same as the claimant's could give the claimant a cause of action) is now unclear. See also note 12 infra.

12 *Schulke & Mayr (UK) Ltd v Alkapharm (UK) Ltd* [1999] FSR 161 (no cause of action based on misrepresentation that the defendant's goods have some quality that they do not in fact possess). It follows that previous decisions that false claims to medals, testimonials or praise in fact belonging to the claimant did not give rise to an action for passing off, unless the claims led to the defendant's goods or business being taken as the claimant's, may remain good law: see *Batty v Hill* (1863) 1 Hem & M 264 (claim to Prize Medal from 1862 Exhibition); *National Starch Manufacturing Co v Munn's Patent Maizena and Starch Co* [1894] AC 275, 11 RPC 281, PC; *Tallerman v Dowsing Radiant Heat Co* [1900] 1 Ch 1, CA (where a commendation in a medical journal of the plaintiff's system of treatment was falsely applied to the defendant's); *Adolph Frankau & Co Ltd v Pflueger* (1910) 28 RPC 130; *Accumulator Industries Ltd v CA Vandervell & Co* (1912) 29 RPC 391; *Cambridge University Press v University Tutorial Press* (1928) 45 RPC 335 (where a false representation that the defendant's book was prescribed for university examinations was not actionable as passing off). See, however, *SDS Biotech UK Ltd v Power Agrichemicals Ltd* (1989) [1995] FSR 797; *Hodge Clemco Ltd v Airblast Ltd* [1995] FSR 806 (both holding it arguable that a misrepresentation that the defendant had the approval of a regulatory body could found an action for passing off).

13 *Richards v Butcher* (1890) 7 RPC 288 (importers of Heidsieck champagne not entitled to maintain an action); *Dental Manufacturing Co Ltd v C De Trey & Co* [1912] 3 KB 76, 29 RPC 617, CA.

14 lie the type of passing off exemplified by the facts of *Erven Warnink BV v Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL.

15 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 748, [1979] 2 All ER 927 at 937, [1980] RPC 31 at 98, HL, per Lord Diplock.

16 *le Erven Warnink BV v Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL.

17 There appears to be little difference in principle between a class of traders who deal in goods originating from a particular manufacturer and bearing his trade mark, whose business and goodwill may suffer from a third person falsely applying the mark to goods not originating from that manufacturer, and a class of traders dealing in goods under a name which describes their geographical origin or qualities. As to the bringing of actions by trade associations see PARA 310 note 5 ante; and as to descriptive and geographical names see PARA 336 post.

## **UPDATE**

### **319 Misuse of descriptive terms**

NOTE 7--See *Diageo North America Inc v Intercontinental Brands (ICB) Ltd* [2010] EWHC 17 (Ch), [2010] All ER (D) 133 (Jan) (vodka).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/320. 'Reverse' passing off.

### 320. 'Reverse' passing off.

So-called 'reverse' passing off occurs when a defendant passes off the claimant's goods or services as his own<sup>1</sup>. Such a misrepresentation normally requires more than the mere application of the defendant's trade marks to the claimant's goods, since dealers in the ordinary course of trade apply their marks to goods made by others and merely doing so does not of itself imply that those goods are manufactured by the dealer. Where such a misrepresentation is made, it may be doubtful whether it falls within the scope of the action for passing off, and, if so, it is actionable, if at all, only as a malicious falsehood<sup>2</sup>. A case which at first sight appears to be reverse passing off may, however, in fact be a subtle form of ordinary passing off. This can occur when the defendant represents that goods made by the claimant were made by himself in order to pass off his business as a dealer as a branch of a well known business which manufactures the parts in which he deals<sup>3</sup>. Alternatively, the defendant may represent that some of the claimant's goods are made by himself in order to gain credit for other goods made by himself<sup>4</sup>, in effect passing off his own goods as coming from the same manufacturing source as the claimant's goods, even though the claimant's connection with those goods is not known<sup>5</sup>. In such a case the defendant's own activities in showing to his customers the claimant's goods (or photographs of them) may create for the claimant a goodwill which he is entitled to protect as the true, although unidentified, manufacturer of the goods<sup>6</sup>.

1 See *Henderson & Son v Munro & Co* (1905) 7 F 636, Ct of Sess (where the issue of a trade circular likely to induce the belief that work in fact done by the plaintiff was done by the defendant was restrained). Reverse passing off may also be committed when the defendant applies a false, descriptive appellation to goods which ought to bear the appellation which the claimant is entitled to protect under the principles laid down in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL (see PARA 319 ante): see *Matthew Gloag & Son Ltd v Welsh Distillers Ltd* [1998] FSR 718, [1998] ETMR 504 (arguable that Scotch whisky could be passed off as 'Welsh whisky').

2 See LIBEL AND SLANDER vol 28 (Reissue) PARA 274 et seq.

3 *AGS Manufacturing Co Ltd v Aeroplane General Sundries Co Ltd* (1918) 35 RPC 127, CA (where the defendants advertised that the letters AGS by which the plaintiff's parts were known stood for their own name).

4 Eg by using the claimant's goods as a sample to sell his own goods.

5 See *William Edge & Sons Ltd v William Nicolls & Sons Ltd* [1911] AC 693 at 705, 709, 28 RPC 582 at 594, 596, HL (where the defendants applied a label bearing their name to goods identical in get-up to the plaintiff's goods which were sold with no name on them, causing the public to believe that the defendants were the manufacturers of the goods which had long been on the market and that they had only now disclosed their name). See also *Copydex Ltd v Noso Products Ltd* (1952) 69 RPC 38 (where a rival glue was advertised 'as shown on television', referring to a programme in which the plaintiff's product had been used but the plaintiff's name not mentioned). It is generally not necessary that the identity of the claimant is known in order for him to sustain an action for passing off: see PARA 318 ante.

6 *British Conservatories Ltd v Conservatories Custom Built Ltd* [1989] RPC 455, CA (where the defendant showed to customers photographs of the conservatories in fact built by the claimant, claiming that they were samples of work done by the defendant). For a similar case see *Plomien Fuel Economiser Co Ltd v National School of Salesmanship Ltd* (1943) 60 RPC 209 at 213, CA.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/321. Manner in which the misrepresentation may be effected.

### **321. Manner in which the misrepresentation may be effected.**

The misrepresentation in an action for passing off may be effected by an express statement<sup>1</sup>, but more commonly it is implied in the defendant's use of a mark, trade name or get-up with which the goods or business of another are associated in the minds of the relevant class of the trade or public<sup>2</sup>. Misrepresentation by the use of similar get-up has a wide ambit, extending sometimes to the shape of goods themselves<sup>3</sup> or to the use of similar decorations for premises<sup>4</sup>, similar livery for vehicles and employees<sup>5</sup>, similar advertising slogans or themes<sup>6</sup>, similar telephone numbers<sup>7</sup> or sound effects<sup>8</sup>.

Other ways in which the misrepresentation may be effected are by substituting other goods in response to an order for the claimant's goods in circumstances when it is not obvious to the customer receiving the goods that substitution has taken place<sup>9</sup>, or by physically annexing or associating the defendant's goods to or with the claimant's goods<sup>10</sup>, or by substituting a service or process employing other materials or machinery in response to a demand for the claimant's service or process<sup>11</sup>, or by an agent who has been selling his principal's goods or services introducing new lines of goods or services of his own in such a way as to represent that they are from the same source<sup>12</sup>.

Implied misrepresentations may in some circumstances arise simply by customers assuming, in the absence of any indication to the contrary, that goods have passed through the normal channels of trade<sup>13</sup>, or that goods are new, unadulterated or unaltered<sup>14</sup>.

Where a trader who has made no misrepresentation to his intended customer realises from something the customer said or did that the customer is under a self-induced misapprehension that the trader is, or is connected with, a competitor, failure to correct that misapprehension amounts to misrepresentation<sup>15</sup>.

It is important to note that the misrepresentation in an action for passing off may be, and often is, effected indirectly, where the defendant places into the hands of others goods or articles calculated to deceive ultimate purchasers of those goods, even where no misrepresentation is made to the persons with whom the defendant immediately deals<sup>16</sup>.

1 Eg a statement that goods are made by a named claimant.

2 *Birmingham Vinegar Brewery Co Ltd v Powell* [1897] AC 710 at 711-712, 14 RPC 720 at 727-728, HL, per Lord Halsbury LC; *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 284, HL, per Lord Parker. Members of the relevant trade or public who are familiar with the claimant's use of a name, mark or get-up will infer from the defendant's use of a name, mark or get-up which is the same or similar that the goods or business concerned are the same or connected, and in this sense the representation is implied rather than express. Since this kind of misrepresentation arises by association with the claimant's mark or other indicium, it is unnecessary that the persons deceived should know the actual identity of the claimant with whose use of the name, mark or get-up they have been familiar: see PARA 300 ante. However, it is necessary to establish that persons who are familiar with the claimant's mark will be deceived: *HFC Bank plc v Midland Bank plc* [2000] FSR 176. See also *Antec International Ltd v South Western Chicks (Warren) Ltd* [1998] FSR 738.

3 As to passing off by similarity of get-up or shape of goods see PARA 338 post.

4 See *Laraine Day Ltd v Kennedy* (1952) 70 RPC 19.

5 *Knott v Morgan* (1836) 2 Keen 213 (imitation of the green livery and gold hatbands of the plaintiff's omnibus coachmen and conductors restrained); *W and G Du Cros Ltd v Gold* (1912) 30 RPC 117 (get-up of taxis).

6 *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] 1 All ER 213, [1981] 1 WLR 193, [1981] RPC 429, PC.

7 *Law Society of England and Wales v Griffiths* [1995] RPC 16.

8 *BBC v TalkSport Ltd* [2001] FSR 53 (claim that defendant broadcaster was misrepresenting itself as broadcasting 'live' from sports events by use of sound effects compromised on appeal by giving of undertakings).

9 *Bovril Ltd v Bodega Co Ltd* (1916) 33 RPC 153; *Pearson Bros v Valentine & Co* (1917) 34 RPC 267 (where the defendants supplied mackintoshes bearing their own label in response to orders for the plaintiff's mackintoshes and it was held that it was not sufficient to leave it to the customer to examine the goods with care); *Thomas French & Sons Ltd v John Rhind & Sons Ltd* [1958] RPC 82; *Showerings Ltd v Blackpool Tower Co Ltd* [1975] FSR 40 (substitute drinks served in bar); *Havana Cigar and Tobacco Factories Ltd v Oddenino* [1924] 1 Ch 179, 41 RPC 47, CA (where it was held that as 'Corona cigar' had an ambiguous meaning, the defendant was under a duty to inquire whether a purchaser wanted the plaintiffs' cigar or a cigar of corona type). See also *Showerings Ltd v Entam Ltd* [1975] FSR 45. Where it is immediately obvious to the customer on receipt of a product that a substitution has occurred, it seems that there is no passing off as the necessary element of misrepresentation is not present, whatever may be the contractual remedies as between customer and supplier: *Lever Bros Ltd v Masbro' Equitable Pioneers Society Ltd* (1912) 29 RPC 225 at 232-233, CA, per Fletcher Moulton LJ; cf *Purefoy Engineering Co Ltd v Sykes Boxall & Co Ltd* (1955) 72 RPC 89 at 93, CA (where it appears to be suggested that it would have made no difference if catalogues accompanying parts supplied in response to orders for the plaintiff's part numbers had made it clear that the parts were not the plaintiffs' because the damage to the plaintiffs would by then have been done). It is, however, hard to see what, if any, misrepresentation is involved and therefore what the cause of action is, even if the claimants suffer damage.

10 *Illustrated Newspapers Ltd v Publicity Services (London) Ltd* [1938] Ch 414, [1938] 1 All ER 321, 55 RPC 172; *Mail Newspapers plc v Insert Media Ltd* [1987] RPC 521 (both cases where the defendant's advertising supplement was inserted into the plaintiff's magazines); *Morny Ltd v Ball and Rogers (1975) Ltd* [1978] FSR 91 (where other goods were included in a gift package with the plaintiff's goods).

11 *Sales Affiliates Ltd v Le Jean Ltd* [1947] Ch 295, [1947] 1 All ER 287, 64 RPC 103 (hair-waving process).

12 *International Scientific Communications Inc v Pattison* [1979] FSR 429.

13 *Sony KK v Saray Electronics (London) Ltd* [1983] FSR 302, CA. See also *Seiko Time Canada Ltd v Consumers Distributing Co Ltd* (1980) 112 DLR (3d) 500. The sale of the goods of a particular manufacturer does not, however, of itself normally carry with it a representation that the goods have passed through a particular trade channel, such as a sole distributor: *Dental Manufacturing Co Ltd v C De Trey & Co* [1912] 3 KB 76 at 87, 29 RPC 617 at 625, CA, per Fletcher Moulton LJ.

14 See the cases cited in the notes to para 317 ante.

15 *British Sky Broadcasting Group plc v Sky Home Services Ltd* [2006] EWHC 3165 (Ch), [2007] FSR 321.

16 See PARA 331 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/322. Misrepresentation must be material.

### **322. Misrepresentation must be material.**

The misrepresentation must be material, in the sense of being likely to influence the actions of the persons to whom it is made<sup>1</sup>. A misrepresentation as to the origin of goods is generally sufficient even though the defendant's goods are not in fact inferior to the claimant's<sup>2</sup>. A mere representation that the claimant sponsors or financially supports the defendant, without any belief by the public that it can rely on quality control exercised by the claimant, is not material<sup>3</sup>. On the other hand, a misrepresentation that a celebrity has endorsed the defendant's goods or services is actionable<sup>4</sup>.

1 *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873 at 889, [1990] 1 WLR 491 at 510, [1990] RPC 341 at 417, HL, per Lord Jauncey of Tullichettle ('Jif Lemon'); *Hodgkinson and Corby Ltd v Wards Mobility Services Ltd* [1994] 1 WLR 1564, [1995] FSR 169. Any confusion must be more than momentary and inconsequential: *Clark v Associated Newspapers Ltd* [1998] 1 All ER 959 at 966, [1998] RPC 261 at 271 per Lightman J; *HFC Bank plc v Midland Bank plc* [2000] FSR 176. As to the nature of the misrepresentation see PARA 317 ante; and as to the persons to whom it is made see PARA 325 post.

2 *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15 at 29-30, HL, per Lord Blackburn. This has been justified on the basis that the customer is likely to rely upon the assurance of quality given to him by the claimant's connection with the goods.

3 *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, CA; and see also *Tavener Rutledge Ltd v Trexapalm Ltd* [1977] RPC 275 at 280 per Walton J.

4 *Irvine v TalkSport Ltd* [2002] EWHC 367 (Ch), [2002] 2 All ER 414, [2002] EMLR 679; affd [2003] EWCA Civ 423, [2003] 2 All ER 881. As to merchandising of names generally see PARA 340 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/323. Misrepresentation is an essential element.

### **323. Misrepresentation is an essential element.**

The existence of a misrepresentation is an essential element of the action for passing off, so that activities which in some sense can be regarded as taking advantage of the claimant's trading reputation and goodwill, such as copying the claimant's goods of a novel character<sup>1</sup> or copying his novel system of advertising<sup>2</sup>, or selling goods or services by reference to him or his goods or services by saying that they are similar or a substitute for them<sup>3</sup>, or an accessory to be used in conjunction with them<sup>4</sup>, are not actionable in English law in the absence of a misrepresentation, even if such conduct might in other jurisdictions be actionable as unfair competition<sup>5</sup>.

Representations to the effect that the defendant's goods or services are equivalent to or a substitute for the claimant's are often made, not expressly, but by the adoption of a similar get-up<sup>6</sup> or similar advertising methods or slogans<sup>7</sup>, and this is not actionable so long as the goods are sufficiently distinguished by other means.

The use of a similar name or get-up in order to satirise or disparage the claimant or his goods or business is not actionable as passing off<sup>8</sup> in the absence of a misrepresentation that the defendant's goods or business are those of the claimant even if such conduct is likely to be damaging or hurtful to the claimant<sup>9</sup>.

1 *Hodgkinson and Corby Ltd v Wards Mobility Services Ltd* [1994] 1 WLR 1564, [1995] FSR 169 (there is no tort of copying, nor of taking a rival's market or customers, neither being susceptible of ownership).

2 *Wertheimer v Stewart, Cooper & Co* (1906) 23 RPC 481.

3 *Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at 540-541; *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15, HL ('Singer system' sewing machines); *Apollinaris Co Ltd v Duckworth & Co* (1906) 23 RPC 540, CA (salts for making up simulated mineral waters).

4 *GH Gledhill & Sons Ltd v British Perforated Toilet Paper Co* (1911) 28 RPC 429; on appeal 28 RPC 714, CA.

5 See *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] 1 All ER 213, [1981] 1 WLR 193, [1981] RPC 429, PC; but cf *Arsenal Football Club plc v Reed* [2003] EWCA Civ 696 at [70]-[71], [2003] 3 All ER 865 at [70]-[71] per Aldous LJ (obiter).

6 See *Fisons Ltd v EJ Godwin (Peat Industries) Ltd* [1976] RPC 653; *Tetrosyl Ltd v Silver Paint & Lacquer Co Ltd* [1980] FSR 68, CA.

7 *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] 1 All ER 213, [1981] 1 WLR 193, [1981] RPC 429, PC.

8 In some circumstances this may be actionable as a trade libel, or, if defamatory, as libel or slander: see LIBEL AND SLANDER vol 28 (Reissue) PARAS 55, 277 et seq.

9 *Miss World (Jersey) Ltd v James Street Productions Ltd* [1981] FSR 309, CA ('Miss Alternative World' ugliness competition); cf *New Zealand Olympic and Commonwealth Games Association Inc v Telecom New Zealand Ltd* [1996] FSR 757, NZ HC (defendant's advertisement contained a play on the Olympic symbol). As to the protection of the Olympic symbol in the United Kingdom see PARA 492 et seq ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/324. Confusion without any misrepresentation.

### **324. Confusion without any misrepresentation.**

An actionable misrepresentation normally entails confusion or the likelihood of confusion on the part of a relevant section of the trade or public<sup>1</sup>. The existence of such confusion arising from the defendant's activities does not, however, necessarily mean that there is an actionable misrepresentation<sup>2</sup>. For example, when a new retail shop is set up close to an existing shop in the same line of business, some confusion is likely to be caused by that very fact, but confusion arising from that cause alone is to be disregarded for the purpose of determining whether there is a misrepresentation<sup>3</sup>. Similarly, where the public is familiar with the claimant's goods or services of a particular kind, substantial numbers of persons may assume that competing goods or services offered by a newcomer are the goods or services of the claimant with whom they have hitherto been familiar, but confusion arising merely from this cause is to be disregarded<sup>4</sup>. Cases of this kind often arise when the claimant has been the first to introduce to the market goods or services of a novel character<sup>5</sup>. In such circumstances the claimant may have used and adopted words descriptive of his goods or services which, while he is the sole manufacturer or supplier, must necessarily denote these goods or services, but this of itself does not make the defendant's use of the words in a descriptive manner a misrepresentation even if a degree of confusion results<sup>6</sup>. It may be necessary to distinguish confusion which arises because the defendant adopts utilitarian features of the claimant's goods or services, as opposed to features which are a capricious addition to the article concerned<sup>7</sup>, although there is no absolute rule that a claimant cannot rely on confusion arising from the adoption of utilitarian features if he can discharge the heavy factual burden of showing that the public regards those features as an indication of trade origin and is moved to purchase the defendant's goods because of the erroneous belief engendered by the defendant's adoption of those features<sup>8</sup>. Confusion can also arise, without there being a misrepresentation, where a defendant has a special right to use a name either by reason of its being his own name<sup>9</sup> or by reason of established concurrent use<sup>10</sup>. In cases of this kind the courts have proceeded on the basis that the defendant is doing no more than making a truthful statement of fact which he has a legitimate interest in making<sup>11</sup>, and the fact that it is misapprehended by some persons is not the defendant's responsibility unless he does something additional to increase the risk of confusion<sup>12</sup>; but these cases have been explained on the basis that there is a misrepresentation but the defendant has a special privilege to make it<sup>13</sup>.

1 As to the elements of the action for passing off see PARA 304 ante.

2 See *My Kinda Town Ltd v Soll* [1983] RPC 407 at 418, CA, per Oliver LJ; *Barnsley Brewery Co Ltd v RBNB* [1997] FSR 462 at 467 per Robert Walker J; *HFC Bank plc v Midland Bank plc* [2000] FSR 176 at 182-183, 201 per Lloyd J; *Premier Luggage & Bags Ltd v Premier Company (UK) Ltd* [2002] EWCA Civ 387 at [37], [2003] FSR 69 at [37] per Chadwick LJ. The distinction between confusion and deception is elusive: *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159 at [91], [111], [2004] RPC 767 at [91], [111], [2004] IP & T 1049 at [91], [111] per Jacob LJ. The difference is that deception is really likely to damage the claimant's goodwill: *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at [19], [2007] RPC 83 at [19] per Jacob LJ.

3 *Laraine Day Ltd v Kennedy* (1952) 70 RPC 19 at 22.

4 *Jones Bros Ltd v Anglo-American Optical Co* (1912) 24 RPC 361 at 369, CA (where Fletcher Moulton LJ said that to establish a misrepresentation it must be shown that some aspect of the name, style, get-up etc adopted by the defendant, over and above the mere similarity of the goods, is likely to influence purchasers). See, however, *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL ('Jif Lemon') (where it was considered that the fact that the plaintiff had enjoyed a de facto monopoly for

many years in small lemon-shaped containers for lemon juice imposed a greater duty on newcomers to that market to take steps to distinguish their goods from those of the plaintiff); *British Sky Broadcasting Group plc v Sky Home Services Ltd* [2006] EWHC 3165 (Ch), [2007] FSR 321 (which held that where a de facto monopoly existed the competitor was not subjected to a free-standing duty to distinguish his product from any connection with the monopoly, but he was obliged to take such care as would prevent his chosen marketing method from conveying a misrepresentation to the effect that there was such a connection). As to passing off by similarity of get-up or of the articles themselves see PARA 338 post.

5 See *Compatibility Research Ltd v Computer Psyche Co Ltd* [1967] RPC 201 at 206 (a case which concerned a computer dating bureau, where Stamp J said that a trader who sets up a new trade has no monopoly of that trade or of the manner of carrying it on, and he cannot stop a rival trader copying his ideas, notwithstanding that confusion will be caused); *My Kinda Town Ltd v Soll* [1983] RPC 407, CA.

6 See *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326, HL; *British Vacuum Cleaner Co Ltd v New Vacuum Cleaner Co Ltd* [1907] 2 Ch 312, 24 RPC 641; *My Kinda Town Ltd v Soll* [1983] RPC 407 at 420, CA, per Oliver LJ. As to special considerations applying where what is complained of is the use of descriptive words, or words which a claimant has invented as a name for a new product or service, see PARA 337 post.

7 *JB Williams Co v H Bronnley & Co Ltd* (1909) 26 RPC 765 at 773, CA, per Fletcher Moulton LJ. Such an addition is much more likely to be taken and relied upon as a badge of trade origin than is a utilitarian feature.

8 *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL ('Jif Lemon'); *Hodgkinson and Corby Ltd v Wards Mobility Services Ltd* [1994] 1 WLR 1564, [1995] FSR 169.

9 *Turton v Turton* (1889) 42 ChD 128, CA. As to the right of a person to make use of his own name see PARA 344 post.

10 *Habib Bank Ltd v Habib Bank AG Zurich* [1981] 2 All ER 650, [1981] 1 WLR 1265, [1982] RPC 1, CA. As to concurrent use see PARA 346 post.

11 Eg that a man named John Turton is carrying on business with his two sons as partners: see *Turton v Turton* (1889) 42 ChD 128 at 135 per Lord Esher MR.

12 *Marengo v Daily Sketch and Daily Graphic Ltd* (1946) [1992] FSR 1 at 2, CA, per Lord Greene MR ('No one is entitled to be protected against confusion as such. Confusion may result from one collision of two independent rights or liberties, and where this is the case, neither party can complain; they must put up with the results of the confusion as one of the misfortunes which occur in life'); revsd on the facts sub nom *Marengo v Daily Sketch and Sunday Graphic Ltd* [1948] 1 All ER 406, 65 RPC 242, HL. However, once a substantial number of people are misled there is passing off: *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159 at [111], [2004] RPC 767 at [111], [2004] IP & T 1049 at [111] per Jacob LJ.

13 See *Joseph Rodgers & Sons Ltd v WN Rodgers & Co* (1924) 41 RPC 277 at 291 per Romer J. Cf *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at [21], [2007] RPC 83 at [21] per Jacob LJ (referring to cases of honest concurrent use and very descriptive marks as not being cases of mere confusion but rather 'cases of tolerated deception or a tolerated level of deception').

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/325. Persons to whom the misrepresentation is made.

### **325. Persons to whom the misrepresentation is made.**

Normally the misrepresentation in an action for passing off is made to customers of the claimant or to ultimate consumers of goods or services supplied by him<sup>1</sup>. The misrepresentation may, however, be made to other persons, such as other members of the trade or the claimant's suppliers<sup>2</sup>. For example, the defendant's financial failure or bad behaviour as a customer might cause damage to the claimant's credit and reputation among his suppliers if the defendant were thought to be associated with him<sup>3</sup>.

1 As to the elements of the action for passing off see PARA 304 ante.

2 *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* [1987] RPC 189 at 206, CA (expressly rejecting the argument that the reference to customers in the formulation (now superseded) of the requirements of passing off in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL (see PARA 304 ante) should be read literally as excluding from the ambit of the action cases of misrepresentations to suppliers). See also *R and J Pullman Ltd v Pullman* (1919) 36 RPC 240; *FW Woolworth & Co Ltd v Woolworths (Australasia) Ltd* (1930) 47 RPC 337; *Brestian v Try* [1958] RPC 161, CA.

3 See *JC Penney Co Inc v Penneys Ltd* [1979] FSR 29 (Hong Kong), in which it appears that *R and J Pullman Ltd v Pullman* (1919) 36 RPC 240 and *FW Woolworth & Co Ltd v Woolworths (Australasia) Ltd* (1930) 47 RPC 337 were not cited. There seems to be no reason in principle why misrepresentations to bankers, investors etc which have the effect of damaging the claimant's trading reputation and credit amongst them should not equally be actionable.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/326. Establishing misrepresentation.

### **326. Establishing misrepresentation.**

To establish a likelihood of deception in an action for passing off where there has been no misrepresentation<sup>1</sup> generally requires the presence of two factual elements:

- 436 (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation<sup>2</sup> among a relevant class of persons; and
- 437 (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source<sup>3</sup> or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other<sup>4</sup>.

The question whether deception is likely is one for the court<sup>5</sup>, which will have regard to:

- 438 (a) the nature and extent of the reputation relied upon<sup>6</sup>;
- 439 (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business<sup>7</sup>;
- 440 (c) the similarity of the mark, name etc used by the defendant to that of the claimant<sup>8</sup>;
- 441 (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors<sup>9</sup>; and
- 442 (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances<sup>10</sup>.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action<sup>11</sup>.

The evidence which is admissible on the question of likelihood of deception, and the way in which the court assesses it, including the significance to be attached to the presence or absence of actual instances of deception, are discussed elsewhere in this title in relation to both passing off and infringement of trade marks<sup>12</sup>.

1 Eg an express statement that the defendant's goods or services are goods or services of the claimant: see PARA 321 ante. As to misrepresentation as an essential element of the action see PARA 323 ante.

2 See *Tavener Rutledge Ltd v Specters Ltd* [1959] RPC 355 at 362, CA, per Lord Evershed MR, and at 364 per Harman LJ.

3 This will be the inference drawn in the classic case of a defendant passing off his goods or business as the claimant's; the nature of the inference drawn will vary depending upon which of the many different forms of passing off is occurring: see PARA 317 ante.

4 *Magnolia Metal Co v Tandem Smelting Syndicate Ltd* (1900) 17 RPC 477 at 486, HL, per Lord Halsbury.

5 See PARA 431 post.



6 See PARA 327 post.

7 See PARA 328 post.

8 The factors to be taken into account in assessing whether or not names, marks etc are deceptively similar for the purposes of passing off are similar to those to be taken into account in assessing the likelihood of confusion in registered trade mark actions (see PARA 74 ante): see *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159 at [78]-[79], [2004] RPC 767 at [78]-[79], [2004] IP & T 1049 at [78]-[79] per Jacob LJ. In particular, it is equally relevant in passing off cases to consider the visual, aural and conceptual similarities between the respective names or marks and the possibility of imperfect recollection. Care should, however, be taken when applying registered trade mark cases in actions for passing off, because in trade mark actions the question to be decided is the narrower and more artificial one of whether the defendant's mark is confusingly similar to the registered mark, and some factors are not relevant which are relevant in actions for passing off, eg factors which are collateral to the defendant's use of the mark complained of. Equally the principle developed by the European Court of Justice that trade marks with a highly distinctive character are entitled to broader protection does not apply to passing off, although there is some truth in the opposite proposition: *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159 at [83]-[86], [2004] RPC 767 at [83]-[86], [2004] IP & T 1049 at [83]-[86] per Jacob LJ.

9 Eg the similarity or dissimilarity of get-up or secondary indicia, such as label wordings or business addresses, or the use of express words of disclaimer sufficient to prevent deception which might otherwise arise.

10 See PARA 329 post.

11 See PARA 330 post.

12 See PARA 430 et seq post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/327. Reputation as an element of establishing deception.

### **327. Reputation as an element of establishing deception.**

Normally the reputation required to be established by the claimant in an action for passing off is that the name, mark or other indicium has by use come to be regarded as identifying goods or services from a particular source known or unknown<sup>1</sup>, or, where there is passing off of a product which has a character intrinsic to its descriptive name, as denoting goods or services of a particular composition, standard, quality or geographical origin<sup>2</sup>. The fact that only the claimant has in the past made use of the name, mark or other feature concerned is not conclusive that it has come to be regarded as distinctive<sup>3</sup>, but distinctiveness will readily be inferred when the name, mark or other feature is invented or fancy and has no direct relation to the character or quality of the goods<sup>4</sup>.

1 *T Oertli AG v EJ Bowman (London) Ltd* [1959] RPC 1 at 4, HL, per Viscount Simonds.

2 In this type of passing off the name or mark denotes not the goods or services of a particular person but goods or services of a particular standard or quality (eg advocaat or champagne): see PARA 319 ante.

3 *Payton & Co Ltd v Snelling, Lampard & Co Ltd* (1899) 17 RPC 48, CA (affd [1901] AC 308, 17 RPC 628, HL); *White, Tomkins and Courage Ltd v United Confectionery Co Ltd* (1914) 31 RPC 286.

4 *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326 at 339, 16 RPC 397 at 406-407, HL, per Lord Shand. Special considerations apply when a claimant seeks to prove that he has established a reputation in words which are recognised as descriptive of his goods or services: see PARA 336 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/328. Common field of activity and likelihood of deception.

### **328. Common field of activity and likelihood of deception.**

It is not a requirement for success in a passing off action that the claimant and the defendant be engaged in a common field of activity<sup>1</sup>. The presence or absence of a common field of activity in which the claimant and the defendant are engaged is a factor to be taken into account in considering whether it is likely that persons coming across the defendant's use of the name, mark etc complained of will assume<sup>2</sup> that he and the claimant are connected<sup>3</sup>. Such a factor may also be significant in deciding, even assuming that a misrepresentation is established, whether the claimant is likely to suffer any substantial damage as a result of the defendant's activities<sup>4</sup>.

Where the defendant's activities, although not in an area of business in which the claimant is engaged, are in an area of business which might be assumed to be a natural extension of the claimant's business, likelihood of deception will readily be inferred<sup>5</sup>. However, even where the fields of activity in which the claimant and the defendant are engaged are remote from each other, it is possible for deception to occur if the name or mark used is highly distinctive<sup>6</sup>, or if the claimant's mark or name is well known and is closely copied with regard to style, lettering etc<sup>7</sup>.

Deception may also occur where the defendant falsely represents that a celebrity has endorsed his goods or services even if the goods and services are remote from the celebrity's field of endeavour<sup>8</sup>.

1 *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 at 714, CA, per Millet LJ (disapproving *McCulloch v May* (1948) 65 RPC 58); *Irvine v TalkSport Ltd* [2002] EWHC 367 (Ch) at [24]-[29], [2002] 2 All ER 414 at [24]-[29], [2002] EMLR 679 at [24]-[29] per Laddie J (affd [2003] EWCA Civ 423, [2003] 2 All ER 881).

2 As to this implied misrepresentation see PARA 321 ante; and as to misrepresentation as an essential element of the action for passing off see PARA 323 ante.

3 *Annabel's (Berkeley Square) Ltd v Schock (t/a Annabel's Escort Agency)* [1972] RPC 838 at 844, CA, per Russell LJ; *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 at 714, CA, per Millet LJ.

4 As to a common field of activity and damage see PARA 334 post.

5 *Dunlop Pneumatic Tyre Co Ltd v Dunlop Lubricant Co* (1898) 16 RPC 12 at 15; *Ames Crosta Ltd v Pionex International Ltd* [1977] FSR 46; *NAD Electronics Inc v NAD Computer Systems Ltd* [1997] FSR 380.

6 *Lego System A/S v Lego M Lemelstrich Ltd* [1983] FSR 155 (garden sprinklers sold under the same name as well known toy bricks).

7 *Walter v Ashton* [1902] 2 Ch 282 (bicycle shop passed off as being a branch of 'The Times' newspaper).

8 *Irvine v TalkSport Ltd* [2002] EWHC 367 (Ch), [2002] 2 All ER 414, [2002] EMLR 679; affd [2003] EWCA Civ 423, [2003] 2 All ER 881.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/329. Factors and circumstances to be considered in assessing the likelihood of deception.

**329. Factors and circumstances to be considered in assessing the likelihood of deception.**

In deciding whether deception sufficient to sustain an action for passing off<sup>1</sup> has occurred or is likely, all the circumstances must be considered<sup>2</sup>. The degree of similarity of the name, mark or other feature concerned<sup>3</sup> is important but not necessarily decisive, so that an action for infringement of a registered trade mark may succeed on the same facts where an action for passing off fails<sup>4</sup> or vice versa<sup>5</sup>. The circumstances in which the defendant's name, mark or get-up is likely to come to the attention of persons who might be confused must be considered, so that in sales to retail customers it is relevant to take into account that the customer does not always have the opportunity of carefully examining the goods and may not be able to see the claimant's and defendant's goods side by side<sup>6</sup> and may in any case have an imperfect recollection of the claimant's goods or mark<sup>7</sup>. Trade customers may be less susceptible to deception than retail customers, so that the use of marks or names in advertisements or circulars, or in relation to goods or services, directed to the trade may create no danger of deception even though retail customers would be deceived if the marks or names were used in advertisements to them or attached to goods so as to come to their attention<sup>8</sup>. The fact that the persons who might be deceived are illiterate, badly educated or unable to understand the language or script in which distinguishing words or names are written is to be taken into account as potentially increasing the likelihood of deception<sup>9</sup>.

For a misrepresentation to be established, it is generally not essential to show that all members of the relevant class of persons will be deceived, but merely that a majority<sup>10</sup> or a substantial proportion<sup>11</sup> is likely to be. It is not sufficient, however, that only careless or indifferent persons<sup>12</sup>, or ignorant persons with little or no knowledge of the trade concerned<sup>13</sup>, are likely to be deceived, nor is it sufficient to show that persons will be deceived who have such an imperfect or insufficient recollection of the claimant's mark that they cannot fairly be said to fall within the class of persons amongst whom the claimant has goodwill<sup>14</sup>.

1 As to the requirement that the claimant must suffer damage see PARAS 333-335 post.

2 *Burberrys v JC Cording & Co Ltd* (1909) 26 RPC 693 at 701 per Parker J.

3 As to factors to be taken into account in assessing the similarity of marks, names etc see PARA 326 note 8 ante.

4 *Saville Perfumery Ltd v June Perfect Ltd and FW Woolworth & Co Ltd* (1941) 58 RPC 147 at 174, HL (decided under the Trade Marks Act 1938, but the position is likely to be the same under the Trade Marks Act 1994). This is because the question to be decided on infringement of registered trade marks is the rather narrower and more artificial question of whether the defendant's mark is confusingly similar to the registered mark. Some factors which are relevant in an action for passing off, eg that the defendant is using the mark in conjunction with other matter which makes confusion either more or less likely, are not relevant to infringement of registered trade marks. As to the infringement of registered trade marks see PARA 84 et seq ante.

5 *Re Joule's Trade Marks, Thompson v Montgomery* (1889) 41 ChD 35, 6 RPC 404, CA; affd [1891] AC 217, 8 RPC 361, HL. See eg *United Biscuits (UK) Ltd v Asda Stores Ltd* [1997] RPC 513 (where passing off was established, but trade mark infringement was not proved because the appropriate comparison was with the trade mark as registered, and not with the mark in actual use). See also the examples given in *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244 at [25], [2007] RPC 83 at [25] per Jacob LJ.

6 *Packham & Co Ltd v Sturgess & Co* (1898) 15 RPC 669 at 673, CA, per Chitty LJ.

7 *Seixo v Provezende* (1866) 1 Ch App 192; *Thomas Hubbuck & Son Ltd v William Brown Sons & Co* (1900) 17 RPC 638 at 645, CA; *Wright, Crossley & Co v Blezard* (1910) 27 RPC 299; *Ravenhead Brick Co Ltd v Ruabon Brick and Terra Cotta Co Ltd* (1937) 54 RPC 341 at 349 per Simonds J. It is possible to carry the doctrine of imperfect recollection too far: *Chappie Ltd v Spratt's Patent Ltd* (1954) 71 RPC 455.

8 *Ford v Foster* (1872) 7 Ch App 611 at 627 per James LJ; *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15 at 20, HL, per Lord Selborne LC; *Star Cycle Co Ltd v Frankenburgs* (1907) 24 RPC 405, CA; *Claudius Ash Son & Co Ltd v Invicta Manufacturing Co Ltd* (1912) 29 RPC 465, HL.

9 *R Johnston & Co v Archibald Orr Ewing & Co* (1882) 7 App Cas 219, HL; *Wilkinson v Griffith* (1891) 8 RPC 370; *Saville Perfumery Ltd v June Perfect Ltd and FW Woolworth & Co Ltd* (1941) 58 RPC 147 at 176, HL. See also *Topps Co Inc v Top Hannah Agencies Ltd* (2000) Times, 14 February, where the Court of Session suggested that where goods were sold to children the impression on a child had to be considered.

10 *Havana Cigar and Tobacco Factories Ltd v Oddenino* [1924] 1 Ch 179, 41 RPC 47, CA.

11 *Saville Perfumery Ltd v June Perfect Ltd and FW Woolworth & Co Ltd* (1941) 58 RPC 147 at 176, HL; *Neutrogena Corp v Golden Ltd* [1996] RPC 473 at 493-494, CA, per Morritt LJ; *Clark v Associated Newspapers Ltd* [1998] 1 All ER 959 at 966, [1998] RPC 261 at 271 per Lightman J. See also *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15 at 18, HL (where Lord Selborne LC said that the imitation of another's trade mark, in a manner liable to mislead the unwary, cannot be justified by showing either that the device or inscription upon the imitated mark is ambiguous and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled).

12 *Norman Kark Publications Ltd v Odhams Press Ltd* [1962] 1 All ER 636, [1962] 1 WLR 380, [1962] RPC 163; *Morning Star Co-operative Society Ltd v Express Newspapers Ltd* [1979] FSR 113 at 117 (where Foster J said that the two newspapers were so different that only 'a moron in a hurry' would be misled).

13 *Payton & Co Ltd v Snelling, Lampard & Co Ltd* (1899) 17 RPC 48 at 57 per Romer LJ; affd [1901] AC 308, 17 RPC 628, HL (where the customers confused were those who had no knowledge of the characteristics of coffee tins which were in fact common to the trade).

14 *HFC Bank plc v HSBC Bank plc (formerly Midland Bank plc)* [2000] FSR 176 (where it was considered essential that the claimant should demonstrate that it had achieved 'brand name recognition' to show it had goodwill, and the relevant test of deception related to its customers as regards whom it had achieved such recognition).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/330. Effect of fraudulent intention.

### 330. Effect of fraudulent intention.

Although proof of a fraudulent intention on the defendant's part is not a necessary element of the cause of action for passing off<sup>1</sup>, a fraudulent intention, if established, is a fact from which the court will readily infer that the defendant has succeeded in achieving his object of inducing deception<sup>2</sup>; but an intention to deceive is not conclusive that deception is in fact likely to occur<sup>3</sup>. Where a fraudulent intention is relied upon by the claimant, it must be pleaded expressly and proved by evidence<sup>4</sup>. Even if there is no fraudulent intention, a conscious decision on the part of the defendant to live dangerously is not something that the court is bound to disregard<sup>5</sup>.

Some of the commonest ways in which a fraudulent intention on the defendant's part may be inferred are from the lack of any adequate explanation or convincing reason for the adoption by the defendant of the name, mark or other indicium in question<sup>6</sup>, and from such matters as the garnishing of the defendant's name so as to increase the chance that it will be mistaken for the claimant's name<sup>7</sup>, the adoption of laudatory epithets which are used by the claimant but which are incorrect when used to describe the defendant's goods or services<sup>8</sup>, a false representation that a business is long-established in a way likely to lead persons to connect that business with the claimant's longer established business<sup>9</sup>, a false representation that the defendant has an office in a place where the claimant has one<sup>10</sup>, the adoption of the claimant's advertising slogans<sup>11</sup>, or the deliberate imitation of the claimant's trade forms<sup>12</sup> or get-up<sup>13</sup>. A request for an excessively large sum of money to desist may be regarded as evidence of a fraudulent intention<sup>14</sup>. An inference of fraudulent intention can also be drawn from the employment in a nominal capacity of a person with a particular surname in order to make use of his name in the business or the purported purchase or licensing from such a person of a right to make use of his name when he has no genuine business goodwill to convey<sup>15</sup>.

1 This is true at least of the cause of action in equity. As to the history of the distinction between passing off as a cause of action at common law and in equity see PARA 305 ante.

2 *Slazenger & Sons v Feltham & Co* (1889) 6 RPC 531 at 538, CA (where Lindley LJ said 'Why should we be astute to say that the defendant cannot succeed in doing that which he is straining every nerve to do?'); *Payton & Co Ltd v Snelling, Lampard & Co Ltd* (1899) 17 RPC 48 at 56, CA (affd [1901] AC 308, 17 RPC 628, HL) (where Romer LJ said 'you may well infer . . . that a man who was going to do a scoundrelly action for his own benefit would take care to do it effectually'); *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39 at 42, HL (where Lord Simonds said 'But if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade?').

To be relevant the intention must, however, be to mislead. A mere underestimate of a degree of initial confusion is not enough: *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 at 385-389, CA, per Slade LJ (the point not being argued in the subsequent appeal to the House of Lords: see *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, HL).

3 *Claudius Ash Son & Co Ltd v Invicta Manufacturing Co Ltd* (1912) 29 RPC 465 at 475, HL, per Lord Loreburn LC.

4 *Claudius Ash Son & Co Ltd v Invicta Manufacturing Co Ltd* (1912) 29 RPC 465 at 475, HL, per Lord Loreburn LC.

5 *United Biscuits (UK) Ltd v Asda Stores Ltd* [1997] RPC 513 at 530 per Robert Walker J. See also *HP Bulmer Ltd v J Bollinger SA* [1978] RPC 79 at 122, CA, per Goff LJ; *Sodastream Ltd v Thorn Cascade Co Ltd* [1982] RPC 459 at 466, CA, per Kerr LJ; *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 at 706, CA, per Millett LJ.

6 *Poiret v Jules Poiret Ltd and Nash* (1920) 37 RPC 177.

7 *Turton v Turton* (1889) 42 ChD 128 at 134, CA.

8 *Mappin and Webb Ltd v Leapman* (1905) 22 RPC 398; *Joseph Rodgers & Sons Ltd v Hearnshaw and Hearnshaw* (1906) 23 RPC 349.

9 *Mallan v Davis* (1886) 3 TLR 221; *William Coulson & Sons v James Coulson & Sons* (1887) 3 TLR 740; *J Lyons & Co Ltd v Lyons* (1931) 49 RPC 188; *Dagenham Girl Pipers Ltd v Vishnu Pather* (1951) 69 RPC 1.

10 *Van Oppen & Co Ltd v Van Oppen* (1903) 20 RPC 617 at 619.

11 *Harrods Ltd v R Harrod Ltd* (1923) 41 RPC 74, CA.

12 *Van Oppen & Co Ltd v Van Oppen* (1903) 20 RPC 617.

13 *Price's Patent Candle Co Ltd v Ogston and Tennant Ltd* (1909) 26 RPC 797; *W and G Du Cros Ltd v Gold* (1912) 30 RPC 117; *Parker & Son (Reading) Ltd v Parker* [1965] RPC 323.

14 Ie because it implies an act of extortion backed up with a threat to deliberately pass off if the amount requested is not paid: see *Glaxo plc v Glaxowellcome Ltd* [1996] FSR 388 (offer to sell company incorporated under name of proposed merged business); *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476, [1999] FSR 1, CA (offer to sell internet domain name).

15 See the cases of fraud cited in connection with the right of an individual to make use of his own name in PARA 344 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/331. Passing off where misrepresentation is made indirectly.

### **331. Passing off where misrepresentation is made indirectly.**

A trader is not permitted to use any mark, device or other means<sup>1</sup> whereby, although he does not make a false representation to a direct purchaser of his goods, he enables such a purchaser to make a false representation to ultimate purchasers of those goods<sup>2</sup>.

Where goods are sold to trade customers who are not themselves deceived but the goods are so marked or got up as to be calculated<sup>3</sup> to deceive ultimate purchasers, the claimant's cause of action for passing off is regarded as complete, both at law<sup>4</sup> and in equity<sup>5</sup>, as soon as the goods are disposed of to the trade customers. Any such goods calculated to deceive are regarded as instruments of deception, and the court has jurisdiction to grant injunctive relief where a defendant is equipped with or is intending to equip another with an instrument of deception<sup>6</sup>. It is not enough that the goods are merely capable of being used by dealers to perpetrate frauds on their customers; the goods, or leaflets or other material supplied with them, must be intended or of such a nature as to suggest, or readily or easily lend themselves to, such passing off, as otherwise the consequence is too remote to be attributed to the supplier of the goods<sup>7</sup>. The fact that some middlemen have chosen to pass off goods which are capable of being sold in a perfectly lawful manner does not mean that the supplier has caused or enabled the passing off<sup>8</sup>. Goods may be regarded as calculated to deceive when they are marked with a distinctive feature by which the claimant's goods have become known in the market which enables dealers to supply them in response to requests for the claimant's goods<sup>9</sup>. It is unnecessary that the goods should actually be marked deceptively when they are supplied to middlemen if the goods, packaging or labels are supplied in component form for the purpose of final assembly into products which will be deceptive<sup>10</sup>. The supply of goods in the United Kingdom for export to a country where they are calculated to deceive amounts to passing off<sup>11</sup>, at least where the trader in the United Kingdom has sufficient knowledge that the sale of the goods abroad will be deceptive<sup>12</sup>.

Similarly, indirect misrepresentations may be made in connection with the passing off of services or businesses, although such a misrepresentation occurs more rarely than in connection with the passing off of goods<sup>13</sup>.

1 As to passing off by use of a name or mark see PARA 326 et seq ante; and as to passing off by similarity of get-up or shape of goods see PARA 338 et seq post.

2 *Singer Manufacturing Co v Loog* (1880) 18 ChD 395 at 412, CA, per James LJ (affd (1882) 8 App Cas 15, HL); *Frank Reddaway & Co Ltd v George Banham & Co Ltd* [1896] AC 199 at 216, 13 RPC 218 at 231, HL, per Lord Macnaghten.

3 For these purposes, 'calculated' means that it is the reasonably foreseeable consequence that ultimate purchasers will be deceived; it does not have to be the intended consequence: *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 at 742, [1979] 2 All ER 927 at 933, [1980] RPC 31 at 93, HL.

4 *Sykes v Sykes* (1824) 3 B & C 541. Damage (which is an essential ingredient of the action) is inferred from the threat that a quantity of deceptive goods is likely to be resold at any moment: *Draper v Trist* [1939] 3 All ER 513 at 522-523, 56 RPC 429 at 436, CA, per Sir Wilfrid Greene MR.

5 *Lever v Goodwin* (1887) 36 ChD 1, 4 RPC 492, CA (where an account of profits was awarded in respect of all the deceptive goods sold to middlemen, not just the proportion passed off to customers as the claimant's goods).



6 *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476, [1999] FSR 1, CA. It appears from this that a mere intention to equip oneself with an instrument of fraud, even without any intention to use it, may be restrained. It seems that eg a company which is formed with an inherently deceptive name, or the registration of an inherently deceptive domain name is to be treated as analogous to goods which are instruments of deception. As to domain names as instruments of deception see PARA 342 post.

7 *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15 at 21, HL, per Lord Selborne LC; *Payton & Co Ltd v Snelling, Lampard & Co Ltd* [1901] AC 308 at 311, 17 RPC 628 at 635, HL, per Lord Macnaghten; *John Brinsmead & Sons Ltd v Brinsmead* (1913) 30 RPC 493 at 509, 511-512, CA, per Buckley LJ (who said that a defendant was not liable where a 'little additional lever' of falsehood applied by the dealer was needed to pass the goods off as the plaintiffs'); *Cadbury Ltd v Ulmer GmbH* [1988] FSR 385 ('Flakes') (where a defendant supplying chocolate bars the same shape as Cadbury's Flakes to ice-cream vendors was held not liable for acts of passing off committed by the vendors).

8 *Apollinaris Co Ltd v Duckworth & Co* (1906) 23 RPC 540 at 548, CA, per Warrington J (where salts prepared by the defendants, according to the analysis of the plaintiffs' mineral water, were reconstituted by a customer and sold as genuine mineral water). As to assisting passing off by others see also PARA 332 post.

9 *R Johnstone & Co v Archibald Orr Ewing & Co* (1882) 7 App Cas 219, HL; *Lee Kar Choo (t/a Yeen Thye Co) v Lee Lian Choon (t/a Chuan Lee Co)* [1967] 1 AC 602, [1966] 3 All ER 1000, PC; cf *Boord & Son Inc v Bagots, Hutton & Co Ltd* [1916] 2 AC 382, 33 RPC 357, HL.

10 *John Walker & Sons Ltd v Henry Ost & Co Ltd* [1970] 2 All ER 106, [1970] 1 WLR 917, [1970] RPC 489 (where bulk whisky was supplied together with bottles and deceptive labels); *John Walker & Sons Ltd v Douglas McGibbon & Co Ltd* [1975] RPC 506, Ct of Sess. In *John Walker & Sons Ltd v Henry Ost & Co Ltd* supra at 115, 928 and 504, in relation to one of the two types of labels involved, it was said that it does not make the defendant any the less culpable if, instead of supplying the deceptive labels, he merely supplies the product knowing and intending that deceptive labels will be applied; and in *White Horse Distillers Ltd v Gregson Associates Ltd* [1984] RPC 61, bulk whisky supplied without labels was described as an 'inchoate instrument of deception' where the supplier knew of and participated in its marketing with deceptive labels in Uruguay. Liability in these circumstances is better explained on the basis that the defendant is liable for facilitating the passing off or cognate tort which occurs abroad (see PARA 332 post) rather than on the basis that the supply of unmarked goods not inherently deceptive is itself an act of passing off.

11 *R Johnston & Co v Archibald Orr Ewing & Co* (1882) 7 App Cas 219, HL.

12 *John Walker & Sons Ltd v Henry Ost & Co Ltd* [1970] 2 All ER 106 at 120, [1970] 1 WLR 917 at 933, [1970] RPC 489 at 508-509.

13 See eg *Society of Accountants and Auditors v Goodway and London Association of Accountants Ltd* [1907] 1 Ch 489, where the defendant association conferred upon its members the right to use the title 'incorporated accountant', so causing deception. As to the use of internet domain names to pass off see PARA 342 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/(iii) Misrepresentation/332. Assisting or being involved in passing off by others.

### **332. Assisting or being involved in passing off by others.**

The liability of a person who enables or assists others to pass off their goods as the claimant's goods by supplying packaging or materials<sup>1</sup> is to be decided on principles more restricted than those which apply to a person who actually supplies goods, whether made up or in component form, so labelled or got up as to be calculated to deceive<sup>2</sup>. Negligence on the part of a printer who supplies deceptive packaging but fails to make sufficient inquiry is not enough to found liability<sup>3</sup>, nor is mere negligence on the part of a person who supplies unlabelled bulk material without knowledge of and participation in the application of deceptive labels by his customer<sup>4</sup>. It may be that knowingly to supply materials for the purpose of enabling goods to be passed off would give rise to liability in negligence or an analogous cause of action<sup>5</sup>, but the supply of materials which some customers may use for the purpose of passing off does not give rise to liability if the materials can also be used lawfully<sup>6</sup>.

Under a head of liability distinct from that of liability for enabling passing off by others, persons who supply materials or who otherwise assist or are involved in the commission of passing off may incur liability as joint wrongdoers. To do so they must satisfy the requirement of being parties to a common design in the course of which the passing off occurs<sup>7</sup>; and under this head persons who make themselves parties to acts of passing off or cognate torts occurring abroad can be sued in the United Kingdom in respect of those acts<sup>8</sup>. Similarly, promoters involved in the formation of companies with deceptive names<sup>9</sup>, or directors and managers of companies which engage in passing off<sup>10</sup>, may incur liability.

Persons who facilitate passing off by others in circumstances where they do not themselves become wrongdoers may nevertheless, under the protective jurisdiction of equity, be restrained by injunction from parting with deceptive goods which have come under their control<sup>11</sup>, or be ordered to disclose information as to the identity of their correspondents to enable the claimants to take proceedings against the wrongdoers<sup>12</sup>.

1 As to passing off by similarity of get-up see PARA 338 et seq ante.

2 See *John Walker & Sons Ltd Henry Ost & Co Ltd* [1970] 2 All ER 106, [1970] 1 WLR 917, [1970] RPC 489. As to indirect passing off where the goods supplied are calculated to deceive see PARA 331 ante.

3 *Paterson Zochonis Ltd v Merfarken Packaging Ltd* [1983] FSR 273, CA.

4 *White Horse Distillers Ltd v Gregson Associates Ltd* [1984] RPC 61.

5 *Paterson Zochonis Ltd v Merfarken Packaging Ltd* [1983] FSR 273 at 283, CA, per Oliver LJ, at 289 per Fox LJ, and at 301 per Robert Goff LJ.

6 *Apollinaris Co Ltd v Duckworth & Co* (1906) 23 RPC 540 at 548, CA, per Warrington J (where mineral water salts were used for making up into mineral water which was passed off as genuine). See also *CBS Inc v Ames Records and Tapes Ltd* [1982] Ch 91, [1981] 2 All ER 812, [1981] RPC 407 (where blank tapes were used by customers for infringing copyright), and the cases there cited.

7 *CBS Songs Ltd v Amstrad Consumer Electronics plc* [1988] AC 1013, [1988] 2 All ER 484, [1988] RPC 567, HL (no common design between the suppliers of home taping equipment and home tapers to infringe copyright); *Unilever plc v Gillette (UK) Ltd* [1989] RPC 583, CA; *Credit Lyonnais Bank Nederland NV v Export Credit Guarantee Department* [1998] 1 Lloyd's Rep 19, CA. See also *Cadbury Ltd v Ulmer GmbH* [1988] FSR 385 ('Flakes') (where a defendant supplying chocolate bars the same shape as Cadbury's Flakes to ice-cream vendors was held not liable for acts of passing off committed by the vendors).

8 *John Walker & Sons Ltd v Henry Ost & Co Ltd* [1970] 2 All ER 106, [1970] 1 WLR 917, [1970] RPC 489 (where in Ecuador whisky mixed with local spirit was passed off as a Scotch whisky, and liability for the passing off in Ecuador was treated as distinct from the defendants' liability for passing off by the act of supplying the whisky with labels calculated to deceive). The power of the court to grant relief in respect of the defendants' participation in the passing off occurring abroad formerly arose from the general rule that a court in England or Wales will grant relief against a defendant over whom it has personal jurisdiction in respect of an act done in a foreign country which is actionable according to English law and which is not justifiable according to the law of the country concerned: see *John Walker & Sons Ltd v Henry Ost & Co Ltd* supra at 120, 933 and 509. See also *Alfred Dunhill Ltd v Sunoptic SA* [1979] FSR 337, CA (where an injunction was granted extending to the United Kingdom and Switzerland, with liberty to the plaintiffs to apply to extend the injunction to other countries on proof of passing off there and of the local law). Now such conduct may be actionable in England by virtue of the Private International Law (Miscellaneous Provisions) Act 1995 Pt III (ss 9-15) (see CONFLICT OF LAWS vol 8(3) (Reissue) PARA 368); but it seems clear that this involves proof that the conduct is tortious under local law rather than by virtue of the English law of passing off. In order to advance such a claim the relevant propositions of foreign law should be pleaded: cf *Global Multimedia International Ltd v ARA Media Services* [2006] EWHC 3107 (Ch), (2006) Times, 1 August. See also *Mother Bertha Music Ltd v Bourne Music Ltd* [1997] EMLR 457.

9 *SA des Anciens Etablissements Panhard and Levassor v Panhard Levassor Motor Co Ltd* [1901] 2 Ch 513, 18 RPC 405; cf *Allen v Original Samuel Allen & Sons Ltd* (1915) 32 RPC 33.

10 *MCA Records Inc v Charly Records Ltd* [2001] EWCA Civ 1441, [2002] EMLR 1.

11 See PARA 454 post.

12 See PARA 453 post.

## UPDATE

### 332 Assisting or being involved in passing off by others

NOTE 8--See also *HG Investment Managers Ltd v HIG European Capital Partners LLP* [2009] FSR 947 (could not be assumed that law of passing off uniform in all member states).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/ (iv) Damage/333. Types of damage.

## **(iv) Damage**

### **333. Types of damage.**

It is essential to an action for passing off that the defendant's activities cause substantial damage to the claimant's business or goodwill, or are likely to do so if continued<sup>1</sup>. Where the defendant's goods or services compete with the claimant's, it is likely that the claimant will suffer loss of profits as a result of purchasers buying the defendant's goods or services in place of the claimant's<sup>2</sup>. Damage may occur despite the fact that the defendant's goods or services are not inferior to the claimant's<sup>3</sup>, although, if they are inferior, the claimant may suffer additional damage to the reputation of his goods or services.

Where the claimant and the defendant do not compete and so the defendant's activities cannot lead directly to loss of sales by the claimant, the claimant may nevertheless suffer damage by being associated in the minds of the relevant traders or the public with the defendant or his business, goods or services<sup>4</sup>. The quality of the defendant's goods or services, the kind of business he does and the credit which he enjoys are all matters which may injure a claimant who is assumed wrongly to be associated with him<sup>5</sup>. Damage is likely to occur if the defendant<sup>6</sup> or his business<sup>7</sup> is unsavoury in character, and, if the defendant has adopted a name similar to the claimant's with fraudulent intent, the court will readily infer the probability of tangible injury to the claimant's trade reputation<sup>8</sup>. Even where there is no reason to suppose that there is anything concerning the defendant or his business which would adversely affect the claimant in the immediate future, the fact that the claimant's reputation is placed at the mercy of an entity over which the claimant has no control and which might get into difficulties in the future<sup>9</sup> may be sufficient to justify the grant of a permanent injunction at the trial<sup>10</sup>, provided that the degree to which the claimant and the defendant may be associated by the public is sufficiently great<sup>11</sup>. In some cases the risk that the claimant may be exposed to litigation if the public assumes that he is responsible for the defendant's business has been held to give rise to a tangible risk of damage to the claimant<sup>12</sup>.

1 *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL, per Lord Oliver of Aylmerton ('Jif Lemon'). While confusion which is quickly corrected, so that it does not give rise to any damage, will not found an action in passing off (see PARA 335 post), it is open to question whether damage of the relevant sort is sustained where persons are led to the defendant by means of a misrepresentation, and are then disabused before transacting business which would otherwise have gone to the claimant: see *HFC Bank plc v Midland Bank plc* [2000] FSR 176 at 186, 202 per Lloyd J.

2 *Draper v Trist* [1939] 3 All ER 513, 56 RPC 429, CA (where it was held that, if the defendant puts a quantity of goods on the market which are calculated to be taken as the claimant's, the court will generally infer that this will lead to some loss of sales by the claimant without necessarily requiring proof of individual transactions in which this can be shown to have taken place). See also *Procea Products Ltd v Evans & Sons Ltd* (1951) 68 RPC 210; *McDonald's Hamburgers Ltd v Burgerking (UK) Ltd* [1987] FSR 112, CA; *Kimberley-Clark Ltd v Fort Sterling Ltd* [1997] FSR 877 (plaintiff entitled to protection not only from loss of sales but also from commercial damage caused by a competitor taking the benefit of his reputation); *Clark v Associated Newspapers Ltd* [1998] 1 All ER 959, [1998] RPC 261 (damage may be presumed in a case of false attribution of authorship).

3 *Blofeld v Payne* (1833) 4 B & Ad 410; *Edelsten v Edelsten* (1863) 1 De GJ & Sm 185. See also *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15 at 30, HL, per Lord Blackburn.

4 This may extend to dilution or erosion of the claimant's goodwill through loss of distinctiveness of the mark in question: *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75, [1993] FSR 641, CA ('elderflower champagne'; damage through the erosion of the uniqueness which attends the word 'champagne'). See also *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476, [1999] FSR 1, CA; *Irvine v TalkSport*

*Ltd*[2002] EWHC 367 (Ch) at [34]-[38], [2002] 2 All ER 414 at [34]-[38], [2002] EMLR 679 at [34]-[38] per Laddie J (affd [2003] EWCA Civ 423, [2003] 2 All ER 881); but see *Harrods Ltd v Harrodian School Ltd*[1996] RPC 697 at 715-716, CA, per Millett LJ.

5 *Ewing v Buttercup Margarine Co Ltd*[1917] 2 Ch 1 at 13, 34 RPC 232 at 239, CA, per Warrington LJ; *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* [1987] RPC 189 at 202, CA, per Slade LJ; *Phones 4U Ltd v Phone4u.co.uk Internet Ltd*[2006] EWCA Civ 244 at [14], [2007] RPC 83 at [14] per Jacob LJ.

6 *Harrods Ltd v R Harrod Ltd* (1923) 41 RPC 74, CA (where a moneylender fraudulently passed himself off as a branch of the well known store).

7 *Annabel's (Berkeley Square) Ltd v Schock (t/a Annabel's Escort Agency)*[1972] RPC 838, CA (where an escort agency was restrained from trading under the same name as the well known night club). Cf *McCulloch v Lewis A May (Produce Distributors) Ltd*[1947] 2 All ER 845 at 851, 65 RPC 58 at 67 (where the opinion of some witnesses that the plaintiff would lower himself by allowing his name to be attached to breakfast cereals was held not to give rise to a tangible risk of injury to his professional reputation); *Stringfellow v McCain Foods (GB) Ltd*[1984] RPC 501, [1984] FSR 175 (revsd [1984] RPC 501 at 525, CA).

8 *Lloyd's v Lloyd's (Southampton) Ltd* (1912) 29 RPC 433, CA; *Harrods Ltd v R Harrod Ltd* (1923) 41 RPC 74, CA.

9 *FW Woolworth & Co Ltd v Woolworths (Australasia) Ltd* (1930) 47 RPC 337; *British Legion v British Legion Club (Street) Ltd* (1931) 48 RPC 555 at 564.

10 This risk of damage in the long term does not justify the grant of an interim injunction, for which the likelihood of damage to the claimant's business or his trading reputation must be much more direct and immediate, eg arising from the poor quality of the defendant's goods: see *Lyons Maid Ltd v Trebor Ltd*[1967] RPC 222.

11 See *Society of Motor Manufacturers and Traders Ltd v Motor Manufacturers' and Traders' Mutual Insurance Co Ltd*[1925] Ch 675 at 692, 42 RPC 307 at 319, CA, per Warrington LJ (who said that, even if a certain number of persons were to think that the defendants were connected with the plaintiffs, in the circumstances there was no tangible risk of loss or damage to the plaintiffs).

12 *Walter v Ashton*[1902] 2 Ch 282 (bicycle shop passed off as being a branch of 'The Times' newspaper); *Illustrated Newspapers Ltd v Publicity Services (London) Ltd*[1938] Ch 414, [1938] 1 All ER 321, 55 RPC 172.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/ (iv) Damage/334. Common field of activity and damage.

### **334. Common field of activity and damage.**

The similarity of the fields of activity in which the claimant and the defendant are engaged is highly relevant to the question of whether or not the defendant's use of the name, mark or other indicium complained of amounts to a misrepresentation, since the more disparate the fields, whether geographically or in terms of the type of business carried on, the less likely it is that the defendant will be assumed to be connected with the claimant<sup>1</sup>. However, even though substantial numbers of persons assume that the claimant and the defendant are connected, if the claimant and the defendant are not engaged in the same or associated fields of activity, it may be that there is no real and tangible risk that the claimant will suffer damage, and accordingly his action for passing off will not succeed<sup>2</sup>. Where the fields of activity of the claimant and the defendant are different, the question whether a connection is likely to be assumed between the claimant and the defendant, and the question whether such association gives rise to a real and tangible risk of damage, are not always clearly distinguished<sup>3</sup>.

In considering whether there is a likelihood of damage to the claimant's business, the court may have regard not only to the present state of affairs but also to the fact that natural expansion of the claimant's business or of the defendant's business may bring the claimant and the defendant into competition in the future<sup>4</sup>. It has been held that the use of the claimant's reputation to promote the sale of goods which he is not engaged in selling can be regarded as causing damage to him even in the absence of any present or reasonably imminent intention on his part of selling or licensing the sale of such goods himself, the damage being the appropriation of the claimant's reputation in that field and the potential of exploiting it, and the loss of the fee which he would have been able to secure from the defendant for the use of his name and reputation<sup>5</sup>. Where, however, the claimant's and the defendant's fields of activity are far removed, even if certain uninformed members of the public or persons with special connections with the claimant were to believe mistakenly that there is a connection between them, a court should not readily infer the likelihood of consequential damage to the claimant, especially against an innocent defendant<sup>6</sup>. The attitude of the courts as to what constitutes sufficient likelihood of damage has changed over the years so that some of the older cases where the likelihood of damage to the claimant was held to be insufficient would now not necessarily be followed<sup>7</sup>.

1 *Annabel's (Berkeley Square) Ltd v Schock (t/a Annabel's Escort Agency)* [1972] RPC 838 at 844, CA, per Russell LJ. As to a common field of activity and likelihood of deception see PARA 328 ante.

2 *Ormond Engineering Co Ltd v Knopf* (1932) 49 RPC 634 (where a false representation that the defendant's goods were licensed under the plaintiff's patent was not actionable as the plaintiffs were not themselves selling competing goods); *McCulloch v Lewis A May (Produce Distributors) Ltd* [1947] 2 All ER 845, 65 RPC 58 (where breakfast cereal was sold under the name of a well known children's broadcaster but it was held that there was no likelihood of damage to the plaintiff in his profession). See also *Sim v HJ Heinz Co Ltd* [1959] 1 All ER 547, [1959] 1 WLR 313, [1959] RPC 75, CA (where there was imitation of an actor's voice in an advertisement); *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [1984] FSR 413, CA (where sales of the defendants' beer in the general market in the United Kingdom was held not likely to damage the plaintiff's business of selling beer abroad and to American service bases in the United Kingdom); *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697, CA (where a school was run under a name similar to the well known store, it was held unlikely that the store's goodwill would be damaged by anything which happened at the school).

3 See eg *Albion Motor Car Co Ltd v Albion Carriage and Motor Body Works Ltd* (1917) 34 RPC 257. The two questions cannot be considered in isolation, as the question whether the defendant's activities pose a real and tangible risk of injury to the claimant's business or goodwill depends among other things on the degree to which the claimant and the defendant are likely to be associated, so that a high risk of association justifies an

injunction even when there is only a remote risk of damage (see *FW Woolworth & Co Ltd v Woolworths (Australasia) Ltd* (1930) 47 RPC 337), but a low risk of confusion does not justify an injunction unless the probability of damage is much more real (see *Society of Motor Manufacturers and Traders Ltd v Motor Manufacturers' and Traders' Mutual Insurance Co Ltd* [1925] Ch 675 at 692, 42 RPC 307 at 319, CA).

4 *Dunlop Pneumatic Tyre Co Ltd v Dunlop Lubricant Co* (1898) 16 RPC 12 at 15 (plaintiff's business); *Crystalite Gramophone Record Manufacturing Co Ltd v British Crystalite Co Ltd* (1934) 51 RPC 315 at 322 (defendant's business).

5 See *Henderson v Radio Corp Pty Ltd* [1969] RPC 218 at 236, 244 (where a photograph of ballroom dancers was placed on a record sleeve in such a way as to suggest that the dancers had sponsored or recommended the music); *Lego System A/S v Lego M Lemelstrich Ltd* [1983] FSR 155 (where garden sprinklers were sold under the same name as well known toy bricks); *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [1984] FSR 413, CA (where the defendant's entry into the general market in the United Kingdom where the plaintiffs had a reputation unconnected with ability or willingness to supply the goods was held not to give rise to potential damage to the plaintiffs); *Irvine v TalkSport Ltd* [2003] EWCA Civ 423, [2003] 2 All ER 881 (where the claimant racing driver succeeded in a claim for passing off by misrepresentation of endorsement against the defendant radio station and recovered as damages the fee he could have charged). As to merchandising see also PARA 340 post.

6 *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 at 525, CA (where the defendant marketed long, thin potato chips as 'Stringfellows', the name of a night club proprietor, and the court refused to conclude that substantial damage was likely even though there was a degree of misrepresentation).

7 See eg *Clark v Freeman* (1848) 11 Beav 112 (commented on in *Walter v Ashton* [1902] 2 Ch 282 at 293) (where an eminent physician was refused an injunction to prevent the fraudulent sale of quack medicine under his name); *Borthwick v Evening Post* (1888) 37 ChD 449, CA (where it was held that the assumption by the public that a new evening newspaper was connected with an existing morning newspaper was not likely to prejudice the publishers of the morning newspaper).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(1) THE ELEMENTS OF PASSING OFF/ (iv) Damage/335. Confusion without damage.

### **335. Confusion without damage.**

In some circumstances where one business is confused with another, there may be, nevertheless, no damage of a kind which will sustain an action for passing off<sup>1</sup>. This is so even where the claimant and the defendant are in directly competing fields of business if the confusion is likely to be rapidly put right or if it causes clerical and administrative errors which lead to misdirected letters and telephone calls but which are likely to be put right because of the way in which the business is conducted without resulting in any loss to or diversion of business from the claimant<sup>2</sup>. Similarly, confusion and inconvenience caused by the adoption of the same telegraphic address<sup>3</sup>, or the claimant's failure to take extra precautions in identifying himself to persons with whom he corresponds<sup>4</sup>, have been held insufficient to sustain an action.

1 As to damage as an essential of the action for passing off see PARAS 333-335 ante.

2 *Meikle v Williamson* (1909) 26 RPC 775; *John Hayter Motor Underwriting Agencies Ltd v RBHS Agencies Ltd* [1977] FSR 285, CA; *Pasterfield v Denham* [1999] FSR 168, Plymouth County Court. See also PARA 333 note 1 ante.

3 *Street v Union Bank of Spain and England* (1885) 30 ChD 156; *George Outram & Co Ltd v London Evening Newspapers Co Ltd* (1911) 28 RPC 308 at 312.

4 *George Outram & Co Ltd v London Evening Newspapers Co Ltd* (1911) 28 RPC 308. See also *Newsweek Inc v BBC* [1979] RPC 441, CA.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(i) Descriptive, Generic and Geographical Names/336. Descriptive and geographical names.

## **(2) PARTICULAR CASES OF PASSING OFF**

### **(i) Descriptive, Generic and Geographical Names**

#### **336. Descriptive and geographical names.**

Special considerations apply where the claimant seeks to restrain as passing off the use of words or phrases which are descriptive of the goods or services concerned or of their geographical origin<sup>1</sup>.

It is possible for a word or phrase which is wholly descriptive of the goods or services concerned to become so associated with the goods or services of a particular trader that its use by another trader is capable of amounting to a representation that his goods or services are those of the first trader<sup>2</sup>. In these circumstances it is sometimes said that, although the primary meaning of the words is descriptive, they have acquired a secondary meaning as indicating the products of a particular trader and no other<sup>3</sup>. However, a trader who seeks to prove that words which are *prima facie* descriptive have acquired such a secondary meaning faces a heavy burden<sup>4</sup>, and the fact that such words, if used on their own without differentiation or explanation, will deceive does not mean that they cannot fairly be used with distinguishing words<sup>5</sup> or in a context where their meaning is descriptive<sup>6</sup>. Where the similarity between the trade marks or names of the claimant and defendant lies in descriptive words, the court will generally accept that small differences will be sufficient to distinguish them, at any rate in the absence of fraudulent intent<sup>7</sup>, even if some degree of confusion arises between the claimant and the defendant as a result, as to do otherwise would allow the claimant unfairly to monopolise words in common use in the English language<sup>8</sup>. Descriptiveness is a matter of degree, and words which have some reference to the goods or services concerned are not necessarily to be treated in the same way as if they were the natural or usual description of those goods or services<sup>9</sup>.

Similar principles apply to geographical names, so that it is difficult for a claimant to establish that a word having *prima facie* a geographical significance will indicate, when used by a defendant, the claimant's goods or services rather than goods or services from or connected with the geographical area concerned, especially where the goods are a natural product of the area rather than a manufactured article which could be made anywhere<sup>10</sup>. However, even though it might be possible for a geographical name to be used with adequate distinction in a way which is not deceptive, a name originally purely geographical in its significance may become so associated with the claimant's goods or services that its use on its own as a trade mark or name without adequate distinction will amount to passing off<sup>11</sup>, especially if it is used in conjunction with get-up or other indicia similar to that used by the claimant<sup>12</sup>. Formerly the misapplication of a geographical name to goods was not actionable at the suit of a trader who legitimately made use of that name, unless by doing so the defendant represented that his goods were goods of the claimant<sup>13</sup>, but this is no longer the law<sup>14</sup>.

1 As to misuse of descriptive terms see PARA 319 ante.

2 *Frank Reddaway & Co Ltd v George Banham & Co Ltd* [1896] AC 199, 13 RPC 218, HL (where it was held unlawful to apply to the goods a description which is literally true, but which is intended to and does convey to a purchaser that they are the claimant's goods). See also *Barnsley Brewery Co Ltd v RBNB* [1997] FSR 462

(where the plaintiff failed to show that 'Barnsley Bitter' had acquired a secondary meaning in fact); *Antec International Ltd v South Western Chicks (Warren) Ltd* [1998] FSR 738.

3 See eg *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326 at 333, 339, 343, 16 RPC 397 at 403, 406, 409, HL.

4 See *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326, 16 RPC 397, HL. Cf the strange facts of *Frank Reddaway & Co Ltd v George Banham & Co Ltd* [1896] AC 199, 13 RPC 218, HL (where it was not known in the trade that the phrase 'camel hair' was descriptive of the plaintiff's belting, and the defendant used it with intent to pass off his goods as the plaintiff's).

5 *Frank Reddaway & Co Ltd v George Banham & Co Ltd* [1896] AC 199 at 210, 222, 13 RPC 218 at 228, 234, HL.

6 *Burberrys v JC Cording & Co Ltd* (1909) 26 RPC 693.

7 *Aerators Ltd v Tollitt* [1902] 2 Ch 319, 19 RPC 418; *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39, HL; *World Athletics and Sporting Publications Ltd v ACM Webb (Publishing) Co Ltd* [1981] FSR 27, CA ('Athletics Weekly' and 'Athletics Monthly' magazines). Cf *Mothercare Ltd v Robson Books Ltd* [1979] FSR 466.

8 See *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326 at 339-340, 16 RPC 397 at 407, HL, per Lord Shand; *British Vacuum Cleaner Co Ltd v New Vacuum Cleaner Co Ltd* [1907] 2 Ch 312 at 328-329, 24 RPC 641 at 655 per Parker J; *Motor Manufacturers and Traders' Society Ltd v Motor Manufacturers and Traders' Mutual Insurance Co Ltd* [1925] Ch 675 at 689-690, 42 RPC 307 at 318-319, CA, per Lawrence J and at 692 and 320 per Sargent LJ; *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39 at 43, HL, per Lord Simonds. It appears that the courts are influenced by the consideration that a claimant who adopts as a mark or trading style words which are wholly descriptive of his goods or services is himself partly responsible for confusion which arises from the fair use by others of those descriptive words. See also *Mothercare UK Ltd v Penguin Books Ltd* [1988] RPC 113, CA (where the well known stores group was held not entitled to restrain the publication of a book about caring for children entitled 'Mother Care/Other Care').

9 *Music Corp'n of America v Music Corp'n (Great Britain) Ltd* (1946) 64 RPC 41 at 44; *Legal and General Assurance Society Ltd v Daniel* [1968] RPC 253, CA; *Pickwick International Inc (GB) Ltd v Multiple Sound Distributors Ltd* [1972] 3 All ER 384, [1972] 1 WLR 1213, [1972] RPC 786; *Computervision Corp'n v Computer Vision Ltd* [1975] RPC 171. Cf *Newsweek Inc v BBC* [1979] RPC 441, CA (television programme called 'Newsweek'). By analogy, fancy packaging which cleverly refers to the characteristics of the goods themselves is not to be equated with a description of the goods: *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL ('Jif Lemon').

10 *Rugby Portland Cement Co Ltd v Rugby and Newbold Portland Cement Co Ltd* (1891) 9 RPC 46, CA; *Grand Hotel Co of Caledonia Springs Ltd v Wilson* [1904] AC 103, 21 RPC 117, PC (where competitors were legitimately entitled to use the name 'Caledonia' in order to gain advantage from the fame acquired by the plaintiffs' mineral water from the same locality); *Hopton Wood Stone Firms Ltd v Gething* (1910) 27 RPC 605. See also *Tigon Mining and Finance Corp'n Ltd v South Tigon Mining Co Ltd* (1931) 48 RPC 526 (where a name belonging originally to the plaintiff company became so associated with an area where it conducted mining operations that it could be used by the defendant without deception as a geographical word).

11 *Seixo v Provezende* (1866) 1 Ch App 192; *Montgomery v Thompson* [1891] AC 217, 8 RPC 361, HL; *North Cheshire and Manchester Brewery Co Ltd v Manchester Brewery Co Ltd* [1899] AC 83, HL; *Worcester Royal Porcelain Co Ltd v Locke & Co* (1902) 19 RPC 479; *Berkeley Hotel Co Ltd v Berkeley International (Mayfair) Ltd* [1972] RPC 237.

12 *Price's Patent Candle Co Ltd v Ogston and Tennant Ltd* (1909) 26 RPC 797. See also *Wotherspoon v Currie* (1872) LR 5 HL 508 (where the defendant set up premises in Glenfield for the purpose of enabling him to pass off his starch as the plaintiff's which was sold under the name 'Glenfield Starch').

13 *California Fig Syrup Co v Taylor's Drug Co Ltd* (1897) 14 RPC 564, CA.

14 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31. See also PARA 319 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(i) Descriptive, Generic and Geographical Names/337. Invented name, or the name of the introducer or patentee, for novel goods or services.

**337. Invented name, or the name of the introducer or patentee, for novel goods or services.**

Special considerations may apply where a claimant introduces a new product and has for a period of time, either because of a patent or because of practical or commercial considerations, a monopoly in supplying it<sup>1</sup>. The courts are reluctant to permit a claimant under the guise of an action for passing off to seek to hamper competition by preventing competitors from making use of a name which is apt to describe the product, even if the name was invented and given to the product by the claimant<sup>2</sup>.

In such circumstances a claimant faces an evidential difficulty, in that it is to be expected that, while his product enjoys a de facto monopoly, it will be referred to or asked for by its descriptive name alone, but it does not follow from evidence of such practice that the public will still regard the descriptive name as denoting the goods of a particular manufacturer once there is a competitor on the market<sup>3</sup>, and it does not matter for this purpose that the words, although apt in common usage to describe the product, are, if strictly or scientifically construed, inaccurate<sup>4</sup>. A further difficulty may arise in that confusion may be inevitable when a new competitor enters a market which has hitherto been supplied by one trader, simply as a result of the similarity of the goods or services concerned<sup>5</sup>. In order to succeed in an action for passing off, the claimant must show that confusion is created or increased by some misrepresentation on the defendant's part, and it may be difficult to show that the particular use made by the defendant of inherently descriptive words is an operative misrepresentation causing confusion in addition to that arising simply from the similarity of the goods or services themselves<sup>6</sup>. Furthermore, a court may consider that, where a claimant trades under or uses as a trade mark words which are inherently descriptive of the goods or services without further distinguishing them, he brings on himself the risk of confusion arising from other traders' fair use of such descriptive terms<sup>7</sup>.

It is possible for the name of the first inventor or introducer of a novel article to come to indicate not the goods made by or under the licence of that particular individual but goods of that type made by any person, in which case the name of the inventor or introducer is said to have become *publici juris* or generic<sup>8</sup>, although this is far less prone to happen than in the case of words which are inherently descriptive<sup>9</sup>. More common is the situation where the name of the introducer or inventor can be used in a context where it signifies products of the general type<sup>10</sup> but where the use of the name in relation to the goods without sufficient distinction or qualification is likely to mislead and will be restrained<sup>11</sup>.

1 See *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326 at 344, 16 RPC 397 at 409, HL.

2 *McCain International Ltd v Country Fair Foods Ltd* [1981] RPC 69, CA (where it was held that the name 'oven chips' was descriptive of the product). See also *eFax.com Inc v Oglesby* [2000] IP & T 992, (2000) Times, 16 March (prefixing a word with an established meaning with the letter 'e' is descriptive of internet services).

3 *Siebert v Findlater* (1878) 7 ChD 801 at 813 ('Angostura Bitters'); *Parsons v Gillespie* [1898] AC 239 at 245, 15 RPC 57 at 62, PC ('Flaked Oatmeal'); *Cellular Clothing Co Ltd v Maxton and Murray* [1899] AC 326 at 344, 16 RPC 397 at 409, HL, per Lord Davey; *Linoleum Manufacturing Co v Nairn* (1878) 7 ChD 834 (where 'linoleum' was held to be descriptive); *McCain International Ltd v Country Fair Foods Ltd* [1981] RPC 69, CA. See also the comments of the members of the House of Lords on the 'monopoly assumption' in *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL ('Jif Lemon').

4 *Parsons v Gillespie* [1898] AC 239 at 245, 15 RPC 57 at 62, PC; *Horlick's Malted Milk Co v Summerskill* (1916) 33 RPC 108 at 114, CA (affd 34 RPC 63, HL); *McCain International Ltd v Country Fair Foods Ltd* [1981] RPC 69 at 74, CA.

5 As to confusion without any misrepresentation see PARA 324 ante.

6 *My Kinda Town Ltd v Soll* [1983] RPC 407 at 420, CA, per Oliver LJ, and at 434 per Robert Goff LJ. Similar considerations arise where passing off is alleged to occur as a result of the similarity of features of goods which are of benefit in use: see PARA 338 ante.

7 *British Vacuum Cleaner Co Ltd v New Vacuum Cleaner Co Ltd* [1907] 2 Ch 312 at 328-329, 24 RPC 641 at 655 per Parker J.

8 *Canham v Jones* (1813) 2 Ves & B 218 ('Velno's Vegetable Extract'); *Liebig's Extract of Meat Co Ltd v Hanbury* (1867) 17 LT 298; *Ford v Foster* (1872) 7 Ch App 611 at 628 per Mellish LJ.

9 See eg *Burberrys v Raper and Pulleyn* (1906) 23 RPC 170.

10 See eg *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15, HL ('Singer system' sewing machines).

11 *Singer Machine Manufacturers v Wilson* (1877) 3 App Cas 376, HL; *AV Roe & Co Ltd v Aircraft Disposal Co Ltd* (1920) 37 RPC 249.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(ii) Get-up and Shape of Goods/338. Passing off by similarity of get-up or shape of goods.

## **(ii) Get-up and Shape of Goods**

### **338. Passing off by similarity of get-up or shape of goods.**

Passing off may occur, not only by reason of any similarity of trade marks or names<sup>1</sup>, but because of the similarity of the general appearance or get-up of goods, or the premises in which business is conducted, or the advertising materials and other documents used in connection with the defendant's goods or services<sup>2</sup>.

The similarity of get-up may be such that passing off is likely to occur even though the trade marks or names are wholly different<sup>3</sup>, especially where the goods are likely to be bought by illiterate or uneducated persons<sup>4</sup>, but similarity or dissimilarity<sup>5</sup> of get-up is only one of the factors to be taken into account in deciding whether in all the circumstances there is a likelihood of deception, and a dissimilar name or mark, if given prominence, may negate the similarity of get-up<sup>6</sup>. A competing trader may adopt a get-up similar to that of the claimant's product, not in order to pass off his goods as the claimant's but in order impliedly to represent to the public that his goods are similar to or a substitute for the claimant's, thus competing in and taking advantage of a market created by the claimant's efforts; this is legitimate so long as he does not thereby represent his product as the claimant's or connected with it<sup>7</sup>.

In assessing whether or not the get-up of the defendant's goods is deceptively similar to the claimant's, characteristics which are common to the trade should be disregarded<sup>8</sup>, but the use in combination of a number of features which are individually used by others in the trade can amount to passing off<sup>9</sup>. Thus where the defendant adopts a feature used by the claimant which is also used by others in the trade, so that its use as such is unobjectionable, the defendant may nevertheless have to take greater care not to copy other features of the get-up of the claimant's goods<sup>10</sup>. Further, where the general appearance of the goods is necessarily similar, a defendant needs to take greater care to avoid adopting those features which are distinctive to the get-up of the claimant's goods<sup>11</sup>. It appears that a trader who is the first to import goods cannot monopolise features which are common to the trade in those goods in their country of origin, at least if no dishonesty is involved in the competing importation<sup>12</sup>.

It is possible for passing off to occur by reason of the similarity of the shape, nature or other characteristics of the goods themselves, as opposed to features of their packaging or marks applied to them<sup>13</sup>. Where, however, what is sought to be restrained is the copying of features of the claimant's goods which have value in use, as opposed to capricious attributes of shape or colour, the courts are reluctant to allow a claimant to secure a monopoly in a new type or design of goods under the guise of an action for passing off<sup>14</sup>, and in this regard the principles applied are closely parallel to those which apply where the claimant seeks to restrain as passing off the use of words or phrases which are descriptive of the goods or services concerned<sup>15</sup>. It is more difficult to establish as a matter of fact that purchasers will assume merely from attributes which have utility that the defendant's goods are the claimant's, particularly because they may buy those goods because of their utility or because of their visual appeal without caring or giving thought to who makes them<sup>16</sup>. Moreover, confusion which arises simply as a result of a new competitor selling a type of goods or services which previously have only been sold by the claimant is not regarded in law as arising from a representation made by the defendant<sup>17</sup>, and there is some authority that a defendant who simply copies attributes of the claimant's goods which give some benefit in use is not to be treated in law as thereby making a representation<sup>18</sup>.

1 As to passing off by use of a name or mark see PARA 326 et seq ante.

2 As to misrepresentation as an essential element of the action see PARA 323 ante.

3 *Reckitt & Colman Products Ltd v Borden Inc*[1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL ('Jif Lemon') (where differing trade names and labels were held insufficient on the facts to prevent confusion arising from the adoption by the defendant of a lemon-shaped plastic container for lemon juice); *Tavener Rutledge Ltd v Specters Ltd*[1959] RPC 355, CA (see the photographs of tins at [1959] RPC 83); *United Biscuits (UK) Ltd v Asda Stores Ltd*[1997] RPC 513 (where similarities in packaging of 'Puffin' biscuits to packaging of 'Penguin' biscuits resulted in passing off whereas the name alone did not).

4 *Lever v Godwin*(1887) 36 ChD 1 at 5, 4 RPC 492 at 504, CA; *Lee Kar Choo (t/a Yeen Thye Co) v Lee Lian Choon (t/a Chuan Lee Co)*[1967] 1 AC 602, [1966] 3 All ER 1000, PC.

5 See eg *Coleman & Co Ltd v John Brown & Co* (1899) 16 RPC 619, CA.

6 *Schweppes Ltd v Gibbens* (1905) 22 RPC 601 at 606-607, HL (where Lord Halsbury LC expressed the view that persons who are so careless that they do not treat the label fairly but take the goods without sufficient consideration and without reading what is written plainly on them cannot be said to be deceived because they do not care what they are getting); *Fisons Ltd v EJ Godwin (Peat Industries) Ltd*[1976] RPC 653; *Tetrosyl Ltd v Silver Paint and Lacquer Co Ltd* [1980] FSR 68, CA.

7 *F King & Co Ltd v Gillard & Co*[1905] 2 Ch 7, 22 RPC 327, CA; *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd*[1981] 1 All ER 213 at 218-219, [1981] 1 WLR 193 at 200, [1981] RPC 429 at 491, PC. See also PARA 323 ante.

8 *Hennessy (James) & Co v Keating* (1908) 25 RPC 361, 52 Sol Jo 455, 24 TLR 534, HL; *JB Williams Co v H Bronnley & Co Ltd* (1909) 26 RPC 765, CA. The evidence of customers who have little knowledge of the goods on the market, and so do not know which features of the claimant's goods are common to the trade and which are distinguishing characteristics, should be disregarded by the court: *Payton & Co Ltd v Snelling, Lampard & Co Ltd* (1899) 17 RPC 48 at 57, CA, per Romer LJ; affd [1901] AC 308, 17 RPC 628, HL.

9 *Lever v Goodwin*(1887) 36 ChD 1, 4 RPC 492, CA.

10 *W and G Du Cros Ltd v Gold* (1912) 30 RPC 117 at 126.

11 *Cordes v R Addis & Son* (1923) 40 RPC 133 at 139.

12 *Boord & Son Inc v Bagots, Hutton & Co Ltd*[1916] 2 AC 382 at 393, sub nom *Re Bagots, Hutton & Co Ltd's Application* 33 RPC 357, HL, per Lord Loreburn.

13 See *Hodgkinson and Corby Ltd v Wards Mobility Services Ltd* [1994] 1 WLR 1564, [1995] FSR 169; *RJ Elliott & Co Ltd v Hodgson* (1902) 19 RPC 518 (imitation of specially shaped cigars restrained); *F Hoffman-La Roche & Co AG v DDSA Pharmaceuticals Ltd*[1972] RPC 1, CA (coloured drug capsules); cf *Roche Products Ltd v Berk Pharmaceuticals Ltd*[1973] RPC 473, CA.

14 *William Edge & Sons Ltd v William Niccolls & Sons Ltd*[1911] AC 693, HL (where the plaintiffs had for many years been the only firm to sell laundry blue in bags to which a stick was attached, thus allowing the bags to be dipped in the water without staining the user's hands, and the defendants were restrained from imitating the shape of the plaintiff's stick but not from using any stick). As to the statutory policy reflected in the restrictions on the registrability of the shape of goods as trade marks see PARA 62 ante.

15 As to the use of descriptive names see PARA 336 ante.

16 *Blundell v Sidney Margolis Ltd* (1951) 68 RPC 71 (bubble gum in the shape of teeth); *Hawkins and Tipson Ltd (Proprietors of Green Bros) v Fludes Carpets Ltd and British Floorcloth Co Ltd*[1957] RPC 8 (pattern on coconut floor matting); *British American Glass Co Ltd v Winton Products (Blackpool) Ltd*[1962] RPC 230 (ornamental dogs); *Gordon Fraser Gallery Ltd v Tatt*[1966] RPC 505 (style of greetings cards); *Jarman and Platt Ltd v I Barget Ltd* [1977] FSR 260, CA (style of furniture); *Lyngstad v Anabas Products Ltd* [1977] FSR 62 (where it was held that badges depicting popular musicians were bought for their own sake rather than because buyers assumed that the sale of the goods was connected with the persons depicted); *Politechnika Ipari Szovetkezet v Dallas Print Transfers Ltd* [1982] FSR 529 ('Rubik' puzzle cubes).

17 For circumstances where confusion arises as a result of the defendant's activities, but not as a result of any misrepresentation on his part, see PARA 324 ante.

18     *Benchairs Ltd v Chair Centre Ltd* [1974] RPC 429 at 435-436 per Graham J (revsd on another point [1974] RPC 429, CA), applying a dictum of Fletcher Moulton LJ in *JB Williams Co v H Bronnley & Co Ltd* (1909) 26 RPC 765 at 773, CA. See also *Jones Bros Ltd v Anglo-American Optical Co* (1912) 29 RPC 361, CA. Cf *Children's Television Workshop Inc v Woolworths (NSW) Ltd* [1981] RPC 187, NSW SC. That this is a rule of law, as distinct from a factual circumstance giving rise to greater difficulties of proof on the part of the claimant, was, however, doubted in *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL ('Jif Lemon').

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(iii) Titles/339. Titles.

### (iii) Titles

#### 339. Titles.

In general the title of an individual book does not function as a trade mark<sup>1</sup>, and it would therefore seem doubtful whether such a title can be protected by an action for passing off, quite apart from the difficulty that it is commonplace for two or more books to be published with the same or similar titles. In principle the title of an individual play or film stands in the same position. Nevertheless there is some authority suggesting that a distinctive title can be protected<sup>2</sup>.

Periodicals and other serials, including books published in successive editions, sequels and radio and television programmes, stand in a different position. It is clear that in principle the title of periodicals and serials may be protected<sup>3</sup>, but often such claims fail because the title is descriptive and small differences in the title and/or other differences in the publication suffice to distinguish it<sup>4</sup>.

In addition, the author of a book or play may have a remedy for the passing off of a film or the like as an adaptation of his book or play if that is not the case<sup>5</sup>.

1 *SCIENCE AND HEALTH Trade Mark*[1968] RPC 402. See also *Games Workshop Ltd v Transworld Publishers Ltd*[1993] FSR 705, CA.

2 *Mathieson v Sir Isaac Pitman & Sons Ltd* (1930) 47 RPC 541 (claim in respect of 'How to Appeal against Your Rates' failed because it was descriptive and had not acquired a secondary meaning); *WH Allen & Co v Brown Watson*[1965] RPC 191 (passing off expurgated edition of book as unexpurgated edition); *Hexagon Pty Ltd v Australian Broadcasting Commission*[1976] RPC 628, NSW SC. See also *20<sup>th</sup> Century Fox Film Corp v Gala Film Distributors Ltd*[1957] RPC 105.

3 See eg *Walter v Emmott* (1885) 54 LJ Ch 1059, CA; *Reed v O'Meara* (1904) 21 LR Ir 216; *Blacklock v Bradshaw* (1926) 43 RPC 97; *Morgan-Grampian plc v Training Personnel Ltd* [1992] FSR 267; *Games Workshop Ltd v Transworld Publishers Ltd* [1993] FSR 705, CA; *Associated Newspapers Ltd v Express Newspapers*[2003] EWHC 1322 (Ch), [2003] FSR 909; *Local Sunday Newspapers Ltd v Johnstone Press plc*[2001] All ER (D) 183 (Jun). See also *Marcus Publishing plc v Hutton-Wild Communications Ltd*[1990] RPC 576, CA.

4 See eg *Borthwick v The Evening Post*(1888) 37 ChD 449, CA; *George Outram & Co Ltd v London Evening Newspapers Co* (1911) 28 RPC 308; *Ridgway Co v Amalgamated Press Ltd* (1912) 29 RPC 130; *Stevens v Cassell* (1913) 30 RPC 199; *The Ridgway Co v Hutchinson* (1923) 40 RPC 335; *Rubber & Technical Press Ltd v Maclaren & Sons Ltd*[1961] RPC 264; *Baylis & Co (Maidenhead Advertiser) Ltd v Darlenko Ltd* [1974] FSR 284; *DC Thomson & Co Ltd v Kent Messenger Ltd*[1975] RPC 191; *Morning Star Co-operative Society Ltd v Express Newspapers Ltd* [1979] FSR 113; *Newsweek Inc v BBC*[1979] RPC 441, CA; *World Athletics and Sporting Publications Ltd v ACM Webb (Publishing) Co Ltd* [1981] FSR 27, CA; *Advance Magazine Publishing Inc v Redwood Publishing Ltd* [1993] FSR 449; *County Sound plc v Ocean Sound Ltd* [1991] FSR 367, CA; *Tamworth Herald Co Ltd v Thomson Free Newspapers Ltd* [1991] FSR 337.

5 *Raleigh v Kinematograph Trading Co Ltd* (1914) 31 RPC 143; *Samuelson v Producers Distributing Co Ltd*[1932] 1 Ch 201, CA; cf *Houghton v Film Booking* (1931) 48 RPC 329; *Loew's Inc v Littler* (1955) 72 RPC 166.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(iv) Personality and Character Merchandising/340. Merchandising and passing off.

#### **(iv) Personality and Character Merchandising**

##### **340. Merchandising and passing off.**

'Merchandising' is the practice which has been growing very common over recent years of licensing the use of a name or mark, or of the representation or attributes of a real or fictional person or character, in connection with goods or services. In certain circumstances the law of passing off will restrain the unauthorised use by third persons of such names, marks, representations or other attributes<sup>1</sup>.

Where a trade mark or trade name is licensed to licensees or franchisees, rather than used directly by the owner of the mark or name, then, provided that the licensor exercises sufficient control over, or otherwise maintains sufficient connection with, the goods or services so as to make the use of the name or mark distinctive of him, he can generally restrain the unauthorised use of the name or mark in the same way as if he had built up the goodwill and reputation attached to the mark by his own trade rather than through licensees<sup>2</sup>.

It is more difficult to prevent the use of a name or mark in relation to goods or services which the owner of the name or mark has not yet marketed, whether directly or through licensees<sup>3</sup>. In such circumstances, the claimant must first establish that, notwithstanding the difference between the fields of activity in which the claimant and the defendant are engaged, the public will assume a connection with the claimant and accordingly the use of the name or mark will be a misrepresentation<sup>4</sup>, and secondly that the misrepresentation creates a real and tangible risk of damage to the claimant<sup>5</sup>. Where the name is an individual's name and the defendant has expressly or implicitly represented<sup>6</sup> that the individual has licensed or endorsed the goods or services, it may be easier to succeed where the goods or services are in some way associated with the capacity in which the individual has become famous, so that the public can be expected to rely on his skill and judgment<sup>7</sup>, than when the individual's professional capacities or attributes are totally unconnected with the goods or services concerned<sup>8</sup>.

1 Other rights which are potentially applicable are those as to registered trade marks (see PARA 55 et seq ante), and, especially where representations of fictional characters are concerned, copyright: see *King Features Syndicate Inc v O and M Kleeman Ltd* [1941] AC 417, [1941] 2 All ER 403, 58 RPC 207, HL; and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARAS 316-317.

2 *JH Coles Pty Ltd v Need* [1934] AC 82, 50 RPC 379, PC. As to licensing generally see PARA 316 ante.

3 The use of trade marks which are famous as applied to one kind of goods, particularly luxury goods, to promote the sale of unrelated goods is increasingly common: see eg *Alfred Dunhill Ltd v Sunoptic SA* [1979] FSR 337, CA (where a mark originally used for pipes and tobacco was applied to jewellery, leather goods, watches, glassware and other diverse goods). See also *News Group Newspapers Ltd v Rocket Record Co Ltd* [1981] FSR 89 (where newspaper publishers marketed a range of goods under the mark 'Page 3' and were able to restrain the release by the defendants of a single record entitled 'Page Three').

4 As to a common field of activity and the likelihood of deception see PARA 328 ante.

5 As to the requirement of damage see PARA 334 ante.

6 The mere use of an individual's name or likeness does not necessarily imply that he has authorised the goods or services concerned: *Lyngstad v Anabas Products Ltd* [1977] FSR 62 (badges depicting popular musicians); cf *Elvis Presley Trade Marks* [1999] RPC 567, CA (memorabilia depicting deceased popular musician).

7 See *Henderson v Radio Corp'n Pty Ltd*[1969] RPC 218 at 236, 244 (where a photograph of ballroom dancers was placed on a record sleeve in such a way as to suggest that they had endorsed or recommended the music); *Irvine v TalkSport Ltd*[2002] EWHC 367 (Ch), [2002] 2 All ER 414, [2002] EMLR 679 (affd [2003] EWCA Civ 423, [2003] 2 All ER 881) (where advertisement contained doctored photograph of claimant racing driver suggesting that he was listening to defendant radio station and thus endorsing it).

8 *McCulloch v Lewis A May (Produce Distributors) Ltd*[1947] 2 All ER 845, 65 RPC 58 (where breakfast cereal was sold under the name of a well known children's broadcaster but it was held that there was no likelihood of damage to the plaintiff in his profession); but the requirement for a common field of activity laid down in this case has been disapproved by the Court of Appeal (see PARA 328 ante). It would appear that where the claimant has a reputation for endorsing goods and services, or if his celebrity is such that members of the public would think that he was endorsing the defendant's product or service despite its nature, a claim may lie in respect of goods or services fairly remote from his own field: *Irvine v TalkSport Ltd*[2002] EWHC 367 (Ch), [2002] 2 All ER 414, [2002] EMLR 679; affd [2003] EWCA Civ 423, [2003] 2 All ER 881.

In very special circumstances unauthorised representation of endorsement by an individual may give rise to an action for defamation: see *Tolley v JS Fry & Sons Ltd*[1931] AC 333, HL (where a caricature of an amateur golfer used as an advertisement was held capable of implying that the golfer had prostituted his amateur status by taking money for endorsing chocolate). See also LIBEL AND SLANDER vol 28 (Reissue) PARAS 11-12.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(iv) Personality and Character Merchandising/341. Fictional characters from books, films and television series.

### **341. Fictional characters from books, films and television series.**

To restrain a defendant from making use of the names, likenesses or other incidents of fictional characters or stories<sup>1</sup>, a series of propositions must be established.

First, it must be shown that the public will assume from the way in which reference is made to the character or story that the defendant's goods or services are connected with or licensed by the claimant<sup>2</sup>. This is more difficult to establish if the use of the character or story is of inherent value to the goods or services marketed, so that members of the public buy the goods or services for their own sake and not because the use of the character or story implies a connection with the claimant<sup>3</sup>. It has been argued that the practice of licensing the use of characters and other matter from films and television productions has become so widespread that the public will now assume that licensing has taken place<sup>4</sup>.

Secondly, the assumption on the part of the public that the claimant is connected with the defendant's goods or services must arise from a misrepresentation made by the defendant, and, if the defendant has merely adopted features of the claimant's character or story which have intrinsic value in relation to the intended use of the goods or services concerned, it may be more difficult to attribute the assumptions made by the public to any misrepresentation on the part of the defendant<sup>5</sup>.

Thirdly, the claimant must establish that the misrepresentation is material and a mere supposition on the part of the public that the claimant is receiving a licence fee without any reliance on the reputation of the claimant as a guarantee of the quality or origin of the goods concerned may not be sufficient<sup>6</sup>.

Fourthly, the claimant must establish the likelihood of damage to his business or goodwill as a result of the defendant's misrepresentation<sup>7</sup>. Even if the likelihood of long-term damage can be established such as would justify the grant of a permanent injunction at the trial, a claimant may have difficulty in obtaining an interim injunction if he is engaged in a licensing operation and his damage pending trial can be adequately compensated by money damages<sup>8</sup>.

1 As to the practice of merchandising see PARA 340 ante.

2 *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665. See also *Conan Doyle v London Mystery Magazine Ltd* (1949) 66 RPC 312 (where references to Sherlock Holmes and the use of his fictitious address by a magazine did not imply a connection with the author of the Sherlock Holmes detective stories); *Wombles Ltd v Wombles Skips Ltd* [1977] RPC 99 (where a skip company adopted the name of mythical creatures inhabiting Wimbledon Common); *Grundy Television Pty Ltd v Startrain Ltd* [1988] FSR 581 ('Neighbours') (where publication of a magazine about characters in the claimant's fictional television series did not imply a representation that the magazine was an official publication by the producers of the television series). The use of a fictional character may, however, be capable of implying a connection: see *Shaw Bros (Hong Kong) Ltd v Golden Harvest (UK) Ltd* [1972] RPC 559 (Hong Kong) ('One Armed Swordsman'); *Hexagon Pty Ltd v Australian Broadcasting Commission* [1976] RPC 628 ('Alvin Purple').

3 See *Lyngstad v Anabas Products Ltd* [1977] FSR 62 at 68 ('ABBA') (where it was held that badges depicting popular musicians satisfied a popular demand among teenagers for effigies of their idols and did not imply that the musicians had authorised them); and cf *Elvis Presley Trade Marks* [1999] RPC 567, CA.

4 This was not established by the plaintiffs in *Lyngstad v Anabas Products Ltd* [1977] FSR 62; *Tavener Rutledge Ltd v Trexapalm Ltd* [1977] RPC 275 ('Kojakpops'); or *Lorimar Productions Inc v Sterling Clothing Manufacturers Ltd* [1982] RPC 395, SA SC. The assumption was held arguable in *IPC Magazines Ltd v Black and White Music Corp* [1983] FSR 348 ('Judge Dredd') (interlocutory injunction refused). It was successfully argued

in *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145 ('Ninja Turtles') (interlocutory injunction granted).

5 See *JB Williams Co v H Bronnley & Co Ltd* (1909) 26 RPC 765 at 773, CA, per Fletcher-Moulton LJ; and PARA 324 ante. Cf *Children's Television Workshop Inc v Woolworths (NSW) Ltd* [1981] RPC 187, NSW SC ('Muppets'). See also *Tarzan Trade Mark* [1970] RPC 450, CA (where an application to register 'Tarzan' in respect of games, clothes and playthings was refused on the grounds that it had direct reference to the character and quality of goods which portrayed or related to the well known fictional character).

6 *Tavener Rutledge Ltd v Trexapalm Ltd* [1977] RPC 275 at 280-281 per Walton J ('Kojakpops'). See also PARA 322 ante. A dictum in *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145 at 159 ('Ninja Turtles'), that there is no requirement that the public should rely on the defendant's misrepresentation, is difficult to reconcile with *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873 at 889, [1990] 1 WLR 491 at 510, [1990] RPC 341 at 417, HL, per Lord Jauncey of Tullichettle ('Jif Lemon') and with *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 at 712-713, CA, per Millet LJ. See also *Hodgkinson and Corby Ltd v Wards Mobility Services Ltd* [1994] 1 WLR 1564, [1995] FSR 169.

7 See PARA 334 ante.

8 *IPC Magazines Ltd v Black & White Music Corp* [1983] FSR 348.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(v) Internet Domain Names/342. 'Cybersquatting'; domain name as an instrument of fraud.

## (v) Internet Domain Names

### 342. 'Cybersquatting'; domain name as an instrument of fraud.

A recent problem thrown up by the widespread use of the internet<sup>1</sup> is the registration of domain names comprising famous names and marks of others, a practice referred to in the press as 'cybersquatting'<sup>2</sup>. Historically, the courts have had little hesitation in restraining the registration of company names comprising famous names and marks<sup>3</sup>, and a similar approach is adopted with respect to domain names.

The principle underlying the courts' intervention in cases of alleged cybersquatting is the jurisdiction to grant injunctive relief where a defendant is equipped with or intending to equip another with an instrument of deception<sup>4</sup>. Where the domain name is of such a nature that any use of it is bound to lead to passing off<sup>5</sup>, the court will conclude that it is an instrument of deception<sup>6</sup>. A domain name will also be considered an instrument of deception if considering all the circumstances, including the intention of the defendant<sup>7</sup>, the similarity of the names and the type of trade, the domain name is likely to be used for passing off<sup>8</sup>.

1 For a description of the features of the internet relevant to an action for passing off see *Pitman Training Ltd v Nominet UK* [1997] FSR 797 at 799-800 per Scott V-C; *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476 at 480-481, [1999] FSR 1 at 5-7, CA, per Aldous LJ.

2 Care has to be taken to distinguish behaviour of this sort from perfectly legitimate uses of domain names. Thus an individual cannot be prevented from registering a domain name comprising his surname, and setting up a website thereunder, simply because his name is also the name of a famous supermarket: see *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476 at 497, [1999] FSR 1 at 23, CA, per Aldous LJ. Similarly, a website whose subject matter is a famous person (eg the website of a fan club), for example, might legitimately use that name in its domain name. Of course, the courts are astute to examine any such excuse carefully. See also PRESS, PRINTING AND PUBLISHING vol 36(2) (Reissue) PARA 416.

3 See *SA des Anciens Etablissements Panhard and Levassor v Panhard Levassor Motor Co Ltd* [1901] 2 Ch 513, 18 RPC 405; *Glaxo plc v Glaxowellcome Ltd* [1996] FSR 388; *Direct Line Group Ltd v Direct Line Estate Agency* [1997] FSR 374 ('this is not a way of conducting business which the court will tolerate' per Laddie J).

4 See PARA 331 ante.

5 Eg because it comprises an invented word or other mark which could only be taken as the claimant's trade mark, such as 'Marks & Spencer'.

6 *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476 at 493, 497, [1999] FSR 1 at 18, 23, CA, per Aldous LJ; *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244, [2007] RPC 83; *Tesco Stores Ltd v Elogicom Ltd* [2006] EWHC 403 (Ch), [2007] FSR 83.

7 If the defendant's intention is to appropriate the goodwill of the claimant or enable others to do so, the court will infer that this will happen even if there is a possibility that such goodwill will not be appropriated: *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476 at 493, [1999] FSR 1 at 18, CA, per Aldous LJ.

8 *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476, [1999] FSR 1, CA; *Musical Fidelity Ltd v Vickers (t/a Vickers Hi-Fi)* [2002] EWCA Civ 1989, [2003] FSR 898. If the domain name is plainly capable of innocent use the position is different: see eg *Radio Taxicabs (London) Ltd v Owner Drivers Radio Taxi Services Ltd* [2004] RPC 351. Of course, if a website is set up under the domain name, the website will be treated as any other publication and the law of passing off applied to it in the usual way: see eg *easyJet Airline Co Ltd v Dainty* [2002] FSR 111.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(2) PARTICULAR CASES OF PASSING OFF/(v) Internet Domain Names/343. Registration of domain name in a publicly accessible register.

### **343. Registration of domain name in a publicly accessible register.**

The registration of a domain name, including the identity of the registrant, exists in a register maintained by the person with whom the domain name was registered, and which is accessible by the public<sup>1</sup>. It has been held that the putting of a distinctive name on such a register makes a representation to persons who consult the register that the registrant is connected or associated with the name registered and thus the owner of the goodwill in the name<sup>2</sup>; and it causes damage to the claimant by the erosion of goodwill in that name<sup>3</sup>. It follows that mere registration of such a domain name can amount to passing off<sup>4</sup>.

<sup>1</sup> See *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476 at 496-497, [1999] FSR 1 at 22-23, CA, per Aldous LJ. See also PRESS, PRINTING AND PUBLISHING vol 36(2) (Reissue) PARA 416.

<sup>2</sup> *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476, [1999] FSR 1, CA.

<sup>3</sup> *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476 at 497, [1999] FSR 1 at 23, CA, per Aldous LJ; cf *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75, [1993] FSR 641, CA.

<sup>4</sup> There may be some factual points that still need to be worked out. The Court of Appeal in *British Telecommunications plc v One in a Million Ltd* [1998] 4 All ER 476, [1999] FSR 1, CA, did not consider fully the circumstances under which a person might consult such a register. It may be that in some cases such a misrepresentation would not be sufficiently material to found an action in passing off: see PARA 322 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(3) SPECIAL DEFENCES/(i) Use of Trader's Own Name/344. Use by an individual of his own name.

### **(3) SPECIAL DEFENCES**

#### **(i) Use of Trader's Own Name**

##### **344. Use by an individual of his own name.**

An individual has certain rights to make use of his own name in the course of trade where the use of that name by another person would amount to passing off<sup>1</sup>. The original justification for this rule was that, as regards passing off at common law where fraudulent intent was a necessary ingredient of the cause of action<sup>2</sup>, the legitimate use by a trader of his own name would not, without more, give rise to the inference of fraudulent intent which would be inferred from the use of that name by a third person who had no legitimate reason for using it<sup>3</sup>. As regards the action in equity, even though the defendant's use of his own name gave rise to misapprehension among the claimant's customers and caused injury to the claimant, there was no equity to restrain the defendant from making a statement of fact, namely that the business was carried on by a person with that name, made honestly in the usual manner in which such statements are made in the course of business and which the defendant had a legitimate interest in making<sup>4</sup>.

More recently the appellate courts have adopted a more restrictive attitude to the right of a trader to use his own name<sup>5</sup>, and the precise extent of the right is now not altogether clear<sup>6</sup>. This more restrictive approach may owe much to the fact that under modern trading conditions it is less essential than it used to be for a trader to use his personal name in carrying on a business<sup>7</sup>.

Whatever the exact scope of a trader's right to use his own name, it is clear that a fraudulent intent will vitiate the right, and there are numerous cases where unsuccessful attempts have been made to pass off by getting individuals with little or no real connection with a business to lend their name to it<sup>8</sup>. Similarly, the unwarranted garnishing of the defendant's name with labelling, style of script or get-up similar to the styles used by the claimant can amount to fraud and can be restrained<sup>9</sup>. Even in the absence of fraud, the writing of the defendant's name in an unclear way<sup>10</sup>, or the abbreviating of his name<sup>11</sup> in such a way as to increase the risk of deception, may be restrained, although there is some authority for the proposition that a trader using his own name is not under a positive obligation to take extra precautions to distinguish himself from his established rival<sup>12</sup>.

The right of an individual to use his own name extends also to the adoption of a firm name which fairly describes the individuals making up the partnership<sup>13</sup>. The right also extends to assumed names which have been acquired by reputation<sup>14</sup> and to a name which has become familiar to the public as the defendant's fancy name<sup>15</sup>, but not to the adoption as a trading style of a mere personal nickname<sup>16</sup>.

The balance of authority favours the proposition that, whatever the nature and scope of the right of an individual to use his name as a trading name, it does not extend to a right to mark his goods if deception is thereby caused<sup>17</sup>.

1 As to the scope of the action for passing off, and the meaning of 'trader', see PARA 310 ante.

2 As to the history of the action for passing off see PARA 305 ante.



3 See *Burgess v Burgess* (1853) 3 De GM & G 896 at 905 per Turner LJ.

4 *Turton v Turton*(1889) 42 ChD 128 at 147, CA, per Fry LJ.

5 *Parker-Knoll Ltd v Knoll International Ltd*[1962] RPC 265, HL, where the majority of the House of Lords (Lord Morris of Borth-y-Gest at 279, Lord Hodson at 283, and Lord Guest at 287 agreeing with Lord Hodson) adopted the test that, if the plaintiff's name or mark is proved to have acquired a secondary meaning, so as to denote goods made by a particular person and not goods made by any other person even though such other person may have the same name, then a person may, even by using his own name innocently, be making a representation which is untrue and which may be restrained by an action for passing off. See also *John Brinsmead & Sons Ltd v Brinsmead* (1913) 30 RPC 493 at 507-509, CA, per Buckley LJ; *Baume & Co Ltd v AH Moore Ltd*[1958] Ch 907, [1958] 2 All ER 113, [1958] RPC 226, CA.

6 If, as some of the judgments in the cases cited in note 5 supra suggest, a trader can only make use of his own name if to do so will not lead to deception, it is difficult to see what advantage is given by the law to a trader using his own name over a person adopting it arbitrarily. However, in *Parker-Knoll Ltd v Knoll International Ltd*[1962] RPC 265, HL, the majority of the House of Lords approved an injunction containing a proviso that the restraint was not to interfere with any use in good faith by the defendants of their full name, implying that some use could legitimately be made of the name but not making clear what use. In *Marengo v Daily Sketch and Sunday Graphic Ltd* (1948) 65 RPC 242 at 251, HL, Lord Simonds considered that a person may carry on business honestly under his own name notwithstanding that confusion arises. In *Reed Executive plc v Reed Business Information Ltd*[2004] EWCA Civ 159 at [111], [2004] RPC 767 at [111], [2004] IP & T 1049 at [111] and in *IN Newman Ltd v Adlem*[2005] EWCA Civ 714 at [46]-[47], [2006] FSR 253 at [46]-[47], Jacob LJ held that there was a defence if use of the name only caused non-damaging confusion but that there was passing off if a substantial number of people were misled. See also *Taylor Bros Ltd v Taylors Group Ltd* [1988] 2 NZLR 1, NZ HC (to the same effect).

7 See *Parker-Knoll Ltd v Knoll International Ltd*[1962] RPC 265 at 289, HL, per Lord Devlin, who considered it no grave hardship for a trader to pick another name if he enters a market in which his surname has already been appropriated by another trader. The attitude of the courts may be less restrictive in fields, eg the professions, where it is still usual for individuals to trade under their own names: see eg *Parker & Son (Reading) Ltd v Parker*[1965] RPC 323 at 326 per Plowman J (estate agents). See also the judgment of Didcott J in *Boswell-Wilkie Circus (Pty) Ltd v Brian Boswell Circus (Pty) Ltd* [1985] FSR 434, SA SC (which extensively reviews the progressive narrowing in English and Commonwealth authorities of the extent of the right of a trade to use his own name); affd on appeal [1986] FSR 479, SA SC.

8 *Croft v Day* (1843) 7 Beav 84; *Southorn v Reynolds* (1865) 12 LT 75; *Massam v Thorley's Cattle Food Co* (1880) 14 ChD 748, CA; *Joseph Rodgers & Sons Ltd v WN Rodgers & Co* (1924) 41 RPC 277; *Alfred Dunhill Ltd v Sunoptic SA* [1979] FSR 337, CA. A number of cases involve attempts by a scion of a famous family to cash in on the family name: *Alfred Dunhill Ltd v Sunoptic SA* supra; *Guccio Gucci SpA v Gucci* [1991] FSR 89; *Asprey & Garrard Ltd v WRA (Guns) Ltd*[2001] EWCA Civ 1499, [2002] FSR 477. See also PARA 330 ante.

9 *Croft v Day* (1843) 7 Beav 84 at 89; *J Lyons & Co Ltd v Lyons* (1931) 49 RPC 188; *Parker & Son (Reading) Ltd v Parker*[1965] RPC 323.

10 *Marengo v Daily Sketch and Sunday Graphic Ltd*[1948] 1 All ER 406, 65 RPC 242, HL (where in passing off involving cartoonists 'Kim' and 'Kem', the 'i' of 'Kim' was written in such a way that it could be mistaken for an 'e').

11 *Wright, Layman and Umney Ltd v Wright* (1949) 66 RPC 149, CA; *Taylor Bros Ltd v Taylors Group Ltd* [1988] 2 NZLR 1, NZ HC.

12 *Jamieson & Co v Jamieson* (1898) 15 RPC 169 at 183, CA, per Lindley MR. It is doubtful how far this would now be followed in view of the more restrictive attitude of the courts. See also *Wright, Layman and Umney Ltd v Wright* (1949) 66 RPC 149, CA (where a qualified injunction was granted restraining the defendant from using the name 'Wright' or 'Wrights' without clearly distinguishing his goods from those of the plaintiff).

13 *Turton v Turton*(1889) 42 ChD 128, CA (where Thomas Turton & Sons Ltd sued in respect of confusion caused when the first defendant, on taking his two sons into partnership, changed the firm name from John Turton & Co to John Turton & Sons); cf *Joseph Rodgers & Sons Ltd v WN Rodgers & Co* (1924) 41 RPC 277 (where a man called Muller took a young man called WN Rodgers into partnership and adopted the firm name 'WN Rodgers & Co' for the purpose of trading on the plaintiff's reputation; passages in the judgment which suggest that the right of a trader to use his name is restricted to the use of his full forenames and surname must be read subject to *Turton v Turton* supra).

14 *Jay's Ltd v Jacob*[1933] Ch 411, 50 RPC 132.

15 *Marengo v Daily Sketch and Daily Graphic Ltd* (1946) [1992] FSR 1, CA; revsd on the facts sub nom *Marengo v Daily Sketch and Sunday Graphic Ltd*[1948] 1 All ER 406, 65 RPC 242, HL.

16 *Biba Group Ltd v Biba Boutique*[1980] RPC 413; *NAD Electronics Ltd v NAD Computer Systems Ltd* [1997] FSR 380.

17 The distinction was first drawn in *Joseph Rodgers & Sons Ltd v WN Rodgers & Co* (1924) 41 RPC 277 at 292 per Romer J, and, although inconsistent with previous authority (see *Burgess v Burgess* (1853) 3 De GM & G 896, CA; *Jamieson & Co v Jamieson* (1898) 15 RPC 169, CA; *John Brinsmead & Sons Ltd v Brinsmead* (1913) 30 RPC 493, CA, all of which involved marking the defendant's name on goods), was subsequently approved in *Baume & Co Ltd v AH Moore Ltd*[1958] Ch 907 at 916, [1958] 2 All ER 113 at 116, [1958] RPC 266 at 268, CA, per Romer LJ. In *Parker-Knoll Ltd v Knoll International Ltd*[1962] RPC 265, HL, the distinction was approved by Lord Morris of Borth-y-Gest at 279, by Lord Hodson at 284 and by Lord Guest (concurring) at 287, but was criticised as illogical by Lord Denning (dissenting) at 277. See also *Marengo v Daily Sketch and Sunday Graphic Ltd* (1948) 65 RPC 242, HL, which was treated as a case of use of trading name, rather than of application of a mark to goods, even though the signature complained of was applied to copies of cartoons circulated in a newspaper. In *Reed Executive plc v Reed Business Information Ltd*[2004] EWCA Civ 159 at [110]-[112], [2004] RPC 767 at [110]-[112], [2004] IP & T 1049 at [110]-[112] per Jacob LJ, the distinction was treated as settled law; but it was held that there was passing off if a substantial number of people were misled even in the case of use of the name as the name of the business.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(3) SPECIAL DEFENCES/(i) Use of Trader's Own Name/345. Use by corporation of its own name.

### **345. Use by corporation of its own name.**

On coming into existence a corporation has its name chosen by its promoters, and it does not have the same natural right to use its name as an individual has<sup>1</sup>, but an established company may have such a right even when it enters a market in which it has not previously traded<sup>2</sup>. A newly-formed company may in general take the name under which the business which it is formed to take over has previously been lawfully carried on, but an individual who has no existing business or goodwill to transfer cannot confer upon a new company a special right to use his name<sup>3</sup>.

1 *Hendriks v Montagu* (1881) 17 ChD 638. See also *Turton v Turton* (1889) 42 ChD 128 at 146, 148, CA; *Fine Cotton Spinners and Doublers' Association Ltd and John Cash & Sons Ltd v Harwood Cash & Co Ltd* [1907] 2 Ch 184 at 190, 24 RPC 533 at 538 per Joyce J; *Asprey & Garrard Ltd v WRA (Guns) Ltd* [2001] EWCA Civ 1499, [2002] FSR 477. As to the use by an individual of his own name see PARA 344 ante.

2 *Saunders v Sun Life Assurance Co of Canada* [1894] 1 Ch 537; cf *Adrema Ltd v Adrema-Werke GmbH and BEM Business Efficiency Machines Ltd* [1958] RPC 323; but see *Taylor Bros Ltd v Taylors Group Ltd* [1988] 2 NZLR 1, NZ HC.

3 *Massam v Thorley's Cattle Food Co* (1880) 14 ChD 748, CA; *Tussaud v Tussaud* (1890) 44 ChD 678; *Fine Cotton Spinners and Doublers' Association Ltd and John Cash & Sons Ltd v Harwood Cash & Co Ltd* [1907] 2 Ch 184, 24 RPC 533; *Kingston, Miller & Co Ltd v Thomas Kingston & Co Ltd* [1912] 1 Ch 575, 29 RPC 289.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(3) SPECIAL DEFENCES/(ii) Concurrent Rights/346. Concurrent use and shared reputation.

## (ii) Concurrent Rights

### 346. Concurrent use and shared reputation.

In certain circumstances two or more traders may acquire independent rights to carry on trade side by side using the same or similar names or marks, when the use of such names or marks by a third person without any such special right would undoubtedly constitute passing off<sup>1</sup>. These rights are to be distinguished from cases where descriptive<sup>2</sup> or fancy terms are common to the trade as a whole so that any new entrant is entitled to make use of them provided that he does so fairly<sup>3</sup>. Concurrent rights to use proprietary, as opposed to descriptive, names or marks can arise by division between different persons of the goodwill of a business which was initially a single business<sup>4</sup>, by attainment of independence by a subsidiary or associated company from its group<sup>5</sup>, by natural expansion of businesses using marks of independent origin into areas in which they come into conflict<sup>6</sup>, or by continuing use by small local users in good faith after a mark has become generally identified with the products of a particular large manufacturer<sup>7</sup>. A claimant's acquiescence in a defendant's use of a name or mark can result in the defendant's acquiring goodwill of his own in the name or mark so that it becomes unconscionable to allow the claimant to bar the defendant's continued use of that name or mark in an action for passing off<sup>8</sup>.

Neither party with a concurrent right to use a name or mark can prevent the other from continuing to use it<sup>9</sup> but the vested right of property of traders in marks which they have honestly adopted and which by public use have attracted valuable goodwill must be accommodated with the interest of the public in not being deceived about the origin of goods<sup>10</sup>. A concurrent right of use does not, however, justify the use, whether intentionally or not, of a name or mark with attributes which increase the risk of confusion<sup>11</sup>.

Another source of concurrent rights of use can arise from the rules of the European Community as to free movement of goods and as to competition<sup>12</sup>.

1 Each of the traders may sue a third person without the concurrence of the other if his own business will suffer some damage as a result of the third person's passing off: see PARA 311 ante.

2 Eg the term 'advocaat': see *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731, [1979] 2 All ER 927, [1980] RPC 31, HL.

3 See PARA 319 ante.

4 *Dent v Turpin*, *Tucker v Turpin* (1861) 2 John & H 139; *Southorn v Reynolds* (1865) 12 LT 75. Concurrent rights can also arise where part of a business is compulsorily severed, eg by the wartime expropriation of the part of a business in one country giving rise to a concurrent right of the original owner and the owner of the expropriated business to use the marks in a third country: see *Ingenohl v Wing On & Co (Shanghai) Ltd* (1927) 44 RPC 343, PC.

5 *Habib Bank Ltd v Habib Bank AG Zurich* [1981] 2 All ER 650, [1981] 1 WLR 1265, [1982] RPC 1, CA; *Anderson & Lembke Ltd v Anderson & Lembke Inc* [1989] RPC 124.

6 *General Electric Co v General Electric Co Ltd* [1972] 2 All ER 507 at 519, [1972] 1 WLR 729 at 743, [1973] RPC 297 at 326, HL, per Lord Diplock; and see *City Link Travel Holdings Ltd v Lakin* [1979] FSR 653. See also *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [1984] FSR 413, CA, which might be regarded as such a case (and was at first instance by Whitford J) although the ground of decision in the Court of Appeal was that the plaintiff had no goodwill in the United Kingdom.

- 7 *Star Cycle Co Ltd v Frankenburgs* (1907) 24 RPC 405 at 414, CA, per Fletcher Moulton LJ.
- 8 *Habib Bank Ltd v Habib Bank AG Zurich*[1981] 2 All ER 650, [1981] 1 WLR 1265, [1982] RPC 1, CA; cf *Poiret v Jules Poiret Ltd* (1920) 37 RPC 177 (where it did not avail the defendants that they had carried on business for several years after the plaintiff had been called up to the war, as they had adopted his name fraudulently). See also *Byford v Oliver*[2003] EWHC 295 (Ch), [2003] EMLR 416.
- 9 *Edge & Sons Ltd v Gallon & Son* (1900) 17 RPC 557, HL; *Marengo v Daily Sketch and Daily Graphic Ltd* (1946) [1992] FSR 1 at 2, CA, per Lord Greene MR ('Confusion may result from the collision of two independent rights or liberties, and where that is the case neither party can complain; they must put up with the results of the confusion as one of the misfortunes which occur in life') (revsd on the facts sub nom *Marengo v Daily Sketch and Sunday Graphic Ltd*[1948] 1 All ER 406, 65 RPC 242, HL).
- 10 See *General Electric Co v General Electric Co Ltd*[1972] 2 All ER 507 at 519, [1972] 1 WLR 729 at 743, [1973] RPC 297 at 326, HL, per Lord Diplock.
- 11 *Marengo v Daily Sketch and Sunday Graphic Ltd*[1948] 1 All ER 406, 65 RPC 242, HL.
- 12 See the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') arts 28-30 (formerly arts 30-36; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)*[1999] All ER (EC) 646, EC)).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(3) SPECIAL DEFENCES/(iii) Parallel Imports/347. Parallel imports and passing off.

### **(iii) Parallel Imports**

#### **347. Parallel imports and passing off.**

'Parallel imports' means strictly the importation and sale by others of goods originating from the owner of industrial property rights in PARALLEL with his own importation of such goods, whether carried out by himself or through authorised agents<sup>1</sup>, but is used more generally to describe the importation and sale by third persons of goods obtained in another country which originate from an internationally known company or group irrespective of whether the company or group satisfies the market in the United Kingdom by imports from that country<sup>2</sup>.

The importation and sale in the United Kingdom of the claimant's goods bearing the marks under which the claimant has allowed them to be sold in a foreign country does not generally amount to passing off<sup>3</sup>, since no misrepresentation is involved as to the origin of the goods<sup>4</sup>. Attempts by a claimant to argue that the sale of goods bearing a manufacturer's mark impliedly represents that the goods have passed through the accustomed channels of supply have been rejected by the courts<sup>5</sup>, as has an attempt to sever and assign the goodwill of the business of importing the goods into the United Kingdom from the goodwill of the business carried on in the country of origin<sup>6</sup>. It generally makes no difference that the imported goods originate not from the same legal person who supplies the goods to the market in the United Kingdom but from another member of the same group of companies, since in modern trading conditions customers will usually neither know nor care which company within a group is responsible for manufacture or sale of the goods, the commercial origin of which is indicated by marks used by the group as a whole<sup>7</sup>. Even if the goodwill in the United Kingdom attached to the marks is owned by a particular member of the group so that the particular company is the appropriate claimant in an action against passing off by third persons, this does not permit the company to sue in respect of goods originating from another member of the same group if the element of misrepresentation is lacking<sup>8</sup>. It is probable that goods which are manufactured and to which the marks are applied under licence stand in the same position as goods actually made by a member of the group of companies<sup>9</sup>.

The importation and sale by the defendant of the claimant's goods of one quality not marketed by the claimant in the United Kingdom can amount to passing off those goods as goods of another quality sold by the claimant in the United Kingdom even where the defendant sells the goods in the packaging in which the claimant, or the claimant's associated or subsidiary company, marketed them in another country<sup>10</sup>.

Actionable passing off occurs when the importer alters the labelling on the foreign quality goods to the labelling used by the claimant for his goods of the quality sold on the English market<sup>11</sup>. If the labelling on the foreign goods is different from that on the English goods, it may be difficult for the claimant to establish that the public will assume them to be of the same quality<sup>12</sup>.

Where the goods are imported from another member state of the European Community or the European Economic Area ('EEA'), regard should also be had to the overriding effect of the rules of European Community law as to free movement of goods and competition<sup>13</sup>.

1 See eg *Imperial Tobacco Co of India Ltd v Bonnan*[1924] AC 755, 41 RPC 411, PC.

2 See eg *Revlon Inc v Cripps and Lee Ltd* [1980] FSR 85, CA.

- 3 As to the position with regard to registered trade marks see PARA 107 ante.
- 4 *Imperial Tobacco Co of India Ltd v Bonnan*[1924] AC 755, 41 RPC 441, PC.
- 5 *Dental Manufacturing Co Ltd v C De Trey & Co*[1912] 3 KB 76, 29 RPC 517, CA; *Imperial Tobacco Co of India Ltd v Bonnan*[1924] AC 755, 41 RPC 441, PC. Cf *Sony KK v Saray Electronics (London) Ltd* [1983] FSR 302, CA; *Seiko Time Canada Ltd v Consumers Distributing Co Ltd* (1980) 112 DLR (3d) 500.
- 6 *Lacteosote Ltd v Alberman*[1927] 2 Ch 117, 44 RPC 211.
- 7 *Revlon Inc v Cripps and Lee Ltd* [1980] FSR 85, CA.
- 8 *Imperial Tobacco Co of India Ltd v Bonnan*[1924] AC 755 at 763, 41 RPC 441 at 448, PC. See also *Habib Bank Ltd v Habib Bank AG Zurich*[1981] 2 All ER 650 at 661-662, [1981] 1 WLR 1265 at 1278-1279, [1982] RPC 1 at 30, CA, per Oliver LJ.
- 9 For consideration by a foreign court of the general principles involved see Case IZR 85/71 *Francesco Cinzano & Cie GmbH v Java Kaffeegeschäfte GmbH & Co* [1974] 2 CMLR 21, German SC.
- 10 *Colgate-Palmolive Ltd v Markwell Finance Ltd*[1989] RPC 497, CA (inferior Colgate toothpaste for the Brazilian market imported in the United Kingdom). See, however, *Revlon Inc v Cripps and Lee Ltd* [1980] FSR 85 at 112, CA, where Templeman LJ held that there could be no passing off when products manufactured, named, labelled and put into circulation by a member of the plaintiff's group of companies were sold by the defendants without any alteration to the contents, name or label.
- 11 *Champagne Heidsieck & Cie v Scotto and Bishop* (1926) 43 RPC 101.
- 12 See *Champagne Heidsieck & Cie Monopole SA v Buxton*[1930] 1 Ch 330, 47 RPC 28; *Revlon Inc v Cripps and Lee Ltd* [1980] FSR 85, CA.
- 13 As to registered trade marks see PARAS 102-106 ante. In general the same European Community law defences apply to passing off as apply to registered trade marks in respect of goods circulating within the EEA, even though the statutory 'exhaustion' defence does not apply; however, in relation to goods imported from outside the EEA the position under the law of passing off is radically different to registered trade marks: see PARA 107 ante. As to the EEA see PARA 102 note 6 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/4. PASSING OFF/(3) SPECIAL DEFENCES/(iv) Name, Mark or Trade of Claimant Fraudulent or Deceptive/348. Claimant disentitled to protection.

#### **(iv) Name, Mark or Trade of Claimant Fraudulent or Deceptive**

##### **348. Claimant disentitled to protection.**

A claimant may be disentitled to protection in an action for passing off if the trade which he carries on is as a whole fraudulent<sup>1</sup>, or if the name or mark which he seeks to protect is fraudulent or deceptive<sup>2</sup>, although the making of some collateral misrepresentations in the course of his trade which do not make the trade as a whole a fraud will not disentitle the claimant to relief<sup>3</sup>. The claimant may be guilty of deception as to the origin of goods if he allows goods with which he has no connection to be sold under his name or mark, but allowing this to happen without fraudulent intent for a time because of temporary difficulties need not disentitle him to protection<sup>4</sup>.

1 *Lee v Haley* (1869) 5 Ch App 155 at 159; *Bile Bean Manufacturing Co Ltd v Davidson* (1906) 22 RPC 553 (on appeal 23 RPC 725).

2 *Leather Cloth Co Ltd v American Leather Cloth Co Ltd* (1865) 11 HL Cas 523 at 542. As to the position relating to registered trade marks see PARA 101 ante.

3 *Ford v Foster* (1872) 7 Ch App 611 (false statements made in advertisements that the plaintiff's goods were patented). In *Sykes v Sykes* (1824) 3 B & C 541, the use of the word 'patent' in a trade mark where a patent had expired long ago was held unobjectionable, as it had become part of the description of the article.

4 *JH Coles Pty Ltd v Need* [1934] AC 82, 50 RPC 379, PC. The assignment or licensing of names or marks in gross may render them deceptive and incapable of protection: see PARAS 314, 316 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(1) INTRODUCTION/349. Jurisdiction of the registrar, of the Office for Harmonisation in the Internal Market and of the courts.

## **5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF**

### **(1) INTRODUCTION**

#### **349. Jurisdiction of the registrar, of the Office for Harmonisation in the Internal Market and of the courts.**

Applications to register a United Kingdom trade mark<sup>1</sup> or to protect an international trade mark in the United Kingdom<sup>2</sup>, and oppositions<sup>3</sup> to such applications, must be made to the registrar<sup>4</sup>. Applications to register Community trade marks<sup>5</sup>, and oppositions<sup>6</sup> to such applications, must be made to the Office for Harmonisation in the Internal Market (Trade Marks and Designs)<sup>7</sup>. The courts have no original jurisdiction to entertain such applications and oppositions.

In the Trade Marks Act 1994, unless the context otherwise requires, 'the court' means the High Court or a designated county court<sup>8</sup>. Proceedings for infringement of United Kingdom registered trade marks, protected international trade marks (UK) and Community trade marks may be brought in these courts<sup>9</sup>. The registrar has no jurisdiction over such proceedings.

In proceedings for revocation, for a declaration of invalidity or for rectification of United Kingdom registered trade marks or protected international trade marks (UK), the applicant may opt to make his application either to the registrar or to the court<sup>10</sup>. In proceedings for infringement of a Community trade mark, the defendant may counterclaim for revocation or a declaration of invalidity<sup>11</sup>. Otherwise revocation or a declaration of invalidity of a Community trade mark may only be sought in the Office for Harmonisation in the Internal Market<sup>12</sup>.

Proceedings for passing off<sup>13</sup> may be brought in the High Court<sup>14</sup> or, it would seem, a county court<sup>15</sup>. The registrar has no jurisdiction over passing off proceedings.

Where there are concurrent proceedings before the registrar and the court involving the same or similar issues, the registrar may stay the registry proceedings and, if he does not, the court may do so<sup>16</sup>.

All procedure in the Trade Marks Registry is governed by the Trade Marks Rules 2000<sup>17</sup>. The Civil Procedure Rules 1998 do not apply to proceedings in the Registry, but in so far as the registrar has a discretion it will generally be exercised in accordance with the overriding objective<sup>18</sup>. An appeal lies from any decision of the registrar under the Trade Marks Act 1994, including any act of the registrar in exercise of a discretion vested in him by or under that Act, except as otherwise expressly provided by rules<sup>19</sup>. In general, appeals from decisions of the registrar lie, at the option of the appellant, either to the High Court or to a person appointed by the Lord Chancellor<sup>20</sup>.

Appeals from decisions of the Office for Harmonisation in the Internal Market lie to the Court of First Instance and thence to the Court of Justice of the European Communities on a point of law<sup>21</sup>.

1 As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq post.

2 As to protected international trade marks (UK) see PARA 13 ante.

- 3 As to opposition proceedings see PARAS 384-386 post.
- 4 As to the registrar see PARA 17 ante; and as to proceedings in the Registry see PARA 352 et seq post.
- 5 For the meaning of 'Community trade mark' see PARA 206 ante.
- 6 As to oppositions to Community trade mark applications see PARA 282 ante.
- 7 As to the Office see PARA 180 et seq ante.
- 8 Trade Marks Act 1994 s 75(a) (amended by the High Court and County Courts Jurisdiction (Amendment) Order 2005, SI 2005/587, art 4(1), (2)). The county courts so designated are the Patents County Court and the county courts at Birmingham, Bristol, Cardiff, Leeds, Liverpool, Manchester and Newcastle upon Tyne: High Court and County Courts Jurisdiction Order 1991, SI 1991/724, art 2(7A), (7B) (added by SI 2005/587).
- 9 County Courts Act 1984 s 15(1) (amended by the High Court and County Courts Jurisdiction Order 1991, SI 1991/724, art 2(8)); High Court and County Courts Jurisdiction Order 1991, SI 1991/724, art 2(7A), (7B) (as added: see note 8 supra); Community Trade Marks Regulations 2006, SI 2006/1027, reg 12. Note that the High Court and County Courts Jurisdiction Order 1991, SI 1991/724, as amended, confers jurisdiction on designated county courts only to grant certain types of relief and to hear claims for invalidity, revocation and rectification, rather than to hear claims for infringement. It was held in *Minsterstone Ltd v Be Modern Ltd* [2002] FSR 807 that county courts already had such jurisdiction under the County Courts Act 1984 s 84 (presumably the intended reference was to s 15); but *Bow v Hart* [1905] 1 KB 592, 22 RPC 222, CA, which decided that there was no such jurisdiction under the County Courts Act 1886 s 56 (repealed), was not cited. High Court trade mark proceedings must be brought in the Chancery Division: *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 18.1(15), (16).
- 10 See the Trade Marks Act 1995 ss 46(4), 47(3), 64(2); and PARA 396 post.
- 11 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, arts 92(d), 96; and PARAS 251, 262 ante.
- 12 See *ibid* art 55; and 289 ante.
- 13 As to passing off see PARA 304 et seq ante.
- 14 High Court proceedings for passing off must be brought in the Chancery Division: *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 18.1(13).
- 15 In *Ideal General Supply Co Ltd v Louis Edelson and Bette Edelson (t/a the Ideal Clothing Co)* [1957] RPC 252 at 256, Diplock J reported without comment the view of a county court judge that he had no jurisdiction to entertain a claim for passing off. It would seem, however, that a claim for passing off is a tort claim within the County Courts Act 1984 s 15 (as amended) (see note 9 supra), and a claim for passing off was entertained by Plymouth County Court in *Pasterfield v Denham* [1999] FSR 168. The existence of this jurisdiction is recognised by CPR 63.13(3)(b), (c) and by *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 18.1(13).
- 16 *Sears plc v Sears Roebuck & Co* [1993] RPC 385; *Philips Electronics NV v Remington Consumer Products Ltd (No 2)* [1999] ETMR 835, [1999] All ER (D) 351; *GENIUS Trade Mark* [1999] RPC 741, Trade Mark Registry; *Jules Rimet Cup Ltd v Football Association Ltd* [2006] EWHC 2415 (Ch), [2006] All ER (D) 65 (Aug).
- 17 *Ie* the Trade Marks Rules 2000, SI 2000/136.
- 18 *Ie* under CPR 1.1: Tribunal Practice Notice (TPN 1/2000) [2000] RPC 587. Tribunal Practice Notices are available from the Patent Office or on its website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IP'): see the UK Intellectual Property Office Name Change Fact Sheet.
- 19 See the Trade Marks Act 1994 s 76(1); and PARA 405 post. The right of appeal so conferred is much wider than the right of appeal conferred by the Trade Marks Act 1938. As to the limitations on the right of appeal under the Trade Marks Act 1938 see *PREDATOR Trade Mark* [1982] RPC 387. Judicial review was formerly the only means of challenging a decision by the registrar in cases where no appeal was provided for by the Trade Marks Act 1938 or the rules made under it: see *Adidas Sarl's Trade Mark* [1983] RPC 262.
- 20 See PARA 405 et seq post.

21 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 63; and PARA 294 ante.

## **UPDATE**

### **349 Jurisdiction of the registrar, of the Office for Harmonisation in the Internal Market and of the courts**

NOTE 17--SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(1) INTRODUCTION/350. Trade marks for textile goods.

**350. Trade marks for textile goods.**

Under the Trade Marks Act 1938 a record ('the Manchester record') had to be kept at the Manchester branch of the Trade Marks Registry and in that record had to be entered copies of all entries in the general register relating to trade marks registered in respect of textile goods<sup>1</sup>. There is no requirement under the Trade Marks Act 1994 to maintain the Manchester record.

<sup>1</sup> See the Trade Marks Act 1938 s 39 (repealed).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(1) INTRODUCTION/351. Sheffield marks for metal goods.

### **351. Sheffield marks for metal goods.**

Under the Trade Marks Act 1938<sup>1</sup> a register had to be kept by the Cutlers' Company<sup>2</sup> at Sheffield in which were entered marks for metal goods, if the applicant carried on business in Hallamshire or within six miles of it. The Sheffield register formed part of the general register, and marks entered on it had also to be entered in London<sup>3</sup>. By virtue of the Trade Marks Act 1994 the Sheffield register is to be treated as part of the register kept under the Trade Marks Act 1938; and applications made to the Cutlers' Company which were pending on 31 October 1994 must proceed on and after that date as if they had been made to the registrar<sup>4</sup>.

1 See the Trade Marks Act 1938 s 30, Sch 2 (repealed).

2 'The Cutlers' Company' means the Master, Wardens, Searchers, Assistants and Commonalty of the Company of Cutlers in Hallamshire in the county of York: *ibid* s 38 (repealed). The company was incorporated in 1623 by 21 Jac 1 c 31 (Hallamshire Cutlers) (1623). The Lordship and Liberty of Hallamshire is one of the manors comprised in the old borough of Sheffield.

3 See the Trade Marks Act 1938 s 30, Sch 2 (repealed).

4 See the Trade Marks Act 1994 s 105, Sch 3 para 20; and PARA 19 note 2 ante. As to the registrar see PARA 17 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(i) In general/352. Business hours and business days.

## **(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK**

### **(i) In general**

#### **352. Business hours and business days.**

The registrar<sup>1</sup> may give directions specifying the hours of business of the Patent Office<sup>2</sup> for the purpose of the transaction by the public of business under the Trade Marks Act 1994 and the days which are business days for that purpose<sup>3</sup>. Any directions so given must be published<sup>4</sup> and posted in the Patent Office<sup>5</sup>. The registrar has accordingly directed that the Patent Office is open for all classes of business under the Act on Monday to Friday, between 10.00 am and 4.00 pm<sup>6</sup>. In addition, notices, applications and other documents may be filed<sup>7</sup> up to midnight on Monday to Friday<sup>8</sup>. Applications which do not claim priority<sup>9</sup> may also be filed on Saturdays between 10.00 am and 1.00 pm<sup>10</sup>. The Patent Office will not be open (for any of the above purposes) on Good Friday, Christmas Day, any bank holiday or any Saturday immediately preceded by one of these<sup>11</sup>.

Business done on any day after the specified hours of business, or on a day which is not a business day, is deemed to have been done on the next business day; and, where the time for doing anything under the Trade Marks Act 1994 expires on a day which is not a business day, that time is extended to the next business day<sup>12</sup>.

1 As to the registrar see PARA 17 ante.

2 As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'); see the UK Intellectual Property Office Name Change Fact Sheet.

3 Trade Marks Act 1994 s 80(1). Directions so given may make different provision for different classes of business and must be published in the prescribed manner: s 80(3).

4 For the meaning of 'publish' see PARA 17 note 10 ante.

5 Trade Marks Rules 2000, SI 2000/136, rr 2(1), 70.

6 Trade Marks Journal dated 31 October 1994. As to the Trade Marks Journal see PARA 17 ante.

7 For the meaning of references to 'filing' see PARA 25 note 2 ante; and as to the filing of documents by electronic means see PARA 354 post.

8 Trade Marks Journal dated 31 October 1994.

9 Ie under the Trade Marks Act 1994 s 35 (see PARA 378 post) or s 36 (see PARA 379 post).

10 Trade Marks Journal dated 31 October 1994.

11 Trade Marks Journal dated 31 October 1994.

12 Trade Marks Act 1994 s 80(2); Trade Marks Journal dated 31 October 1994.

### **UPDATE**

**352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

**352 Business hours and business days**

TEXT AND NOTES 4, 5--See now Trade Marks Rules 2008, SI 2008/1797, r 80.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(i) In general/353. Use of forms.

### **353. Use of forms.**

The registrar<sup>1</sup> may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark<sup>2</sup> or any other proceeding before him under the Trade Marks Act 1994<sup>3</sup>. Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before him<sup>4</sup> and any directions with respect to their use must be published<sup>5</sup> and any amendment or modification of a form or of the directions with respect to its use must be published<sup>6</sup>. A requirement to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form<sup>7</sup>. If the form used is not a replica, it must preserve the essential features of the prescribed form. The registrar cannot exempt anyone from the obligation to use an acceptable form as and when required by the Trade Marks Act 1994 and the Trade Marks Rules 2000<sup>8</sup>, but is able to decide whether departures from the prescribed forms are acceptable<sup>9</sup>.

1 As to the registrar see PARA 17 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 Trade Marks Act 1994 s 66(1). Any form required to be filed with the registrar in respect of any specified matter is subject to the payment of the fee, if any, prescribed in respect of that matter by rules made under s 79 (see PARA 16 ante): Trade Marks Rules 2000, SI 2000/136, r 4(2). For the meaning of references to 'filing' see PARA 25 note 2 ante; and as to the filing of documents by electronic means see PARA 354 post. As to fees see PARA 16 ante.

4 Ie pursuant to the Trade Marks Act 1994 s 66.

5 For the meaning of 'publish' see PARA 17 note 10 ante.

6 Trade Marks Act 1994 s 66(2); Trade Marks Rules 2000, SI 2000/136, r 3(1). The forms required to be used under the Trade Marks Act 1994 and the Trade Marks Rules 2000, SI 2000/136, are published in the Trade Marks Journal and on the website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk).

7 Trade Marks Rules 2000, SI 2000/136, r 3(2).

8 Ie the Trade Marks Rules 2000, SI 2000/136 (as amended).

9 *Re M's Application* [1985] RPC 249, CA; *KML Invest AB's Trade Mark Application* [2004] RPC 972, Appointed Person.

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **353 Use of forms**



TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 3, 4.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(i) In general/354. Filing of documents by electronic means and electronic communications.

### **354. Filing of documents by electronic means and electronic communications.**

The registrar<sup>1</sup> may, at his discretion, permit as an alternative to sending by post or delivery of the application, notice or other document in legible form the filing<sup>2</sup> of the application, notice or other document by electronic means subject to such terms or conditions as he may specify either generally by published<sup>3</sup> notice or in any particular case by written notice to the person desiring to file any such documents by such means<sup>4</sup>.

The delivery using electronic communications<sup>5</sup> to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address of his for the receipt of electronic communications<sup>6</sup>. Unless the contrary is provided such delivery is deemed to be effected immediately upon the transmission of the communication<sup>7</sup>.

1 As to the registrar see PARA 17 ante.

2 For the general meaning of references to 'filing' see PARA 25 note 2 ante.

3 For the meaning of 'publish' see PARA 17 note 10 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 69. It is now possible to file a trade mark application online via the Patent Office website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office': see the UK Intellectual Property Office Name Change Fact Sheet.

5 I.e. electronic communications within the meaning of the Electronic Communications Act 2000 (see TELECOMMUNICATIONS AND BROADCASTING vol 45(1) (2005 Reissue) PARA 616): Trade Marks Rules 2000, SI 2000/136, r 69A(2) (r 69A added by SI 2006/760).

6 Trade Marks Rules 2000, SI 2000/136, r 69A(1) (as added: see note 5 supra).

7 Ibid r 69A(1) (as added: see note 5 supra).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **354 Filing of documents by electronic means and electronic communications**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 78, 79.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(i) In general/355. Translations.

### **355. Translations.**

Where any document or part thereof which is in a language other than English is filed<sup>1</sup> or sent<sup>2</sup> to the registrar<sup>3</sup>, the registrar may require that there be furnished a translation into English of the document or that part, verified to the satisfaction of the registrar as corresponding to the original text<sup>4</sup>. The registrar may, however, refuse to accept any translation which is in his opinion inaccurate; and thereupon another translation of the document in question verified to the satisfaction of the registrar as corresponding to the original text must be furnished<sup>5</sup>.

1 For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

2 le in pursuance of the Trade Marks Act 1994 or the Trade Marks Rules 2000, SI 2000/136 (as amended). For the meaning of 'send' see PARA 25 note 14 ante.

3 As to the registrar see PARA 17 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 72(1).

5 Ibid r 72(2).

### **UPDATE**

#### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **355 Translations**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 82.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(i) In general/356. Calculation of times and periods; alteration of time limits.

### **356. Calculation of times and periods; alteration of time limits.**

The registrar<sup>1</sup> may certify any day as an interrupted day<sup>2</sup> where:

- 443 (1) there is an event or circumstance causing an interruption in the normal operation of the Patent Office<sup>3</sup>; or
- 444 (2) there is a general interruption or subsequent dislocation in the postal services of the United Kingdom<sup>4</sup>.

Any such certificate of the registrar must be posted in the Patent Office and advertised in the Trade Marks Journal<sup>5</sup>. Where the time for doing anything under the Trade Marks Rules 2000<sup>6</sup> expires on an interrupted day, the registrar must extend that time to the next following day not being an interrupted day (or an excluded day)<sup>7</sup>.

The registrar must extend any time limit in the Trade Marks Rules 2000 where he is satisfied that the failure to do something under those rules was wholly or mainly attributed to a delay in, or failure of, a communication service<sup>8</sup>. Any such extension is to be made after giving the parties such notice, and subject to such conditions, as the registrar may direct<sup>9</sup>.

Subject to a number of important exceptions<sup>10</sup>, the time or periods prescribed<sup>11</sup> or specified by the registrar for doing any act or taking any proceedings may, at the written request of the person or party concerned, or on the initiative of the registrar<sup>12</sup>, be extended by the registrar as he thinks fit, upon such terms as he may direct<sup>13</sup>. When a request for extension of a time or period prescribed by certain rules<sup>14</sup> is made, the party seeking the extension must send a copy of the request to each person party to the proceedings<sup>15</sup>. A request for an extension must be made before the time or period in question has expired<sup>16</sup>; but, where the request for extension is made after the time or period has expired, the registrar may, at his discretion, extend the period or time if he is satisfied with the explanation for the delay in requesting the extension and it appears to him to be just and equitable to do so<sup>17</sup>.

Where the period within which any party to any proceedings before the registrar may file evidence<sup>18</sup> is to begin upon the expiry of any period in which any other party may file evidence and that other party notifies the registrar that he does not wish to file any, or any further, evidence, the registrar may direct that the period within which the first-mentioned party may file evidence is to begin on such date as may be specified in the direction and must notify all parties to the dispute of that date<sup>19</sup>.

Provision is made for the correction of irregularities in procedure which consist in failure to comply with limitations of specified periods or times<sup>20</sup>.

1 As to the registrar see PARA 17 ante.

2 I.e. a day certified by the registrar under the Trade Marks Rules 2000, SI 2000/136, r 67(1): r 67(4) (r 67 substituted by SI 2006/760).

3 Trade Marks Rules 2000, SI 2000/136, r 67(1)(a) (as substituted: see note 2 supra). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

- 4 Trade Marks Rules 2000, SI 2000/136, r 67(1)(b) (as substituted: see note 2 supra). For the meaning of 'United Kingdom' see PARA 3 note 2 ante.
- 5 Ibid r 67(2) (as substituted: see note 2 supra).
- 6 Ie the Trade Marks Rules 2000, SI 2000/136 (as amended).
- 7 Ibid r 67(3) (as substituted: see note 2 supra). An 'excluded day' is a day which is not a business day as specified in a direction given by the registrar under the Trade Marks Act 1994 s 80 (see PARA 352 ante): Trade Marks Rules 2000, SI 2000/136, r 67(4) (as so substituted).
- 8 Ibid r 67A(1) (r 67A added by SI 2006/760). A communication service is a service by which documents may be sent and delivered, and includes post, facsimile, email and courier: Trade Marks Rules 2000, SI 2000/136, r 67A(3) (as so added).
- 9 Ibid r 67A(2) (as added: see note 8 supra).
- 10 The exceptions are specified in ibid r 68(3) (amended SI 2004/947; SI 2006/760). Under this provision, the times or periods prescribed by the following rules are excepted: the Trade Marks Rules 2000, SI 2000/136, r 10A(2) (as added) (direction to file address for service: see PARA 357 post), r 11 (deficiencies in application: see PARA 363 post), r 13(1) (time for filing opposition: see PARA 384 post), r 13A(1) (as added) and rr 31(3), 32(3), 33(6) (times for filing counter-statement: see PARAS 384, 398-400 post), r 23(4) (time for filing opposition to amendment of regulations governing use of registered collective or certification mark: see PARAS 161, 172 ante), r 25(3) (time for filing opposition to alteration of registered trade mark: see PARA 393 post), r 29 (delayed renewal: see PARA 29 ante), r 30 (restoration of registration: see PARA 30 ante), and r 47 (time for filing opposition to proposals to amend register following reclassification: see PARA 392 post).
- 11 Ie prescribed by the Trade Marks Rules 2000, SI 2000/136 (as amended).
- 12 A request for the extension of a period prescribed, which is filed after the application has been published under ibid r 12 (see PARA 383 post) must be on Form TM9 and must in any other case be on that form if the registrar so directs: r 68(2)(b). As to the use of forms see PARA 353 ante.
- 13 Ibid r 68(1). The registrar has published two Tribunal Practice Notices (TPN 3/2000 and TPN 1/2003) setting out the circumstances in which an application to extend the time limit for an appeal will be granted. Tribunal Practice Notices are available from the Patent Office or on its website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk).
- 14 Ie a time or periods prescribed by the Trade Marks Rules 2000, SI 2000/136, rr 13-13C (as amended) (see PARA 384 post), r 18 (see PARA 375 post), r 23 (see PARAS 161, 172 ante), r 25 (see PARA 393 post), rr 31, 31A (as added), 32, 32A (as added), 33, 33A (as added) (see PARAS 398-400 post) or r 34 (see PARA 401 post).
- 15 Ibid r 68(2)(a) (amended by SI 2004/947).
- 16 Trade Marks Rules 2000, SI 2000/136, r 68(4).
- 17 Ibid r 68(5).
- 18 Ie under the Trade Marks Rules 2000, SI 2000/13 (as amended).
- 19 Ibid r 68(6).
- 20 See ibid r 68(7); and PARA 361 post.

## UPDATE

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **356 Calculation of times and periods; alteration of time limits**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 74-77, Sch 1 (r 77 amended by SI 2009/2089).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(i) In general/357. Address for service.

### **357. Address for service.**

For the purposes of any proceedings under the Trade Marks Act 1994 or the Trade Marks Rules 2000<sup>1</sup>, an address for service must be filed by:

- 445 (1) an applicant for the registration of a trade mark<sup>2</sup>;
- 446 (2) any person who opposes the registration of a trade mark in opposition proceedings<sup>3</sup>;
- 447 (3) any person who applies for revocation<sup>4</sup>, a declaration of invalidity<sup>5</sup> or rectification<sup>6</sup> under the Act<sup>7</sup>;
- 448 (4) the proprietor<sup>8</sup> of the registered trade mark who opposes such an application<sup>9</sup>.

The proprietor of a registered trade mark, or any person who has registered an interest in a registered trade mark, may file an address for service on the appropriate form<sup>10</sup>. Where a person has provided an address for service, he may substitute a new address for service by notifying the registrar on the same type of form<sup>11</sup>.

An address for service filed by an applicant for the registration of a trade mark, the proprietor of a registered trade mark or any person who has registered an interest in a registered trade mark must be an address in the United Kingdom<sup>12</sup>, another EEA state<sup>13</sup> or the Channel Islands<sup>14</sup>. An address for service filed by a person who opposes the registration of a trade mark in opposition proceedings, a person who applies for revocation, a declaration of invalidity or rectification or a proprietor who opposes such an application must be an address in the United Kingdom, unless in a particular case the registrar otherwise directs<sup>15</sup>.

Where a person had failed to file an address for service<sup>16</sup> as required<sup>17</sup> and the registrar has sufficient information enabling him to contact that person, the registrar must direct that person to file an address for service<sup>18</sup>. Where such a direction has been given, the person directed must file an address for service before the end of the period of two months beginning with the date of the direction<sup>19</sup>. Where the registrar has insufficient information to give such a direction or a direction was given and the person had failed to provide an address for service by the expiry of the two month period<sup>20</sup>, then:

- 449 (a) in the case of an applicant for the registration of a trade mark, the application will be treated as withdrawn<sup>21</sup>;
- 450 (b) in the case of a person opposing the registration of a trade mark, his opposition will be treated as withdrawn<sup>22</sup>;
- 451 (c) in the case of a person applying for revocation, a declaration of invalidity or rectification, his application will be treated as withdrawn<sup>23</sup>; and
- 452 (d) in the case of a proprietor opposing such an application, he will be deemed to have withdrawn from the proceedings<sup>24</sup>.

The holder of an international registration who requests protection of the trade mark in the United Kingdom (via the International Bureau<sup>25</sup>) is not required to file an address for service unless and until he needs to make representations in order to overcome a notice of provisional refusal after examination<sup>26</sup>, he files a counter-statement to an opposition to his mark<sup>27</sup>, or he

files a counter-statement to an application for revocation or a declaration of invalidity of his mark<sup>28</sup>. Where the holder files an address for service to make representations it must be an address for service in the United Kingdom, another EEA state or the Channel Islands<sup>29</sup>. Where the holder files a counter-statement to opposition proceedings, the address must be an address in the United Kingdom<sup>30</sup>. Where the holder files a counter-statement to revocation or invalidity proceedings, the address must be an address in the United Kingdom unless in a particular case the registrar otherwise directs<sup>31</sup>.

- 1    Ie the Trade Marks Rules 2000, SI 2000/136 (as amended).
- 2    Ibid r 10(1)(a) (r 10 substituted by SI 2006/760). As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 363 et seq post.
- 3    Trade Marks Rules 2000, SI 2000/136, r 10(1)(b) (as substituted: see note 2 supra). As to opposition proceedings see PARAS 384-386 post.
- 4    As to revocation see PARAS 114 et seq ante, 396 et seq post.
- 5    As to a declaration of invalidity see PARAS 118 et seq ante, 396 et seq post.
- 6    As to rectification see PARAS 121 ante, 396 et seq post.
- 7    Trade Marks Rules 2000, SI 2000/136, r 10(1)(c) (as substituted: see note 2 supra).
- 8    For the meaning of 'proprietor' see PARA 22 note 8 ante.
- 9    Trade Marks Rules 2000, SI 2000/136, r 10(1)(d) (as substituted: see note 2 supra).
- 10   Ibid r 10(2) (as substituted: see note 2 supra). The appropriate form is Form TM33: r 10(2) (as so substituted). As to the use of forms see PARA 353 ante.
- 11   Ibid r 10(3) (as substituted: see note 2 supra). It is the responsibility of the person concerned to notify any change of address for service to the registrar, and the registrar is under no duty to verify the currency of the address for service when sending documents: *OIOI Trade Mark* (O/340/04), Appointed Person.
- 12   For the meaning of 'United Kingdom' see PARA 3 note 2 ante.
- 13   'EEA state' means a member state (ie of the European Community), Iceland, Liechtenstein or Norway: Trade Marks Rules 2000, SI 2000/136, r 2 (amended by SI 2006/763). As to the EEA see PARA 102 note 6 ante.
- 14   Trade Marks Rules 2000, SI 2000/136, r 10(4) (as substituted: see note 2 supra).
- 15   Ibid r 10(5) (as substituted (see note 2 supra), and amended by SI 2006/1029).
- 16   Ie an address for service which complies with the requirements of the Trade Marks Rules 2000, SI 2000/136, r 10(4) or (5): r 10A(5) (r 10A added by SI 2006/760).
- 17   Ie under the Trade Marks Rules 2000, SI 2000/136, r 10(1).
- 18   Ibid r 10A(1) (as added: see note 16 supra).
- 19   Ibid r 10A(2) (as added: see note 16 supra).
- 20   Ibid r 10A(3) (as added: see note 16 supra).
- 21   Ibid r 10A(4)(a) (as added: see note 16 supra).
- 22   Ibid r 10A(4)(b) (as added: see note 16 supra).
- 23   Ibid r 10A(4)(c) (as added: see note 16 supra).
- 24   Ibid r 10A(4)(d) (as added: see note 16 supra).
- 25   As to seeking protection for trade marks via the International Bureau see PARA 365 post.



26 Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(5) (amended by SI 2006/763); Trade Marks (International Registration) Order 1996, SI 1996/714, art 9A(3) (added by SI 2004/948; and amended by SI 2006/763). As to examination of the international registration and notices of refusal see PARA 372 post.

27 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10B(1)(b) (added by SI 2004/948). As to opposition proceedings see PARAS 384-386 post.

28 Trade Marks (International Registration) Order 1996, SI 1996/714, art 13(1A)(b) (added by SI 2004/948; and amended by SI 2006/763).

29 Trade Marks (International Registration) Order 1996, SI 1996/714, arts 9(5), 9A(3) (art 9(5) as amended; and art 9A(3) as added and amended: see note 26 supra). The address for service must be filed on Form TM33: arts 9(5), 9A(3) (art 9(5) as amended; and art 9A(3) as added and amended: see note 26 supra).

30 Ibid art 10B(1)(b) (as added: see note 27 supra).

31 Ibid art 13(1B) (added by SI 2006/763; and amended by SI 2006/1080).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **357 Address for service**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 11, 12 (amended by SI 2009/546).

TEXT AND NOTES 25-31--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(ii) Procedural Powers of the Registrar/358. In general.

## **(ii) Procedural Powers of the Registrar**

### **358. In general.**

Without prejudice to any provisions of the trade marks legislation<sup>1</sup> requiring the registrar<sup>2</sup> to hear any party to proceedings under that legislation<sup>3</sup>, or to give such party an opportunity to be heard, the registrar must, before taking any decision on any matter which is or may be adverse to any party to any proceedings before him, give that party an opportunity to be heard<sup>4</sup>. The registrar must give that party at least 14 days' notice of the time when he may be heard unless that party consents to shorter notice<sup>5</sup>.

In relation to the examination of witnesses on oath and the disclosure and production of documents, the registrar has all the powers of an official referee of the Supreme Court (now referred to as a judge of the Technology and Construction Court)<sup>6</sup>; and the rules applicable to the attendance of witnesses before such a referee apply in relation to the attendance of witnesses in proceedings before the registrar<sup>7</sup>.

At any stage of any proceedings before him, the registrar may direct that the parties to the proceedings attend a case management conference where they have an opportunity to be heard with regard to the future conduct of the proceedings, and in particular with regard to the proposed exercise of any of the registrar's powers<sup>8</sup>. Further, the registrar may direct that the parties attend a pre-hearing review at which he may give such directions as to the conduct of the hearing as he may think fit<sup>9</sup>. The Patent Office has issued general guidance as to the practice which will be followed in exercise of the registrar's powers of case management, pre-hearing review and generally when the registrar is acting as a tribunal<sup>10</sup>.

The hearing before the registrar of any dispute between two or more parties relating to any matter in connection with an application for the registration of a mark or a registered mark must be in public unless the registrar, after consultation with those parties who appear in person or are represented at the hearing, otherwise directs<sup>11</sup>.

1    Ie any provisions of the Trade Marks Act 1994 or the Trade Marks Rules 2000, SI 2000/136 (as amended).

2    As to the registrar see PARA 17 ante.

3    Ie proceedings under the Trade Marks Act 1994 or the Trade Marks Rules 2000, SI 2000/136 (as amended).

4    Ibid r 54(1). Tribunal Practice Notice (TPN 5/2000) [2001] RPC 253 sets out the registrar's practice with regard to hearings under the Trade Marks Rules 2000, SI 2000/136, r 54. Tribunal Practice Notices are available from the Patent Office or on its website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

The right to a hearing is a fundamental right under the Convention for the Protection of Human Rights and Fundamental Freedoms (Rome, 4 November 1950; TS 71 (1953); Cmd 8969) art 6, and the denial of a hearing will normally constitute a serious irregularity in procedure: *Gracey's Trade Mark Application* (O/375/01), Appointed Person; *MOVIESTAR Trade Mark* [2005] RPC 623, Appointed Person. Where a decision is taken in breach of the Trade Marks Rules 2000, SI 2000/136, r 54, the affected party is entitled to challenge the decision under r 66 (see PARA 361 post): *RAPIER Trade Mark* (O/170/07), Appointed Person.

5 Trade Marks Rules 2000, SI 2000/136, r 54(2).

6 Trade Marks Act 1994 s 69(b); Trade Marks Rules 2000, SI 2000/136, r 58(1). As from a day to be appointed these provisions are amended so as to refer to the Senior Courts or the Court of Judicature: Trade Marks Act 1994 s 69(b) (prospectively amended by the Constitutional Reform Act 2005 s 59(5), Sch 11 para 31); Trade Marks Rules 2000, SI 2000/136, r 58(1) (prospectively amended by virtue of the Constitutional Reform Act 2005 s 59(5), Sch 11). At the date at which this volume states the law no such day had been appointed.

The power to order disclosure (formerly referred to as discovery) of documents should be exercised only in respect of documents which are relevant to the matter in dispute and disclosure of which is necessary to dispose fairly of the proceedings: *LIFESAVERS Trade Mark*[1997] RPC 563; and see also *Merrell Dow Pharmaceuticals Inc's (Terfenadine) Patent*[1991] RPC 221.

7 Trade Marks Act 1994 s 69(c); Trade Marks Rules 2000, SI 2000/136, r 58(2).

8 *Ibid* r 36. The registrar must give the parties at least 14 days notice of the date of the case management conference: r 36.

9 *Ibid* r 37. The registrar must give the parties at least 14 days notice of the date of the pre-hearing review: r 37.

10 Tribunal Practice Notice (TPN 1/2000) [2000] RPC 587. The Tribunal Practice Notice relates generally to proceedings relating to patents, trade marks and designs, and applies to proceedings where there are two or more parties in front of the registrar as well as proceedings where only one party and the registrar are involved.

11 Trade Marks Rules 2000, SI 2000/136, r 59(1). Nothing in r 59 prevents a member of the Council on Tribunals or of its Scottish Committee from attending a hearing in his capacity as such: r 59(2). As to the Council on Tribunals see ADMINISTRATIVE LAW vol 1(1) (2001 Reissue) PARA 55 et seq. As to the registrar's decisions see PARA 404 post.

## UPDATE

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **358 In general**

TEXT AND NOTES 1-5--See now Trade Marks Rules 2008, SI 2008/1797, r 63.

TEXT AND NOTES 6, 7--See now SI 2008/1797 r 65.

NOTE 6--Appointed day is 1 October 2009: SI 2009/1604.

TEXT AND NOTES 8, 9--SI 2000/136 rr 36, 37 revoked: SI 2008/1797.

NOTE, 11--See now SI 2008/1797 r 66.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(ii) Procedural Powers of the Registrar/359. Evidence.

### **359. Evidence.**

Where evidence may be admitted<sup>1</sup> by the registrar<sup>2</sup> in any proceedings before him, it must be by the filing<sup>3</sup> of a statutory declaration or affidavit<sup>4</sup>. A witness statement verified by a statement of truth may be used as an alternative<sup>5</sup>, but the registrar may direct as he thinks fit in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to such a witness statement<sup>6</sup>. The registrar may in any particular case take oral evidence in lieu of or in addition to such evidence; and, unless he otherwise directs, he must allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence<sup>7</sup>. Where a party adduces evidence of a statement made by a person otherwise than by giving oral evidence in the proceedings and does not call that person as a witness, the registrar may if he thinks fit permit any other party to call that person as a witness and cross-examine him on the statement as if he were called as a witness by the party relying on his statement and as if it were his evidence in chief<sup>8</sup>.

Any statutory declaration or affidavit duly filed<sup>9</sup> must be made and subscribed as follows<sup>10</sup>:

- 453 (1) in the United Kingdom<sup>11</sup>, before any justice of the peace or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceedings<sup>12</sup>;
- 454 (2) in any other part of Her Majesty's dominions or in the Republic of Ireland, before any court, judge, justice of the peace or any officer authorised by law to administer an oath there for the purpose of any legal proceedings<sup>13</sup>; and
- 455 (3) elsewhere, before a commissioner for oaths, notary public, judge or magistrate<sup>14</sup>.

Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person so authorised to take a declaration may be admitted by the registrar without proof of the genuineness of the seal or signature, or of the official character of the person or his authority to take the declaration<sup>15</sup>.

At any stage of any proceedings before the registrar, he may direct that such documents, information or evidence as he may reasonably require are to be filed within such period as he may specify<sup>16</sup>.

1    Ie under the Trade Marks Rules 2000, SI 2000/136 (as amended).

2    As to the registrar see PARA 17 ante.

3    For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

4    Trade Marks Act 1994 s 69(a); Trade Marks Rules 2000, SI 2000/136, r 55(1).

5    Ibid r 55(3). The practice and procedure of the High Court with regard to witness statements and statements of truth, their form and contents and the procedure governing their use apply as appropriate to all proceedings under the Trade Marks Rules 2000, SI 2000/136 (as amended): r 55(4).

6    Ibid r 55(3).

7 Ibid r 55(2).

8 Ibid r 55(5). If a party desires to test the evidence given by affidavit, statutory declaration or witness statement, then prima facie and within reason he should be allowed to do so: *Alliance & Leicester plc's Trade Mark Application* [2002] RPC 573. The registrar requires reasonable written notice to be given of any desire to cross-examine a witness: Tribunal Practice Notice (TPN 1999) [1999] RPC 294. Tribunal Practice Notices are available from the Patent Office or on its website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

9 le filed under the Trade Marks Act 1994 or the Trade Marks Rules 2000, SI 2000/136 (as amended).

10 Ibid r 56(1).

11 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

12 Trade Marks Rules 2000, SI 2000/136, r 56(1)(a).

13 Ibid r 56(1)(b).

14 Ibid r 56(1)(c).

15 Ibid r 56(2).

16 Ibid r 57. This power is wide enough to enable the registrar to require a party to clarify his case, including by way of amendment to his statement of the case: *BSA BY R2 Trade Mark* (O/144/07), Appointed Person.

## UPDATE

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **359 Evidence**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 64. As to the general powers of the registrar in relation to proceedings see r 62.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(ii) Procedural Powers of the Registrar/360. Costs and security for costs.

### **360. Costs and security for costs.**

The registrar<sup>1</sup> may in any proceedings before him, under the Trade Marks Act 1994 or the Trade Marks Rules 2000<sup>2</sup>, by order award any party such costs as he may consider reasonable; and he may direct how and by what parties they are to be paid<sup>3</sup>. Any such order of the registrar may be enforced in the same way as an order of the High Court<sup>4</sup>.

The registrar may require any person who is a party in any proceedings before him, under the Trade Marks Act 1994 or the Trade Marks Rules 2000, to give security for costs in relation to those proceedings; and he may require security for the costs of any appeal from his decision<sup>5</sup>. In default of such security being given, the registrar, in the case of proceedings before him, or the person duly appointed<sup>6</sup>, in the case of an appeal, may treat the party in default as having withdrawn his application, opposition, objection or intervention, as the case may be<sup>7</sup>.

1 As to the registrar see PARA 17 ante.

2 I.e. the Trade Marks Rules 2000, SI 2000/136 (as amended).

3 Trade Marks Act 1994 s 68(1); Trade Marks Rules 2000, SI 2000/136, r 60. The registrar's normal practice is to make modest awards of costs on a scale, but he has a discretion to order compensatory costs: *Rizla Ltd's Application* [1993] RPC 365. The Patent Office has issued guidance as to the practice in exercising powers to award costs in, inter alia, trade mark matters: Tribunal Practice Notice (TPN 2/2000) [2000] RPC 598. Tribunal Practice Notices are available from the Patent Office or on its website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

4 Trade Marks Act 1994 s 68(2)(a).

5 Ibid s 68(3); Trade Marks Rules 2000, SI 2000/136, r 61(1).

6 I.e. appointed under the Trade Marks Act 1994 s 76: see PARA 405 et seq post.

7 Ibid s 68(3); Trade Marks Rules 2000, SI 2000/136, r 61(2).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **360 Costs and security for costs**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 67, 68.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(ii) Procedural Powers of the Registrar/361. Correction of irregularities of procedure.

### **361. Correction of irregularities of procedure.**

Any irregularity in procedure<sup>1</sup> in or before the Patent Office<sup>2</sup> or the registrar<sup>3</sup> may be rectified on such terms as the registrar may direct<sup>4</sup>. In the case of an irregularity or prospective irregularity:

- 456 (1) which consists of a failure to comply with any limitation as to specified times or periods<sup>5</sup> and which has occurred or appears to the registrar as likely to occur in the absence of a direction; and
- 457 (2) which is attributable wholly or in part to an error, default or omission on the part of the Patent Office or the registrar<sup>6</sup> and which it appears to the registrar should be rectified,

he may direct that the time or period in question be altered in such manner as he may specify<sup>7</sup>.

1 An irregularity in procedure is simply a failure to observe procedural rules, whatever the cause of the failure may be: *E's Applications* [1983] RPC 231 at 250, HL, per Diplock LJ.

2 As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

3 As to the registrar see PARA 17 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 66, which is expressed to be subject to r 68 (see the text and notes 5-7 infra; and PARA 356 ante). The registrar's powers under r 66 cannot be used in a manner contrary to other provisions of the Trade Marks Act 1994 or the Trade Marks Rules 2000, SI 2000/136 (as amended), and accordingly cannot be used to extend time limits which are inextensible by virtue of r 68(3): *E's Applications* [1983] RPC 231, HL; *KML Invest AB's Trade Mark Application* [2004] RPC 972, Appointed Person. The registrar has power under the Trade Marks Rules 2000, SI 2000/136, r 66 to withdraw the registration of a trade mark if the registration was procedurally irregular: see *Andreas Stihl AG & Co's Trade Mark Application* [2001] RPC 215, Appointed Person; *BAT OUT OF HELL Trade Mark* (O/398/02), Appointed Person.

5 The times or periods specified in the Trade Marks Act 1994, the Trade Marks Rules 2000, SI 2000/136 (as amended), or the old law as that law continues to apply. For the meaning of 'old law' see PARA 15 note 2 ante.

6 An attempt by a solicitor to file a notice of opposition on the last day which failed because he attempted to use an out of date fax number, when the current fax numbers of the Patent Office were published weekly in the Trade Marks Journal, did not amount to an irregularity in the Patent Office and so there was no power to extend time: *MONSTER MUNCH Trade Mark* [1997] RPC 721, Trade Marks Registry.

7 Trade Marks Rules 2000, SI 2000/136, r 68(7), which is expressed to be without prejudice to the registrar's powers to extend any time or periods under r 68(1)-(6) (see PARA 356 ante). The registrar's powers under r 68(7) cannot be used to extend time limits which are inextensible by virtue of r 68(3): *E's Applications* [1983] RPC 231, HL; *KML Invest AB's Trade Mark Application* [2004] RPC 972, Appointed Person.

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

**361 Correction of irregularities of procedure**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 74, 77 (r 77 amended by SI 2009/2089).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(ii) Procedural Powers of the Registrar/362. Registrar's inherent jurisdiction.

### **362. Registrar's inherent jurisdiction.**

The registrar<sup>1</sup> has an inherent jurisdiction to regulate procedure before him provided that he neither creates a substantial jurisdiction where none existed nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon him<sup>2</sup>. It appears that it is pursuant to this inherent jurisdiction that the registrar grants or refuses parties to proceedings before him permission to amend their statements of case<sup>3</sup>.

<sup>1</sup> As to the registrar see PARA 17 ante.

<sup>2</sup> *Pharmedica GmbH's Trade Mark Application* [2000] RPC 536, [2000] All ER (D) 28; *ACADEMY Trade Mark* [2000] RPC 35, Appointed Person; *Hyde's Trade Mark Applications (No 2)* (O/333/05), Appointed Person.

<sup>3</sup> See *COFFEEMIX Trade Mark* [1998] RPC 717, Appointed Person; and cf *BSA BY R2 Trade Mark* (O/144/07), Appointed Person.

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iii) Application for Registration/363. Application relating to United Kingdom registered marks.

### **(iii) Application for Registration**

#### **363. Application relating to United Kingdom registered marks.**

An application for registration<sup>1</sup> of a trade mark<sup>2</sup> must be made to the registrar<sup>3</sup> and must be filed<sup>4</sup> on the appropriate form<sup>5</sup>. The application must contain: (1) a request for registration of a trade mark; (2) the name and address of the applicant<sup>6</sup>; (3) a statement of the goods or services in relation to which it is sought to register the trade mark<sup>7</sup>; and (4) a representation<sup>8</sup> of the trade mark<sup>9</sup>. The application must also specify the class or classes to which it relates<sup>10</sup>. The application must state that the trade mark is being used<sup>11</sup>, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used<sup>12</sup>.

The application is subject to the payment of the application fee and such class fees as may be appropriate<sup>13</sup>.

Where an application for registration of a trade mark does not satisfy the statutory requirements<sup>14</sup>, the registrar must send<sup>15</sup> notice thereof to the applicant to remedy the deficiencies or, as the case may be, default of payment<sup>16</sup>. If within two months of the date of the notice<sup>17</sup> the applicant:

- 458 (a) fails to remedy any deficiency relating to the contents of the application notified to him<sup>18</sup>, the application is deemed never to have been made<sup>19</sup>; or
- 459 (b) fails to remedy any other deficiency<sup>20</sup> notified to him or fails to make payment<sup>21</sup>, the application is treated as abandoned<sup>22</sup>.

1 For the meaning of 'registration' see PARA 19 note 2 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 As to the registrar see PARA 17 ante.

4 For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

5 Trade Marks Act 1994 s 32(1); Trade Marks Rules 2000, SI 2000/136, r 5(1). The appropriate form is Form TM3: r 5(1). As to the use of forms see PARA 353 ante.

An application for registration of a mark under the Trade Marks Act 1938 which was pending on 31 October 1994 must be dealt with under the old law and, if registered, the mark must be treated as an existing registered mark: Trade Marks Act 1994 s 105, Sch 3 para 10(1). The power of the Secretary of State under s 78 (see PARA 15 ante) to make rules regulating practice and procedure, and as to the matters mentioned in s 78(2), is exercisable in relation to such an application; and different provision may be made for such applications from that made for other applications: Sch 3 para 10(2). As to the Secretary of State see PARA 14 ante. The Trade Marks Act 1938 s 23 (repealed) (provisions as to associated trade marks) must be disregarded in dealing on and after 31 October 1994 with an application for registration: Trade Marks Act 1994 Sch 3 para 10(3). For the meaning of 'the old law' see PARA 4 note 3 ante; and for the meaning of 'existing registered mark' see PARA 4 note 2 ante.

In the case of a pending application for registration which had not been advertised under the Trade Marks Act 1938 s 18 (repealed) before 31 October 1994, the applicant might give notice to the registrar claiming to have the registrability of the mark determined in accordance with the provisions of the Trade Marks Act 1994: Sch 3

para 11(1). Notice duly given was irrevocable and had the effect that the application was treated as if made immediately after 31 October 1994: Sch 3 para 11(3).

6 An application by a partnership may now be made in the name of the partnership, rather than in the names of the individual partners as formerly: Practice Amendment Notice PAN 2/04; but see *Drinkstop Ltd v Michaels Foodmarket* (O/168/05), Appointed Person.

7 It is not permissible to specify the goods or services by means of a statement that the goods or services in question do not possess a particular characteristic: Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2006] Ch 1, [2004] ECR I-1619, ECJ; *Croom's Trade Mark Application* [2005] RPC 23, Appointed Person (limitation to clothing 'none being items of haute couture' not allowed); *Oska's Ltd's Trade Mark Application* [2005] RPC 525 (limitation to clothing for sale to particular market not allowed). A restriction on the scope of the goods or services is, however, permissible even if framed in negative terms: *SVM Asset Management Ltd's Trade Mark Application* (O/043/05), Appointed Person (limitation to financial services 'not including the provision of venture capital' and 'not including the provision of any such services to the pharmaceutical biotechnological and bioscientific sectors' both allowed).

8 A trade mark must be capable of being represented graphically: see the Trade Marks Act 1994 s 1(1); and PARA 57 ante. The registrar's current practice in relation to marks incorporating or consisting of colours is set out in Practice Amendment Notice (PAN 3/03).

9 Trade Marks Act 1994 s 32(2).

10 See the Trade Marks Rules 2000, SI 2000/136, r 8(2)(a), (3) (as amended); and PARA 371 post. As to the classification of goods and services see PARA 369 et seq post.

11 For the meaning of 'use' see PARA 60 note 8 ante.

12 Trade Marks Act 1994 s 32(3). If the applicant does not intend to use the mark, the application may be objectionable as made in bad faith: see PARA 69 ante.

13 Ibid s 32(4); Trade Marks Rules 2000, SI 2000/136, r 5(1). As to fees see PARA 16 ante.

14 Ie the requirements of the Trade Marks Act 1994 s 32(2), (3) or (4) (see the text and notes 1-13 supra); or the Trade Marks Rules 2000, SI 2000/136, r 5 (see the text and notes 1-13 supra) or r 8(2)(a) (as amended) (see PARA 371 post).

15 For the meaning of 'send' see PARA 25 note 14 ante.

16 Trade Marks Rules 2000, SI 2000/136, r 11 (amended by SI 2004/497). The reference to default of payment is to such default in the case of the Trade Marks Act 1994 s 32(4): see the text to note 13 supra.

17 This period may not be extended: see the Trade Marks Rules 2000, SI 2000/136, r 68(1), (3); and PARA 356 ante.

18 Ie any deficiency notified to him in respect of the Trade Marks Act 1994 s 32(2): see the text to notes 6-9 supra.

19 Trade Marks Rules 2000, SI 2000/136, r 11(a).

20 Ie any deficiency notified to him in respect of the Trade Marks Act 1994 s 32(3) (see the text to notes 11-12 supra) or the Trade Marks Rules 2000, SI 2000/136, r 5 (see the text and notes 1-13 supra) or r 8(2)(a) (as amended) (see PARA 371 post).

21 Ie as required by the Trade Marks Act 1994 s 32(4): see the text to note 13 supra.

22 Trade Marks Rules 2000, SI 2000/136, r 11(b) (as amended: see note 16 supra).

## UPDATE

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

**363 Application relating to United Kingdom registered marks**

TEXT AND NOTES 1-13--See now Trade Marks Rules 2008, SI 2008/1797 rr 5, 8, 15 (r 5 amended by SI 2009/2089).

TEXT AND NOTES 14-22--SI 2000/136 r 11 now SI 2008/1797 r 13.

NOTE 17--See now SI 2008/1797 r 77 (amended by SI 2009/2089).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iii) Application for Registration/364. Series of trade marks.

### **364. Series of trade marks.**

The proprietor<sup>1</sup> of a series of trade marks<sup>2</sup> may apply to the registrar<sup>3</sup> on the appropriate form<sup>4</sup> for their registration as a series in a single registration and there must be included in such application a representation of each mark claimed to be in the series; and, if the registrar is satisfied that the marks constitute a series, he must accept the application<sup>5</sup>.

At any time before preparations of publication of the application have been completed by the Patent Office<sup>6</sup>, the applicant may request on the appropriate form<sup>7</sup> the division of the application into separate applications in respect of one or more marks in that series and the registrar must divide the application accordingly provided that at least one application remaining after such a division would comprise either a trade mark or a series of trade marks<sup>8</sup>. Such a division of an application into one or more applications is subject to the payment of a divisional fee and such application and class fees as are appropriate<sup>9</sup>.

At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series, and the registrar must delete the mark accordingly<sup>10</sup>. Where the registrar deletes a trade mark from an application, the application in so far as it relates to the deleted mark is to be treated as withdrawn<sup>11</sup>.

1 For the meaning of 'proprietor' see PARA 22 note 8 ante.

2 For these purposes, a 'series of trade marks' means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark: Trade Marks Act 1994 s 41(2). For trade marks to qualify as a series the differences between them must be sufficiently insignificant that the average consumer would be unlikely to notice the differences: *Sony Ericsson Mobile Communications AB's Trade Mark Application* (O/138/06), Appointed Person. For the meaning of 'trade mark' see PARA 57 ante.

3 As to the registrar see PARA 17 ante.

4 I.e Form TM3: Trade Marks Rules 2000, SI 2000/136, r 21(1). As to the use of forms see PARA 353 ante.

5 Trade Marks Act 1994 s 41(1)(c), (3); Trade Marks Rules 2000, SI 2000/136, r 21(1).

6 As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

7 I.e Form TM12: Trade Marks Rules 2000, SI 2000/136, r 21(2) (amended by SI 2004/947).

8 Trade Marks Rules 2000, SI 2000/136, r 21(2) (as amended: see note 7 supra).

9 Ibid r 21(4). As to fees see PARA 16 ante.

10 Ibid r 21(3).

11 Ibid r 21(3A) (added by SI 2004/947).

### **UPDATE**

**352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

**364 Series of trade marks**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 28 (amended by SI 2009/2089).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iii) Application for Registration/365. Protection for international registrations.

### **365. Protection for international registrations.**

The procedure by which an international registration<sup>1</sup> becomes protected in the United Kingdom is initiated in a different way from an application for registration of a United Kingdom trade mark, but thereafter follows a similar procedure and it is subject to the same substantive requirements<sup>2</sup> for achieving protection in the United Kingdom as for the registrability of a registered mark<sup>3</sup>. A person desiring to secure protection for a trade mark in the United Kingdom via this route must make a request to extend the protection of his international registration to the United Kingdom; such a request may be included in his original international application, or extension to the United Kingdom may be requested subsequently to the initial international registration<sup>4</sup>. The International Bureau<sup>5</sup> notifies the British registrar after receiving a request for the extension of protection of an international registration to the United Kingdom<sup>6</sup>.

The incoming international registration is not subject to the requirements of the Trade Marks Act 1994 or rules requiring the filing of the application in the Patent Office or pertaining to its form<sup>7</sup>. There are, however, corresponding and broadly similar requirements relating to the application for international registration<sup>8</sup>. Apart from these exceptions, an international registration designating the United Kingdom<sup>9</sup> is entitled to become protected where, if the particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration including any imposed by rules<sup>10</sup>.

1    I.e. an international trade mark registration on the international register operated under the Madrid Protocol: see PARAS 11-13 ante. As to the Madrid Protocol see PARA 8 ante.

2    I.e. including any requirements imposed by the Trade Marks Rules 2000, SI 2000/136 (as amended): Trade Marks (International Registration) Order 1996, SI 1996/714, arts 2, 3(1).

3    See PARA 55 ante.

4    Applications for international registration are filed through the home trade mark office of the applicant. For an outline of the procedure followed under the Madrid Protocol see PARA 13 ante.

5    As to the International Bureau see PARA 8 note 11 ante.

6    Madrid Protocol art 3 (ter).

7    I.e. the Trade Marks Act 1994 ss 32-34; and the Trade Marks Rules 2000, SI 2000/136, rr 5-8A (as amended), 10, 11 (see PARAS 363 ante, and 370-371, 378 post). These are excluded from applying to international registrations by the Trade Marks (International Registration) Order 1996, SI 1996/714, art 3(2) (amended by SI 2004/948). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

8    See the Madrid Protocol art 3(1)-(3); and the Madrid Common Regulations r 9. A detailed description of these provisions which form part of the international regime established under the Madrid Agreement and Protocol is outside the scope of this work. As to the Madrid Protocol see PARA 8 ante; and as to the Common Regulations see PARA 11 note 5 ante.

9    For the meaning of 'international registration designating the United Kingdom' see PARA 13 ante.

10   Trade Marks (International Registration) Order 1996, SI 1996/714, art 3(1).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **365 Protection for international registrations**

NOTES 2, 7, 10--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

NOTES 2, 7--See now Trade Marks Rules 2008, SI 2008/1797, rr 5-9, 11, 13 (rr 5, 13 amended by SI 2009/2089).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iii) Application for Registration/366. Date of filing.

### **366. Date of filing.**

The date of filing of an application for registration<sup>1</sup> of a trade mark<sup>2</sup> is the date on which documents containing everything required to be contained in the application<sup>3</sup> are furnished to the registrar<sup>4</sup> by the applicant<sup>5</sup>. If, however, documents are furnished on different days, the date of filing is the last of those days<sup>6</sup>.

For an international registration<sup>7</sup>, the equivalent of the date of filing of a domestic trade mark application is the date of the international registration or, if later, the date when a request for extension of protection to the United Kingdom is recorded in the international register<sup>8</sup>. The date of the international registration is normally the date when the international application was received in the office of origin<sup>9</sup>.

1 For the meaning of references to 'registration' see PARA 19 note 2 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 I.e. required by the Trade Marks Act 1994 s 32(2): see PARA 363 ante.

4 As to the registrar see PARA 17 ante.

5 Trade Marks Act 1994 s 33(1). References in the Trade Marks Act 1994 to the date of application for registration are to the date of filing of the application: s 33(2). The date of filing is important because: (1) it may be critical in the event of conflicting applications for the same or similar marks (see PARA 70 ante); and (2) once registration is granted, many of the rights conferred by the mark date back to the date of application (see PARAS 21, 85 ante).

6 Ibid s 33(1). Thus if the application does not contain an adequate representation of the mark sought to be registered, eg because it does not identify a colour unambiguously, it will only be accorded a date of filing when the uncertainty has been resolved (*Ty Nant Spring Water Ltd's Trade Mark Application* [2000] RPC 55, [1999] ETMR 981, Appointed Person; *Robert McBride Ltd's Trade Mark Application* [2003] RPC 343, Appointed Person) if it is permissible at all (see *Nestlé SA's Trade Mark Application* [2004] EWCA Civ 1008, [2005] RPC 77, sub nom *Société des Produits Nestlé SA v Mars UK Ltd* [2005] IP & T 551).

7 As to international registrations see PARAS 8, 11-13 ante.

8 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(2).

9 Madrid Protocol art 3(4). As to the Madrid Protocol see PARA 8 ante.

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **366 Date of filing**

NOTE 8--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iii) Application for Registration/367. Division of application.

### **367. Division of application.**

At any time before registration<sup>1</sup> an applicant may send<sup>2</sup> to the registrar<sup>3</sup> a request<sup>4</sup> for a division of his application for registration (the 'original application') into two or more separate applications ('divisional applications'), indicating for each division the specification<sup>5</sup> of goods or services; each divisional application will be treated as a separate application for registration with the same filing date<sup>6</sup> as the original application<sup>7</sup>.

Where the request to divide an application is sent after publication of the application<sup>8</sup>, any objections in respect of, or opposition to, the original application are to be taken to apply to each divisional application and must be proceeded with accordingly<sup>9</sup>.

Upon division of an original application in respect of which notice has been given to the registrar of particulars relating to the grant of a licence, or a security interest or any right in or under it, the notice and the particulars are deemed to apply in relation to each of the applications into which the original application has been divided<sup>10</sup>.

<sup>1</sup> In context this must mean at any time before registration or refusal of the application: *Sensornet Ltd's Trade Mark Application* [2007] RPC 185, Appointed Person. The registrar has power to permit the division of an application during the pendency of an appeal against a decision to refuse the application since the registrar's practice is to treat appeals as being of suspensory effect: *Sensornet Ltd's Trade Mark Application* supra; *Aggregate Industries Ltd's Trade Mark Application* (O/178/06), Appointed Person. For the meaning of 'registration' see PARA 19 note 2 ante.

<sup>2</sup> For the meaning of 'send' see PARA 25 note 14 ante.

<sup>3</sup> As to the registrar see PARA 17 ante.

<sup>4</sup> The request must be sent on Form TM12. As to the use of forms see PARA 353 ante.

<sup>5</sup> For the meaning of 'specification' see PARA 369 note 1 post.

<sup>6</sup> For the meaning of 'date of filing' see PARA 366 ante.

<sup>7</sup> Trade Marks Act 1994 s 41(1)(a); Trade Marks Rules 2000, SI 2000/136, r 19(1). These provisions do not permit an application for a series of marks to be divided into an application for each of those marks (or combinations thereof); such a division is provided for by r 21 (see PARA 364 post): *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] RPC 890, [1999] All ER (D) 729.

<sup>8</sup> As to the publication of the application see PARA 383 post.

<sup>9</sup> Trade Marks Rules 2000, SI 2000/136, r 19(2).

<sup>10</sup> Ibid r 19(3).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

**367 Division of application**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 26 (amended by SI 2009/2089).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iii) Application for Registration/368. Merger of separate applications.

### **368. Merger of separate applications.**

An applicant who has made separate applications for registration of a mark may, at any time before preparations for the publication of any of the applications have been completed by the Patent Office<sup>1</sup>, request<sup>2</sup> the registrar<sup>3</sup> to merge the separate applications into a single application<sup>4</sup>. If the registrar is satisfied that all the applications which are the subject of the request for merger:

- 460 (1) are in respect of the same trade mark;
- 461 (2) bear the same date of application; and
- 462 (3) are, at the time of the request, in the name of the same person,

he must merge them into a single application<sup>5</sup>.

1 As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

2 The request must be made on Form TM17. As to the use of forms see PARA 353 ante.

3 As to the registrar see PARA 17 ante.

4 Trade Marks Act 1994 s 41(1)(b); Trade Marks Rules 2000, SI 2000/136, rr 2(1), 20(1).

5 Ibid r 20(2).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **368 Merger of separate applications**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 27.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iv) Classification of Goods and Services/369. Classification of goods and services.

## **(iv) Classification of Goods and Services**

### **369. Classification of goods and services.**

Every application must specify<sup>1</sup> the class of goods or services<sup>2</sup> to which it relates<sup>3</sup>. Goods and services must be classified for the purposes of the registration of trade marks<sup>4</sup> according to the Nice Classification<sup>5</sup>. When a trade mark is registered it must be classified according to the version of the Nice Classification that had effect on the date of application for registration<sup>6</sup>. Any question arising as to the class within which any goods or services fall must be determined by the registrar, whose decision is final<sup>7</sup>.

It is important which goods or services a mark is registered for<sup>8</sup>, and care must accordingly be taken to ensure that the application covers all the goods or services with which an applicant may be concerned.

There is a guide listing most goods alphabetically with an indication of the appropriate class for those goods. That guide is an indication of practice and not a decision on questions of classification<sup>9</sup>.

These provisions do not apply to international registrations<sup>10</sup> but there are corresponding international provisions relating to classification<sup>11</sup>.

1 For these purposes, 'specification' means the statement of goods or services in respect of which a trade mark is registered or proposed to be registered: Trade Marks Rules 2000, SI 2000/136, r 2(1).

2 I.e. under the 'Nice Classification': see note 5 infra.

3 Trade Marks Rules 2000, SI 2000/136, r 8(2)(a) (substituted by SI 2004/947; and amended by SI 2006/3039). An application may relate to more than one class: see PARA 371 post.

4 For the meaning of 'trade mark' see PARA 57 ante.

5 Trade Marks Act 1994 s 34(1): Trade Marks Rules 2000, SI 2000/136, r 7(1) (r 7 substituted by SI 2006/3039). The 'Nice Classification' means the system of classification under the Nice Agreement: Trade Marks Rules 2000, SI 2000/136, r 7(3)(b) (as so substituted). The 'Nice Agreement' means the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979: Trade Marks Rules 2000, SI 2000/136, r 7(3)(a) (as so substituted). See further PARAS 10 ante, 370 post.

The purpose of classification is primarily administrative but registration by reference to a particular class of goods or services may affect substantive rights: see eg *Re AA Byrd & Co Ltd's Application* (1953) 70 RPC 212; *CAL-U-TEST Trade Mark* [1967] FSR 39; *GE Trade Mark* [1969] RPC 418 at 458-459 (on appeal [1970] RPC 339, CA; revsd [1972] 2 All ER 507, [1972] 1 WLR 729, [1973] RPC 297, HL); *TORNADO Trade Mark* [1979] RPC 155, Trade Marks Registry; *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281; *Avnet Inc v Isoact Ltd* [1998] FSR 16; *Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, [2002] RPC 639; but cf *Carless, Capel & Leonard v F Pilmore-Bedford & Sons* (1928) 45 RPC 205; *Ofrex Ltd v Rapesco Ltd* [1963] RPC 169.

The registrar may exercise the powers conferred by rules under the Trade Marks Act 1994 s 65 (adaptation of entries to new classification: see PARA 392 post) to secure that any existing registered marks which do not conform to the system of classification prescribed under s 34 are brought into conformity with that system: s 105, Sch 3 para 12. As to the registrar see PARA 17 ante.

6 Trade Marks Rules 2000, SI 2000/136, r 7(2).

7 Trade Marks Act 1994 s 34(2). This provision does not empower the registrar to permit an applicant to transfer an application from one class to another in circumstances falling outside s 39(2) (see PARA 375 post): *Altecnic Ltd's Trade Mark Application*[2001] EWCA Civ 1928, [2002] RPC 639.

8 The position is, however, not as crucial under the Trade Marks Act 1994 as it was under the Trade Marks Act 1938 s 4(1) (repealed) (where it was essential in the case of infringement that the confusingly similar mark should be used on goods or services falling within the specification of goods of the registered mark; similarity of goods or services to those registered was not enough).

9 See *GE Trade Mark*[1969] RPC 418 at 458-459; on appeal [1970] RPC 339, CA; revsd [1972] 2 All ER 507, [1972] 1 WLR 729, [1973] RPC 297, HL.

10 Trade Marks (International Registration) Order 1996, SI 1996/714, art 3(2). For the meaning of 'international registration' see PARA 12 note 2 ante.

11 Madrid Protocol art 3(2). The indication of classes given by the applicant is subject to control by the International Bureau, which exercises that control in association with the office of origin of the international application. As to the International Bureau see PARAS 8 note 11, 12 note 5 ante. As to the Madrid Protocol see PARA 8 ante.

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **369 Classification of goods and services**

TEXT AND NOTES 1-6--See now Trade Marks Rules 2008, SI 2008/1797, r 7, 8.

NOTE 10--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iv) Classification of Goods and Services/370. The Nice Classification.

### **370. The Nice Classification.**

When a trade mark is registered it must be classified according to the version of the Nice Classification<sup>1</sup> that had effect on the date of application for registration<sup>2</sup>. The current edition<sup>3</sup> of the Nice Classification classifies goods<sup>4</sup> and services<sup>5</sup> as follows<sup>6</sup>:

- 463 (1) Class 1: chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
- 464 (2) Class 2: paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- 465 (3) Class 3: bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- 466 (4) Class 4: industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
- 467 (5) Class 5: pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
- 468 (6) Class 6: common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
- 469 (7) Class 7: machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.
- 470 (8) Class 8: hand tools and implements (hand-operated); cutlery; side arms; razors.
- 471 (9) Class 9: scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
- 472 (10) Class 10: surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
- 473 (11) Class 11: apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- 474 (12) Class 12: vehicles; apparatus for locomotion by land, air or water.



- 475 (13) Class 13: firearms; ammunition and projectiles; explosives; fireworks.
- 476 (14) Class 14: precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- 477 (15) Class 15: musical instruments.
- 478 (16) Class 16: paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
- 479 (17) Class 17: rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
- 480 (18) Class 18: leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- 481 (19) Class 19: building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
- 482 (20) Class 20: furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
- 483 (21) Class 21: household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
- 484 (22) Class 22: ropes, string, nets, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
- 485 (23) Class 23: yarns and threads, for textile use.
- 486 (24) Class 24: textiles and textile goods, not included in other classes; bed and table covers.
- 487 (25) Class 25: clothing, footwear, headgear.
- 488 (26) Class 26: lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
- 489 (27) Class 27: carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
- 490 (28) Class 28: games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
- 491 (29) Class 29: meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
- 492 (30) Class 30: coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery; ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
- 493 (31) Class 31: agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
- 494 (32) Class 32: beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

- 495 (33) Class 33: alcoholic beverages (except beers).
- 496 (34) Class 34: tobacco; smokers' articles; matches.
- 497 (35) Class 35: advertising<sup>7</sup>; business management; business administration; office functions<sup>8</sup>.
- 498 (36) Class 36: insurance; financial affairs; monetary affairs; real estate affairs.
- 499 (37) Class 37: building construction; repair; installation services.
- 500 (38) Class 38: telecommunications.
- 501 (39) Class 39: transport; packaging and storage of goods; travel arrangement.
- 502 (40) Class 40: treatment of materials.
- 503 (41) Class 41: education; providing of training; entertainment; sporting and cultural activities.
- 504 (42) Class 42: scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.
- 505 (43) Class 43: services for providing food and drink; temporary accommodation.
- 506 (44) Class 44: medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
- 507 (45) Class 45: legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

1 For the meaning of the 'Nice Classification' see PARA 369 note 5 ante.

2 Trade Marks Rules 2000, SI 2000/136, r 7(2) (substituted by SI 2006/3039).

3 I.e. the ninth edition, in force from 1 January 2007. Copies are available from the World Intellectual Property Organisation and from its website, accessible at the date at which this title states the law at [www.wipo.int](http://www.wipo.int). An application may relate to more than one class: see PARA 371 post.

4 Classes 1-34 (see heads (1)-(34) in the text) relate to goods.

5 Classes 35-45 (see heads (35)-(45) in the text) relate to services.

6 Formerly the Trade Marks Rules 2000, SI 2000/136, Sch 2 (revoked by SI 2001/3832) set out the classification of goods for registrations dated before 27 July 1938 (when the Trade Marks Act 1938 came into force) except where a specification had been converted to the classification set out in Sch 3 (revoked by SI 2006/3039) whether under the old law (see PARA 15 note 2 ante) or under the provisions relating to reclassification. By the end of 2001 all remaining registrations dated before 27 July 1938 had been reclassified. The Trade Marks Rules 2000, SI 2000/136, Schs 3, 4 (revoked by SI 2006/3039) set out the classification of goods for registrations dated before 1 January 2002, and 1 January 2007 respectively, based on the Nice Classifications that were then current. The Nice Classifications are no longer set out in detail in United Kingdom statutory instruments.

7 The provision of support services to customers to enable them to carry their own advertisements on their own websites is apparently not an advertising or promotional service falling within Class 35: *Avnet Inc v Isoact Ltd* [1998] FSR 16.

8 Services provided in connection with retail trade may be the subject of a trade mark registration provided that details are provided with regard to the goods or type of goods to which those services relate: Case C-418/02 *Praktiker Bau- und Heimwerkermärkte AG* [2006] Ch 144, [2005] ECR I-5873, ECJ. The registrar's practice is to classify such services in Class 35: Practice Amendment Notice (PAN 6/05).

## UPDATE

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **370 The Nice Classification**

TEXT AND NOTES 1, 2--See now Trade Marks Rules 2008, SI 2008/1797, r 7(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(iv) Classification of Goods and Services/371. Application may relate to more than one class.

### **371. Application may relate to more than one class.**

An application may be made for registration in more than one class<sup>1</sup> of goods or services<sup>2</sup>. Every application must specify the class<sup>3</sup> to which it relates and the goods or services which are appropriate to that class<sup>4</sup>. The goods or services must be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the classes<sup>5</sup>. If the application relates to more than one class, the specification<sup>6</sup> contained in it must set out the classes in consecutive numerical order and the specification of the goods or services must be grouped accordingly<sup>7</sup>. If the specification contained in the application lists items by reference to a class in which they do not fall, the applicant may request, by filing the appropriate form<sup>8</sup>, that his application be amended to include the appropriate class for those items; and, upon the payment of such class fee as may be appropriate, the registrar must amend his application accordingly<sup>9</sup>. Where the application does not satisfy the requirements as to specification of the classes and goods or services<sup>10</sup>, the registrar must send<sup>11</sup> notice of this to the applicant<sup>12</sup>. The notice must specify a period, of not less than two months, within which the applicant must satisfy those requirements<sup>13</sup>. Where the applicant fails to satisfy those requirements before the expiry of that period, his application must be treated as abandoned<sup>14</sup>.

1    Ie more than one class in the Nice Classification: see PARA 370 ante.

2    Trade Marks Rules 2000, SI 2000/136, r 8(1) (amended by SI 2006/3039). As to the registrar's duty to notify the applicant of any deficiency under the Trade Marks Rules 2000, SI 2000/136, r 8 (as amended) see PARA 363 ante. As to the registrar see PARA 17 ante.

3    Ie the class in the Nice Classification: see PARAS 369-370 ante.

4    Trade Marks Rules 2000, SI 2000/136, r 8(2) (r 8(2), (3) substituted by SI 2004/947; and amended by SI 2006/3039). The applicant should exercise care in specifying the class of the goods or services, since it may not be possible to change this by a subsequent amendment: see *Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, [2002] RPC 639; and PARA 375 post.

5    Trade Marks Rules 2000, SI 2000/136, r 8(2) (as substituted and amended: see note 4 supra). The classes referred to are those in the Nice Classification: see PARAS 369-370 ante.

6    For the meaning of 'specification' see PARA 369 note 1 ante.

7    Trade Marks Rules 2000, SI 2000/136, r 8(3) (as substituted and amended: see note 4 supra).

8    The appropriate form is Form TM3A. As to the use of forms see PARA 353 ante. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

9    Trade Marks Rules 2000, SI 2000/136, r 8(4) (amended by SI 2006/3039). It would appear that such an amendment is permissible under the Trade Marks Act s 39(2) (see PARA 375 post) on the basis that it is an obvious mistake: *Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, [2002] RPC 639; *Auntie G Ltd's Trade Mark Application* (O/083/04), Appointed Person. As to fees see PARA 16 ante.

10   Ie the requirements in the Trade Marks Rules 2000, SI 2000/136, r 8(2)(b), (3) (as substituted and amended) (see the text to notes 4, 7 supra).

11   For the meaning of 'send' see PARA 25 note 14 ante.

12   Trade Marks Rules 2000, SI 2000/136, r 8A(1) (r 8A added by SI 2004/947).

13 Trade Marks Rules 2000, SI 2000/136, r 8A(2) (as added: see note 12 supra).

14 Ibid r 8A(3) (as added: see note 12 supra).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **371 Application may relate to more than one class**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 8, 9.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(v) Examination of Application/372. Applications for registration of United Kingdom trade marks.

## **(v) Examination of Application**

### **372. Applications for registration of United Kingdom trade marks.**

The registrar<sup>1</sup> must examine whether an application for registration<sup>2</sup> of a trade mark<sup>3</sup> satisfies the requirements of the Trade Marks Act 1994, including any requirements imposed by rules<sup>4</sup>. For that purpose he must carry out a search, to such extent as he considers necessary, of earlier trade marks<sup>5</sup>.

In practice, following receipt of the application, if the registrar considers that objections exist, he writes to the applicant indicating what these are. Sometimes such objections can be settled by correspondence. The applicant may ask for a hearing<sup>6</sup>. The nature of the objection may be such<sup>7</sup> that it can be overcome by evidence<sup>8</sup>.

1 As to the registrar see PARA 17 ante.

2 As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARAS 352 et seq ante, 374 et seq post.

3 For the meaning of 'trade mark' see PARA 57 ante.

4 Trade Marks Act 1994 s 37(1). As to the formal requirements to be satisfied by the applicant see PARA 363 ante; as to the substantive requirements for registrability see PARA 55 et seq ante; and as to the making of rules generally see PARA 15 ante.

The registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by the Trade Marks Act 1994: see s 70(2); and PARA 18 ante.

5 Ibid s 37(2). For the meaning of 'earlier trade mark' see PARA 70 ante. The primary purpose of the search is to identify potentially conflicting earlier rights: see PARA 70 et seq ante.

As from 1 October 2007 the Trade Marks Act 1994 s 37(2) is to cease to have effect, and instead the registrar may, in connection with an examination under s 37(1) (see the text to notes 1-4 supra), carry out a search of earlier trade marks for the purpose of notifying the applicant and other persons about the existence of earlier trade marks that might be relevant to the proposed registration: see s 8(2)(a), (3); the Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, arts 3, 4 (not yet in force); and PARA 82 ante.

6 See the Trade Marks Rules 2000, SI 2000/136, r 54; and PARA 358 ante.

7 Eg based on the requirement for distinctiveness: see PARA 60 ante.

8 As to the registrar's power to direct the filing of documents, information and evidence see PARA 358 ante; and as to evidence see PARA 359 ante.

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **372 Applications for registration of United Kingdom trade marks**

NOTE 5--As to notifying the results of a search under SI 2007/1976 art 4 see Trade Marks Rules 2008, SI 2008/1797 r 14.

NOTE 6--See now SI 2008/1797 r 63.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(v) Examination of Application/373. Applications for protection of international registrations.

### **373. Applications for protection of international registrations.**

Upon receiving from the International Bureau<sup>1</sup> notification of an international registration designating the United Kingdom<sup>2</sup>, the registrar<sup>3</sup> must examine whether it satisfies the requirements of the Trade Marks Act 1994, including any requirements imposed by rules<sup>4</sup> as they apply to international registrations<sup>5</sup>. For that purpose, he must carry out a search, to such extent as he considers necessary, of earlier trade marks<sup>6</sup>. If it appears to the registrar that these requirements are not met, or are met only in relation to some of the goods or services in respect of which protection in the United Kingdom has been requested, he must give notice of provisional refusal<sup>7</sup> to the International Bureau<sup>8</sup>. Where the International Bureau notifies the registrar<sup>9</sup> that a particular term used to indicate any of the goods and services included in the international registration is too vague for the purpose of classification or is incomprehensible or is linguistically incorrect then the registrar may give notice of provisional refusal to the International Bureau in respect of that term<sup>10</sup>. In either case, the notice of provisional refusal must specify a period within which the holder of the international registration may then make representations to the registrar<sup>11</sup>. In such cases notices of provisional refusal must not be given after the expiry of the period of 18 months from the date on which the notification of the request for protection was sent to the United Kingdom<sup>12</sup>.

1 As to the International Bureau see PARAS 8 note 11, 12 note 5 ante.

2 For the meaning of 'international registration designating the United Kingdom' see PARA 13 ante.

3 As to the registrar see PARA 17 ante.

4 Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(1), applying art 3.

5 See *ibid* art 3, which applies the requirements of the Trade Marks Act 1994 and rules, with certain exceptions, to international registrations: see PARA 365 ante.

6 Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(2). For the meaning of 'earlier trade mark' see PARA 70 ante.

7 Notices of provisional refusal must set out the matters required by the Madrid Protocol art 5 and the Common Regulations r 17: Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(3) (art 11 substituted by SI 2002/692). As to the Madrid Protocol see PARA 8 ante; and as to the Common Regulations see PARA 11 note 5 ante.

8 Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(3) (amended by SI 2002/692).

9 *Ie* under the Common Regulations r 13(2)(b).

10 Trade Marks (International Registration) Order 1996, SI 1996/714, art 9A(1) (art 9A added by SI 2004/948).

11 Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(4) (amended by SI 2002/692); Trade Marks (International Registration) Order 1996, SI 1996/714, art 9A(2) (as added: see note 10 ante). For these purposes, the holder must file an address for service: arts 9(5), 9A(3) (art 9A(3) as so added; and amended by SI 2006/763); and see PARA 357 ante.

12 Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(1) (as substituted: see note 7 *supra*). Notice of provisional refusal may be given after this period where it is based on an opposition: art 11(1) (as so substituted). As to opposition proceedings see PARA 384 post.



## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **373 Applications for protection of international registrations**

TEXT AND NOTES--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(v) Examination of Application/374. Withdrawal or restriction of application.

### **374. Withdrawal or restriction of application.**

The applicant may at any time withdraw his application for registration of a trade mark or restrict the goods or services covered by the application<sup>1</sup>. If the application has been published<sup>2</sup>, the withdrawal or restriction must also be published<sup>3</sup>.

<sup>1</sup> Trade Marks Act 1994 s 39(1). For the meaning of 'trade mark' see PARA 57 ante. As to whether the applicant may offer a restriction conditionally or must do so unconditionally see *Sensornet Ltd's Trade Mark Application* [2007] RPC 185, Appointed Person. Cf the following decisions made under EC Council Regulation 40/94 (OJ L1, 14.1.94, p 1) on the Community trade mark, reg 44(1) (see PARA 280 ante): Case T-219/00 *Ellos v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2002] ECR II-753, [2002] IP & T 384, CFI; Case T-396/02 *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR II-3821, [2004] All ER (D) 157 (Nov), CFI; Case C-412/05 *Alcon Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] All ER (D) 238 (Apr), ECJ.

<sup>2</sup> For the meaning of 'publish' see PARA 17 note 10 ante.

<sup>3</sup> Trade Marks Act 1994 s 39(1). See also the Trade Marks Rules 2000, SI 2000/136, r 18(1); and PARA 375 post.

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **374 Withdrawal or restriction of application**

NOTE 3--See now Trade Marks Rules 2008, SI 2008/1797, r 25(1).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(v) Examination of Application/375. Correction and amendment of application.

### **375. Correction and amendment of application.**

Apart from amendments restricting the scope of goods or services covered by an application for registration of a trade mark<sup>1</sup>, in other respects an application may be amended, at the request of the applicant, only by correcting:

- 508 (1) the name or address of the applicant;
- 509 (2) errors of wording or of copying; or
- 510 (3) obvious mistakes,

and then only where the correction does not substantially affect the identity of the trade mark<sup>2</sup> or extend the goods or services covered by the application<sup>3</sup>. A request for an amendment of an application to correct an error or to change the name or address of the applicant or in respect of any amendment requested after publication of the application must be made on the appropriate form<sup>4</sup>.

Where a request is made for amendment of an application<sup>5</sup> which has been published and the amendment affects the representation of the trade mark or the goods or services covered by the application, the amendment or a statement of the effect of the amendment must also be published<sup>6</sup>.

Any person claiming to be affected by the amendment may, within one month of the date on which the amendment or a statement of the effect of the amendment was published<sup>7</sup>, give notice to the registrar of opposition to the amendment<sup>8</sup>. Such notice must include a statement of the grounds of objection which must, in particular, indicate why the amendment would not be permissible<sup>9</sup>.

1 le pursuant to the Trade Marks Act 1994 s 39(1): see PARA 374 ante.

2 A correction does not substantially affect the identity of the trade mark if the differences are sufficiently insignificant that they are likely to go unnoticed by the average consumer: see *Sony Ericsson Mobile Communications AB's Trade Mark Applications* (O/138/06), Appointed Person; but cf Case T-128/99 *Signal Communications Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2001] ECR II-3273, CFI.

3 Trade Marks Act 1994 s 39(2). This restriction is designed to prevent an applicant stealing a march on a rival in a case of conflicting rights where the identity of a mark applied for or the scope of goods and services covered by an application filed on a particular date may be crucial. It is always open to an applicant to file an additional new application with the changed mark or the extra goods or services which he wishes to cover, but the new application will have a later date. Thus an amendment to the application to change the class of the goods specified is not permissible under s 39(2) unless the class originally stated was an obvious mistake (*Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, [2002] RPC 639); nor are amendments to limit the colour and specify the size of a shape mark permissible under the Trade Marks Act 1994 s 39(2) (*Nestlé SA's Trade Mark Application* [2004] EWCA Civ 1008, [2005] RPC 77, sub nom *Société des Produits Nestlé SA v Mars UK Ltd* [2005] IP & T 551).

4 Trade Marks Rules 2000, SI 2000/136, r 17. The appropriate form is Form TM21: r 17. As to the use of forms see PARA 353 ante.

5 le pursuant to the Trade Marks Act 1994 s 39: see the text and notes 1-3 supra; and PARA 374 ante.

6 Ibid s 39(3); Trade Marks Rules 2000, SI 2000/136, r 18(1). For the meaning of 'publish' see PARA 17 note 10 ante.

7 Ie under ibid r 18(1): see the text and notes 5-6 supra.

8 Ibid r 18(2) (substituted by SI 2004/947). The notice must be given on Form TM7: Trade Marks Rules 2000, SI 2000/136, r 18(2) (as so substituted).

9 Ibid r 18(2) (as substituted: see note 8 supra). The registrar must send a copy of the Form TM7 to the applicant, and the provisions of rr 13A-14 (rr 13A-13C as added; r 14 as amended) (see PARAS 384-385 post) apply to proceedings relating to the opposition to the amendment of the application as they apply to proceedings relating to opposition to the registration of a trade mark with certain modifications: r 18(3) (substituted by SI 2004/947).

## **UPDATE**

### **352-375 Business hours and business days ... Correction and amendment of application**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (amended by SI 2008/2300, SI 2008/2683, SI 2009/546, SI 2009/2089).

### **375 Correction and amendment of application**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 24, 25.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(v) Examination of Application/376. Disclaimer or limitation of application.

### **376. Disclaimer or limitation of application.**

An applicant for registration<sup>1</sup> of a trade mark<sup>2</sup> may<sup>3</sup>:

- 511 (1) disclaim any right to the exclusive use<sup>4</sup> of any specified element of the trade mark<sup>5</sup>; or
- 512 (2) agree that the rights conferred by the registration are to be subject to a specified territorial or other limitation<sup>6</sup>.

Disclaimers and limitations can similarly be made in relation to an international trade mark for which protection is sought in the United Kingdom<sup>7</sup>.

1 For the meaning of 'registration' see PARA 19 note 2 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 Trade Marks Act 1994 s 13(1). The proprietor of a registered trade mark may also make disclaimers and limitations: see PARA 394 post. As to the making of such disclaimers and limitations see PARA 83 ante. As to the effect of such disclaimers and limitations on the proprietor's rights see PARA 98 ante.

4 For the meaning of 'use' see PARA 60 note 8 ante.

5 Trade Marks Act 1994 s 13(1)(a).

6 Ibid s 13(1)(b).

7 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(4), (5) (art 4(4) amended, and art 4(5) substituted, by SI 2002/692).

### **UPDATE**

### **376 Disclaimer or limitation of application**

NOTE 7--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(v) Examination of Application/377. Correction of international registrations.

### **377. Correction of international registrations.**

Where the International Bureau<sup>1</sup> notifies<sup>2</sup> the registrar<sup>3</sup> that it has corrected an international registration designating the United Kingdom<sup>4</sup>, and the correction either substantially affects the identity of the trade mark<sup>5</sup> or reduces or extends the goods or services comprised in the international registration, the registrar may treat such a notification of correction as a new notification of an international registration designating the United Kingdom<sup>6</sup>.

1 As to the International Bureau see PARAS 8 note 11, 12 note 5 ante.

2 Ie pursuant to the Common Regulations r 28. As to the Common Regulations see PARA 11 note 5 ante.

3 As to the registrar see PARA 17 ante.

4 For the meaning of 'international registration designating the United Kingdom' see PARA 13 ante.

5 As to corrections which substantially affect the identity of a trade mark see PARA 375 note 2 ante.

6 Trade Marks (International Registration) Order 1996, SI 1996/714, art 12A(1), (2) (art 12A added by SI 2002/692). Where he does so the provisions of the Trade Marks (International Registration) Order 1996, SI 1996/714, art 12A(3) (as so added) or art 12A(4) (as so added) apply as appropriate.

### **UPDATE**

### **377 Correction of international registrations**

NOTE 6--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(vi) Priority of Convention and Overseas Applications/378. Claim to priority of Convention application.

## **(vi) Priority of Convention and Overseas Applications**

### **378. Claim to priority of Convention application.**

A person who has duly filed an application for protection of a trade mark<sup>1</sup> in a Convention country<sup>2</sup> (a 'Convention application'), or his successor in title, has a right to priority<sup>3</sup>, for the purposes of registering the same trade mark under the Trade Marks Act 1994 for some or all of the same goods or services, for a period of six months from the date of filing<sup>4</sup> of the first such application<sup>5</sup>. If the application for registration under the Act is made within that six month period<sup>6</sup>:

- 513 (1) the relevant date for the purpose of establishing which rights take precedence is the date of filing of the first Convention application<sup>7</sup>; and
- 514 (2) the registrability of the trade mark is not affected by any use<sup>8</sup> of the mark in the United Kingdom<sup>9</sup> in the period between that date and the date of the application under the Act<sup>10</sup>.

Any filing which in a Convention country is equivalent to a regular national filing<sup>11</sup>, under its domestic legislation or an international agreement, is treated as giving rise to the right of priority<sup>12</sup>.

A subsequent application<sup>13</sup> concerning the same subject as the first Convention application, filed in the same Convention country, is considered the first Convention application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and (b) it has not yet served as a basis for claiming a right of priority<sup>14</sup>. The previous application may not thereafter serve as a basis for claiming a right of priority<sup>15</sup>.

Where a right to priority is claimed by reason of an application for protection of a trade mark duly filed in a Convention country<sup>16</sup> or in another country or territory<sup>17</sup>, particulars of that claim must be included in the application for registration<sup>18</sup>; and where no certificate<sup>19</sup> is filed with the application, such particulars must include the country or countries and the date or dates of filing<sup>20</sup>. Unless it has been filed at the time of the filing of the application for registration, there must be filed, within three months of the application<sup>21</sup>, a certificate by the registering or other competent authority of that country certifying, or verifying to the satisfaction of the registrar, the date of the filing of the application, the country or registering or competent authority, the representation of the mark and the goods or services covered by the application<sup>22</sup>.

A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently<sup>23</sup>.

The above provisions apply so as to confer a right of priority in relation to protection of an international registration designating the United Kingdom<sup>24</sup> as they apply in relation to registering a trade mark under the Trade Marks Act 1994<sup>25</sup>, but the manner of claiming priority is determined in accordance with the Madrid Protocol and Common Regulations instead of following the procedure under the Trade Marks Act 1994<sup>26</sup>.

- 1 For the meaning of 'trade mark' see PARA 57 ante.
- 2 For the meaning of 'Convention country' see PARA 6 note 2 ante.
- 3 The effect of a right to priority is that the application enjoys the date of filing in the Convention country rather than the later date of filing in the United Kingdom, for the purposes of resolving conflicts with other applications or with conflicting common law rights based on use: see PARAS 70, 77 ante.
- 4 For the meaning of 'date of filing' see PARA 366 ante.
- 5 Trade Marks Act 1994 s 35(1). See also note 23 infra. Section 35 applies to an application for registration under the Trade Marks Act 1994 made on or after 31 October 1994 notwithstanding that the Convention was made before that date: Trade Marks Act 1994 s 105, Sch 3 para 13.
- 6 Ibid s 35(2).
- 7 Ibid s 35(2)(a).
- 8 As to the meaning of 'use' see PARA 60 note 8 ante. As to the burden of proving use of a trade mark see ibid s 100; and PARA 114 ante.
- 9 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.
- 10 Trade Marks Act 1994 s 35(2)(b). See also note 5 supra.
- 11 For these purposes, a 'regular national filing' means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application: ibid s 35(3). The requirement for a 'regular national filing' is satisfied by evidence of a procedurally regular filing in the relevant Convention country: *FSS Trade Mark*[2001] RPC 763, Appointed Person.
- 12 Trade Marks Act 1994 s 35(3). See also note 5 supra.
- 13 Ie presumably a subsequent application by the same applicant or a successor in title to him, although ibid s 35(4) does not expressly say so.
- 14 Ibid s 35(4). See also note 5 supra.
- 15 Ibid s 35(4).
- 16 Ie under ibid s 35.
- 17 Ie in respect of which provision corresponding to that made in ibid s 35 is made under s 36 (see PARA 379 post).
- 18 Ie under the Trade Marks Rules 2000, SI 2000/136, r 5: see PARA 363 ante.
- 19 Ie no certificate as is referred to in ibid r 6(2): see the text and notes 21-22 infra.
- 20 Trade Marks Act 1994 s 35(5); Trade Marks Rules 2000, SI 2000/136, r 6(1). See also note 5 supra.
- 21 See note 18 supra.
- 22 Trade Marks Act 1994 s 35(5); Trade Marks Rules 2000, SI 2000/136, r 6(2). See also note 5 supra.
- 23 Trade Marks Act 1994 s 35(6). The reference in s 35(1) (see the text to notes 1-5 supra) to the applicant's successor in title is to be construed accordingly: s 35(6). See also note 5 supra.
- 24 The effect of a valid claim to priority is that the international registration enjoys in the United Kingdom a date earlier than its date of registration in the event of coming into conflict with other applications or marks. For the date of the international registration, which is normally the date of filing of the international application in the office of origin, see PARAS 21, 366 ante. For the meaning of 'international registration designating the United Kingdom' see PARA 13 ante.
- 25 Trade Marks (International Registration) Order 1996, SI 1996/714, art 8(1).
- 26 See ibid art 8(2), which excludes the Trade Marks Act 1994 s 35(5) (see the text and notes 16-22 supra) from applying to claims to priority by international registrations. The Trade Marks Rules 2000, SI 2000/136, r 5



(see PARA 363 ante), which governs claims to priority, is also excluded from applying to international applications by the Trade Marks (International Registration) Order 1996, SI 1996/714, art 3(2). As to the Madrid Protocol see PARA 8 ante; and as to the Common Regulations see PARA 11 note 5 ante.

## **UPDATE**

### **378 Claim to priority of Convention application**

TEXT AND NOTES--SI 2000/136 rr 5, 6 now Trade Marks Rules 2008, SI 2008/1797, rr 5, 6 (r 5 amended by SI 2009/2089).

TEXT AND NOTES 24-26--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(vi) Priority of Convention and Overseas Applications/379. Claim to priority from other relevant overseas application; new applications.

### **379. Claim to priority from other relevant overseas application; new applications.**

Her Majesty may by Order in Council make provision for conferring on a person who has duly filed an application for protection of a trade mark<sup>1</sup> in:

- 515 (1) any of the Channel Islands or a colony; or
- 516 (2) a country or territory in relation to which Her Majesty's government in the United Kingdom has entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks,

a right to priority, for the purpose of registering the same trade mark under the Trade Marks Act 1994 for some or all of the same goods or services, for a specified period from the date of filing<sup>2</sup> of that application<sup>3</sup>.

A person who has duly filed<sup>4</sup> an application for the protection of a trade mark in a relevant country<sup>5</sup> has a right to priority, for the purpose of registering the same trade mark under the Trade Marks Act 1994 for some or all of the same goods or services, for a period of six months from the date of filing of the application in that country<sup>6</sup>. Where the application for registration under the Act is made within that period of six months: (a) the relevant date for the purpose of establishing which rights take precedence is the date of the filing of the application in the relevant country; and (b) the registrability of the trade mark is not affected by any use of the mark in the United Kingdom<sup>7</sup> in the period between that date and the date of the application under the Trade Marks Act 1994<sup>8</sup>.

A subsequent application concerning the same subject as the first application, duly filed in the same relevant country, is considered the first application to be filed in that country (of which the filing date is the starting date of the period of priority) if at the time of the subsequent application: (i) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and (ii) it has not yet served as a basis for claiming right of priority<sup>9</sup>.

A previous application may not, however, serve as a basis for claiming a right of priority where a subsequent application is so considered as the first application to be filed<sup>10</sup>.

A right to priority so conferred vests in the person filing the application or his successors in title, unless otherwise stated in the application, and may be assigned or otherwise transmitted, either with the application or independently<sup>11</sup>.

Where a right to priority is claimed by reason of such an application, particulars of that claim must be included in the application for registration filed under the Trade Marks Act 1994; and unless a certificate<sup>12</sup> is filed with the application, such particulars must include the relevant country and the date of filing<sup>13</sup>. There must be filed within three months of the filing of the application for registration under the Act a certificate by the registering or other competent authority of the relevant country certifying, or verifying to the satisfaction of the registrar: (A) the date of the filing of the application; (B) the relevant country or registering or competent authority; (C) the representation of the mark; and (D) the goods or services covered by the application<sup>14</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 For the meaning of 'date of filing' see PARA 366 ante.

3 Trade Marks Act 1994 s 36(1). Any such Order in Council may make provision corresponding to that made by s 35 (see PARA 378 ante) in relation to Convention countries or such other provision as appear to Her Majesty to be appropriate: s 36(2). A statutory instrument containing any such Order in Council is subject to annulment in pursuance of a resolution of either House of Parliament: s 36(3). For the meaning of 'Convention country' see PARA 6 note 2 post.

As to the order that has been made see the Trade Marks (Claims to Priority from Relevant Countries) Order 1994, SI 1994/2803 (amended by SI 1995/2997). The order, as originally enacted, came into force on 5 December 1994: Trade Marks (Claims to Priority from Relevant Countries) Order 1994, SI 1994/2803, art 1.

4 For these purposes, 'duly filed' means a filing which is adequate to establish the date on which the application was filed in the relevant country in question, whatever may be the subsequent fate of the application: *ibid* art 2.

5 For these purposes, 'relevant country' means Antigua and Barbuda, Bahrain, Belize, Bolivia, Botswana, Brunei Darussalam, Colombia, Djibouti, Dominica, Ecuador, Guatemala, Hong Kong, India, Jamaica, Kuwait, Macau, Maldives, Mozambique, Myanmar, Namibia, Nicaragua, Pakistan, Sierra Leone, Thailand: *ibid* art 2, Schedule (substituted by SI 1995/2997).

6 Trade Marks (Claims to Priority from Relevant Countries) Order 1994, SI 1994/2803, art 3.

7 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

8 Trade Marks (Claims to Priority from Relevant Countries) Order 1994, SI 1994/2803, art 4.

9 *Ibid* art 5.

10 *Ibid* art 6.

11 *Ibid* art 7.

12 *Ie* a certificate as is referred to in *ibid* art 8(2): see the text to note 14 *infra*.

13 *Ibid* art 8(1).

14 *Ibid* art 8(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(vi) Priority of Convention and Overseas Applications/380. Claim to priority from other relevant overseas application; old applications.

### **380. Claim to priority from other relevant overseas application; old applications.**

Where before 31 October 1994 a person duly filed an application for protection of a trade mark<sup>1</sup> in a relevant country<sup>2</sup> which is not a Convention country (a 'relevant overseas application'), he, or his successor in title, has a right to priority, for the purposes of registering the same trade mark under the Trade Marks Act 1994 for some or all of the same goods or services, for a period of six months from the date of filing of the relevant overseas application<sup>3</sup>.

If the application for registration under the Act is made within that six month period: (1) the relevant date for the purposes of establishing which rights take precedence is the date of filing of the relevant overseas application; and (2) the registrability of the trade mark is not affected by any use of the mark in the United Kingdom<sup>4</sup> in the period between that date and the date of the application under the Act<sup>5</sup>.

Any filing which in a relevant country is equivalent to a regular national filing<sup>6</sup>, under its domestic legislation or an international agreement, is treated as giving rise to the right of priority<sup>7</sup>.

A subsequent application concerning the same subject as the relevant overseas application, filed in the same country, is considered the relevant overseas application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application:

- 517 (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- 518 (b) it has not yet served as a basis for claiming a right of priority<sup>8</sup>.

The previous application may not thereafter serve as a basis for claiming a right of priority<sup>9</sup>.

A right to priority arising as a result of a relevant overseas application may be assigned or otherwise transmitted, either with the application or independently<sup>10</sup>.

1 For the meaning of 'trade mark' see PARA 57 ante.

2 'Relevant country' meant a country which was specified in an Order in Council under the Trade Marks Act 1938 s 39A (as added) at the time of the application under s 38A (as added) or such other time as might be specified in the Order in Council: s 39A(10) (added by the Patents, Designs and Marks Act 1986 s 2(2), Sch 2 para 5). The Trade Marks Act 1938 was repealed by the Trade Marks Act 1994 s 106(2), Sch 5. The Order in Council so made was the Trade Marks and Service Marks (Relevant Countries) Order 1986, SI 1986/1303 (amended by SI 1986/1890; SI 1986/2236; SI 1987/170; SI 1988/1856; SI 1990/2593; SI 1992/2672; SI 1993/1258).

3 Trade Marks Act 1994 s 105, Sch 3 para 14(1). See also note 9 infra. Nothing in Sch 3 para 14 affects proceedings on an application for registration under the Trade Marks Act 1938 made before 31 October 1994 (see the Trade Marks Act 1994 Sch 3 para 10; and PARA 363 ante): Sch 3 para 14(7).

Provision may be made by rules as to the manner of claiming a right to priority on the basis of a relevant overseas application: Sch 3 para 14(5).

4 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

5 Trade Marks Act 1994 Sch 3 para 14(2).

6 For these purposes, a 'regular national filing' means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application: *ibid* Sch 3 para 14(3).

7 *Ibid* Sch 3 para 14(3).

8 *Ibid* Sch 3 para 14(4).

9 *Ibid* Sch 3 para 14(4).

10 *Ibid* Sch 3 para 14(6). The reference in Sch 3 para 14(1) (see the text to notes 1-3 *supra*) to the applicant's 'successor in title' is to be construed accordingly: Sch 3 para 14(6).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(vii) Acceptance or Refusal of Application or of International Registration/381. Acceptance or refusal of application for a registered trade mark.

## **(vii) Acceptance or Refusal of Application or of International Registration**

### **381. Acceptance or refusal of application for a registered trade mark.**

If it appears to the registrar<sup>1</sup> that the requirements for registration<sup>2</sup> are not met, he must inform the applicant and give him an opportunity, within such period as the registrar may specify, to make representations or to amend the application<sup>3</sup>. If the applicant fails to satisfy the registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period<sup>4</sup>, the registrar must refuse to accept the application<sup>5</sup>. Although there is no longer any statutory power under which the registrar may accept applications subject to amendments, disclaimers or limitations<sup>6</sup>, in practice the registrar continues to indicate to applicants cases where objection could be overcome by an appropriate amendment, disclaimer or limitation<sup>7</sup>. If, however, it appears to the registrar that the requirements for registration are met, he must accept the application<sup>8</sup>.

Where grounds for refusal of registration exist in respect of only some of the goods or services for which the trade mark has been applied for, refusal must cover those goods or services only<sup>9</sup>; and accordingly the registrar must accept the application so far as it relates to goods or services in respect of which grounds for refusal do not exist<sup>10</sup>.

1 As to the registrar see PARA 17 ante.

2 As to the requirements for registration see PARA 55 et seq ante.

3 Trade Marks Act 1994 s 37(3).

4 If there is a failure to respond before the end of the specified period, then refusal is mandatory: *POSTPERFECT Trade Mark*[1998] RPC 255, Appointed Person.

5 Trade Marks Act 1994 s 37(4). By contrast with a decision following opposition proceedings (see PARA 385 post), there is no specific requirement for the registrar to notify the applicant of a decision under this provision stating his reasons. Instead the general rule that the registrar must send the applicant written notice of the decision applies, and the applicant may then request a statement of the reasons for the decision: see the Trade Mark Rules 2000, SI 2000/136, r 62; and PARA 404 post. When refusing registration of a trade mark, the registrar is required to state in his decision his conclusion for each of the individual goods and services specified in the application, regardless of the manner in which that application was formulated; nevertheless, where the same ground of refusal is given for a category or group of goods or services, the registrar may use general reasoning for all of the goods or services: *Case C-239/05 BVBA Management, Training en Consultancy v Benelux Merkenbureau* [2007] ETMR 35, [2007] All ER (D) 187 (Feb), ECJ. As to appeals from decisions of the registrar see PARA 405 et seq post.

6 *Ie* as there was under the Trade Marks Act 1938 s 17(2) (repealed). As to disclaimers and limitations see PARA 83 ante.

7 *Eg* a disclaimer of an element of the mark applied for, or a territorial limitation might overcome an objection of lack of distinctiveness: see PARA 83 ante.

8 Trade Marks Act 1994 s 37(5); *EUROLAMB Trade Mark*[1997] RPC 279, Appointed Person; *Procter & Gamble Ltd's Trade Mark Applications*[1999] RPC 673, [1999] ETMR 816, CA; and see further PARA 55 ante. In this respect the Trade Marks Act 1994 differs from the Trade Marks Act 1938, which gave the registrar a residual discretion to refuse registration of a mark even if it met the statutory requirements.

9 EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks, art 13. These provisions have no counterpart in the Trade Marks Act 1994 s 37 (cf s 46(5) (see PARA 117 ante) and s 47(5) (see PARA 120 ante), but nevertheless they are binding upon the registrar: *MISTER LONG Trade Mark*[1998] RPC 401, Appointed Person; *Nettec Solutions Ltd's Trade Mark Application*[2003] RPC 308, Appointed Person; *Sensornet Ltd's Trade Mark Application*[2007] RPC 185, Appointed Person.

10 *Sensornet Ltd's Trade Mark Application*[2007] RPC 185, Appointed Person. It is unclear whether this enables the registrar to re-write the specification of goods or only to apply a blue-pencil test, but the registrar's current practice is that proposals to re-word specifications must be put forward by the applicant: Practice Amendment Notice (PAN 14/06).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **381 Acceptance or refusal of application for a registered trade mark**

NOTE 5--SI 2000/136 r 62 now Trade Marks Rules 2008, SI 2008/1797, r 69.

TEXT AND NOTE 9--Directive 89/104 art 13 replaced in same terms: European Parliament and EC Council Directive 2008/95 art 13 (OJ L299, 8.11.2008, p 25).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(vii)

Acceptance or Refusal of Application or of International Registration/382. Decision as to whether to uphold notice of provisional refusal of protection for international registration.

### **382. Decision as to whether to uphold notice of provisional refusal of protection for international registration.**

Where the registrar<sup>1</sup> has given notice of provisional refusal<sup>2</sup> to the International Bureau<sup>3</sup>, the registrar must decide whether the provisional refusal will be upheld<sup>4</sup> in whole or in relation to some only of the goods or services in relation to which protection in the United Kingdom is requested and notify the International Bureau accordingly<sup>5</sup>.

1 As to the registrar see PARA 17 ante.

2 I.e. notice of provisional refusal pursuant to the Trade Marks (International Registration) Order 1996, SI 1996/714, art 9(3) (as amended) (see PARA 373 ante), art 9A(1) (as added) (see PARA 373 ante), or art 10A(5) (as added) (see PARA 384 post).

3 As to the International Bureau see PARAS 8 note 11, 12 note 5 ante.

4 I.e. in the light of the representations made by the holder (if any) (see PARA 372 ante) or in the light of the parties' evidence and argument in opposition proceedings (see PARA 384 post).

5 Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(4) (substituted by SI 2002/692; and amended by SI 2004/948). If and to the extent that the notice of provisional refusal is upheld, the request for extension of protection will stand refused subject to any appeal. If and to the extent that the notice of provisional refusal is not upheld, it is implicit that the registrar must publish a notice under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (see PARA 383 post). If there is an appeal to the appointed person or the court against a decision to uphold a notice of provisional refusal, the registrar must notify the International Bureau of the decision of the appointed person or the court: art 11(5) (substituted by SI 2002/692).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **382 Decision as to whether to uphold notice of provisional refusal of protection for international registration**

TEXT AND NOTES--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(vii) Acceptance or Refusal of Application or of International Registration/383. Publication of applications.

### **383. Publication of applications.**

When an application for registration of a trade mark<sup>1</sup> has been accepted, the registrar<sup>2</sup> must publish<sup>3</sup> the application<sup>4</sup>. If the essential features of the mark are not clearly depicted, the registrar ought to re-publish the application in correct form and the opposition period will start from the date of re-publication<sup>5</sup>.

Similarly, where following examination<sup>6</sup> of an application for protection of an international registration<sup>7</sup>, it appears to the registrar that the application is entitled to protection<sup>8</sup> in relation to all or some of the goods or services specified in the international registration, the registrar must publish a notice specifying particulars of the international registration and the goods and services for which protection is to be conferred<sup>9</sup>.

1 As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see the text and notes 2-5 infra; and PARAS 352 et seq ante, 384 et seq post. For the meaning of 'trade mark' see PARA 57 ante.

2 As to the registrar see PARA 17 ante.

3 For the meaning of 'publish' see PARA 17 note 10 ante.

4 Trade Marks Act 1994 s 38(1); Trade Marks Rules 2000, SI 2000/136, r 12.

5 *CREOLA Trade Mark* [1997] RPC 507; *Andreas Stihl AG & Co's Trade Mark Application* [2001] RPC 215, Appointed Person. As to opposition see PARA 384 et seq post.

6 I.e. an examination under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 9: see PARA 373 ante. It is implicit that, if the registrar decides in the light of representations made by the holder not to uphold a notice of provisional refusal under r 9(3) (as amended) (see PARA 373 ante) or r 9A(1) (as added) (see PARA 373 ante) he must follow the same procedure.

7 For the meaning of 'international registration' see PARA 12 note 2 ante.

8 I.e. that it satisfies the requirements of the Trade Marks Act 1994, including any requirements imposed by rules, as they apply to international registrations: see PARA 373 ante.

9 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (substituted by SI 2004/948). Unless this notice is published at least four months before the expiry of the period of 18 months from the date on which the notification of the request for protection was sent to the United Kingdom, the registrar must inform the International Bureau that oppositions may be filed after the expiry of that period: Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(2) (substituted by SI 2002/692). As to the International Bureau see PARAS 8 note 11, 12 note 5 ante.

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **383 Publication of applications**

TEXT AND NOTES 1-4--See now Trade Marks Rules 2008, SI 2008/1797, r 16.

NOTES 6, 9--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(viii) Opposition Proceedings/384. Opposition proceedings.

## **(viii) Opposition Proceedings**

### **384. Opposition proceedings.**

Any person<sup>1</sup> may give notice to the registrar<sup>2</sup> of opposition to the registration of a trade mark<sup>3</sup> within three months of the date on which the application was published<sup>4</sup>; and the notice must include a statement of the grounds<sup>5</sup> of opposition<sup>6</sup>. Where the opposition is based on an earlier trade mark<sup>7</sup>, the statement of grounds must include a representation of that mark, details of the authority with which that mark is registered or has been applied for, the registration or application number of that mark, the classes<sup>8</sup> in respect of which that mark is registered or has been applied for, and the goods and services in respect of which that mark is registered or has been applied for and in respect of which the opposition is based<sup>9</sup>. In addition, where the earlier trade mark has been registered and the registration procedure for that mark was completed before the period of five years ending with the date of publication of the application, the statement of grounds must include a statement detailing whether during the relevant period<sup>10</sup> the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use<sup>11</sup> (a 'statement of use')<sup>12</sup>. Where the opposition is based on an unregistered trade mark or other sign which the opponent claims to be protected by virtue of any rule of law (in particular the law of passing off)<sup>13</sup>, the statement of grounds must include a representation of that mark or sign and the goods or services in respect of which such protection is claimed<sup>14</sup>.

Similarly, within three months of the date of publication by the registrar of a notice that protection will be conferred upon an international registration<sup>15</sup>, any person may give notice to the registrar of opposition to the conferring of protection<sup>16</sup>. The requirements as to form and service of the notice of opposition are the same as those applying to notice of opposition to the registration of a United Kingdom registered trade mark<sup>17</sup>, and the procedural steps described below apply equally to both kinds of oppositions except where indicated<sup>18</sup>. In addition, however, where notice of opposition to the conferring of protection on an international registration has been given the registrar must, within four months of the publication of the notice that protection is to be conferred<sup>19</sup>, give notice of provisional refusal to the International Bureau<sup>20</sup> stating the grounds on which the opposition is based<sup>21</sup>.

The registrar must send a copy of the appropriate form<sup>22</sup> to the applicant for the United Kingdom registered trade mark, or in the case of an international registration, the holder<sup>23</sup>. The date on which this is done is the 'notification date'<sup>24</sup>. The applicant or holder must then file the relevant form<sup>25</sup>, which must include a counter-statement within the relevant period<sup>26</sup>. The relevant period for this purpose is:

- 519 (1) unless either head (2) or head (3) below applies, the period beginning on the notification date and ending three months after that date<sup>27</sup>;
- 520 (2) where the applicant and the opponent agree to an extension of time for filing<sup>28</sup>, within the period of three months either party files the necessary form<sup>29</sup> requesting such an extension of time and during the period beginning on the date that form was filed and ending 12 months after the notification date no notice to continue<sup>30</sup> is filed by the opponent, the period beginning on the notification date and ending 12 months after that date<sup>31</sup>;

521 (3) where a request for an extension of time for filing<sup>32</sup> has been filed<sup>33</sup> and the opponent has filed a notice to continue<sup>34</sup>, the period beginning on the notification date and ending three months after that date or one month after the date on which the notice to continue was filed, whichever is the later<sup>35</sup>.

If the applicant fails to file the necessary form<sup>36</sup> and counter-statement within the relevant period, the application is deemed withdrawn<sup>37</sup>. Similarly, if the holder of the international registration fails to file the necessary form<sup>38</sup> and counter-statement within the relevant period, the registrar must notify the International Bureau that the provisional refusal has been upheld<sup>39</sup>.

The registrar must send a copy of the form<sup>40</sup> (including the counter-statement) to the opponent<sup>41</sup>. Unless the registrar gives a preliminary indication, the date upon which this is done is the 'initiation date'<sup>42</sup>. If the opposition or part of it is based on the relative grounds of refusal<sup>43</sup>, then unless the registrar indicates to the parties that he thinks it is inappropriate to do so, the registrar must consider the statement of the grounds of opposition and the counter-statement and notify the parties whether it appears to him that the mark should or should not be registered in respect of the goods and services listed in the application (a 'preliminary indication')<sup>44</sup>. Where such notification is sent the date upon which it is sent is the 'indication date'<sup>45</sup>. If the registrar's preliminary indication is that the mark should be registered for all the goods and services listed in the application, then the opponent must file a notice of intention to proceed<sup>46</sup> or else he will be deemed to have withdrawn his opposition<sup>47</sup>. If the registrar's preliminary indication is that the mark should be registered for some, but not all, of the goods and services listed in the application, then the applicant will be deemed to have withdrawn his application unless either the applicant or the opponent files a notice of intention to proceed<sup>48</sup> within one month of the indication date or the applicant requests the amendment of his application so that it only relates to those goods and services<sup>49</sup> within a further month<sup>50</sup>. If the registrar's preliminary indication is that the mark should not be registered for any of the goods and services listed in the application, then the applicant must file a notice of intention to proceed<sup>51</sup> within month one of the indication date or else he will be deemed to have withdrawn the application<sup>52</sup>. If a notice of intention to proceed is filed by either party, the registrar must send a copy of that notice to all the other parties; and the date upon which this is done is then the 'initiation date'<sup>53</sup>.

Within three months of the initiation date, the opponent must file<sup>54</sup> any evidence he considers necessary to adduce in support of his opposition<sup>55</sup>. Where the opposition is based on an earlier trade mark the registration procedure for which was completed before the start of the period of five years ending with the date of publication, and the applicant or holder has either denied or not admitted the truth of a matter set out in the statement of use, the opponent must also file<sup>56</sup> evidence supporting the statement of use<sup>57</sup>. If the opponent files no such evidence, he is deemed, unless the registrar otherwise directs, to have withdrawn his opposition<sup>58</sup>. The registrar must notify the applicant or holder of any such direction<sup>59</sup>.

If the opponent files evidence or the registrar notifies the applicant or holder of such a direction, the applicant may, within three months of the evidence being filed or the registrar sending him such notification, file<sup>60</sup> any evidence he may consider necessary to adduce in support of his application<sup>61</sup>.

Where the applicant or holder files evidence, the opponent may, within three months of such evidence being filed, file<sup>62</sup> evidence in reply which must be confined to matters strictly in reply to the applicant's or holder's evidence<sup>63</sup>.

The registrar may at any time, if he thinks fit, give leave to either party to file<sup>64</sup> evidence upon such terms as he thinks fit<sup>65</sup>.

When the periods for filing evidence have expired, the registrar must request that the parties give written notice of whether they wish to be heard<sup>66</sup>. If a hearing is requested by any party to the proceedings, the registrar must send to the parties notice of a date for the hearing<sup>67</sup>.

1 The opponent does not have to show that he is aggrieved by, or otherwise interested in, the application: *Pharmedica GmbH's Trade Mark Application*[2000] RPC 536, [2000] All ER (D) 28; cf *Oystertec plc's Patent*[2002] EWHC 2324 (Pat), [2003] RPC 559, sub nom *Oystertec plc v Edward Evans Barker*[2003] IP & T 1015. When an opponent transfers to another person the interest which he is seeking to protect by means of the opposition, eg upon sale of the relevant business or earlier trade mark, the registrar has a discretion to permit the substitution of that person as opponent, even in the absence of any explicit statutory power under the Trade Marks Act 1994 or rules authorising such a substitution: *Pharmedica GmbH's Trade Mark Application* supra.

2 As to the registrar see PARA 17 ante.

3 For the meaning of 'trade mark' see PARA 57 ante. Notice must be given on Form TM7. As to the use of forms see PARA 353 ante.

The notice must correctly identify the trade mark application sought to be opposed and the registrar has no power to put right an error made in identifying the application after the application has become registered: *DUCATI Trade Mark*[1998] RPC 227, Trade Marks Registry; cf *Andreas Stihl AG & Co's Trade Mark Application*[2001] RPC 215, Appointed Person; *BAT OUT OF HELL Trade Mark* (O/398/02), Appointed Person.

4 Ie under the Trade Marks Rules 2000, SI 2000/136, r 12: see PARA 383 ante. For the meaning of 'publish' see PARA 17 note 10 ante.

5 The statement of grounds should properly plead and particularise the material facts upon which an allegation is based; and the previous practice that led to pleadings before the Trade Marks Registry often failing to identify the issues should not continue: *Julian Higgins' Trade Mark Application*[2000] RPC 321; *CLUB EUROPE Trade Mark*[2000] RPC 329, [1999] All ER (D) 686; *DEMON ALE Trade Mark*[2000] RPC 345, Appointed Person. The Trade Marks Registry has published a Tribunal Practice Notice (TPN 1/2000) [2000] RPC 587 setting out the matters which should be contained in pleadings. Tribunal Practice Notices are available from the Patent Office or on its website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet. As to the procedural powers of the registrar see further PARA 358 ante.

6 Trade Marks Act 1994 s 38(2); Trade Marks Rules 2000, SI 2000/136, r 13(1) (r 13 substituted by SI 2004/947). The period specified in the Trade Marks Rules 2000, SI 2000/136, r 13(1) (as substituted) may not be extended: see r 68(1), (3) (r 68(3) as amended); and PARA 356 ante.

7 For the meaning of 'earlier trade mark' see PARA 70 ante. The opponent need not be the proprietor of the earlier trade mark relied upon (*BALMORAL Trade Mark*[1999] RPC 297, Appointed Person) unless the Trade Mark Act 1994 s 7(2) (see PARA 80 ante) or s 60(2) (see PARA 154 ante) applies. If it is registered, the earlier trade mark must be presumed to be validly registered unless the applicant brings separate proceedings to challenge that registration: see s 72; and PARA 110 ante.

8 As to classification of goods and services see PARA 369 et seq ante.

9 Trade Marks Rules 2000, SI 2000/136, r 13(2)(a)-(d), (3) (as substituted: see note 6 supra).

10 Ie the period specified in the Trade Marks Act 1994 s 6A(3)(a) (as added): see PARA 79 ante.

11 As to genuine use and proper reasons for non-use see PARA 114 ante.

12 Trade Marks Rules 2000, SI 2000/136, r 13(2)(e) (as substituted: see note 6 supra).

13 As to reliance upon such earlier rights see PARA 77 ante. The opponent need not be proprietor of the earlier right relied upon: *WILD CHILD Trade Mark* [1998] RPC 455, Appointed Person. As to passing off see PARA 304 et seq ante.

14 Trade Marks Rules 2000, SI 2000/136, r 13(4) (as substituted: see note 6 ante).

15 Ie a notice specifying particulars of the international registration and particulars of the goods or services for which protection in the United Kingdom will be conferred published pursuant to the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (as substituted): see PARA 383 ante. For the meaning of 'international registration' see PARA 12 note 2 ante.

16 Ibid art 10(2) (art 10 substituted by SI 2004/948).

17 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10A(1), (2)-(4) (art 10A added by SI 2004/948; and the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10A(1) amended by SI 2006/763). In addition the Form TM7 must include an address for service in the United Kingdom unless in a particular case the registrar otherwise directs: Trade Marks (International Registration) Order 1996, SI 1996/714, art 10A(1)(b), (1A) (art 10A(1)(b) as so added and amended; art 10A(1A) added by SI 2006/763; and amended by SI 2006/1080). As to address for service see PARA 357 ante.

18 The Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (art 10C added by SI 2004/948) applies the Trade Marks Rules 2000, SI 2000/136, rr 13B, 13C (both as added) (see the text and notes 44-67 infra), r 14 (as amended) (see PARA 385 post) and r 37 (see PARA 358 ante) to opposition proceedings against the conferring of protection on international registrations, with the substitution of 'the holder' for 'the applicant' and other modifications. See also the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10B (added by SI 2004/948).

19 Ie under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (as substituted): see PARA 383 ante.

20 As to the International Bureau see PARAS 8 note 11, 12 note 5 ante.

21 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10A(5) (as added: see note 17 supra).

22 Ie Form TM7. For the meaning of 'send' see PARA 25 note 14 ante.

23 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10A(6) (as added: see note 17 supra); Trade Marks Rules 2000, SI 2000/136, r 13(5) (as substituted: see note 6 supra).

24 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10A(6) (as added: see note 17 supra); Trade Marks Rules 2000, SI 2000/136, r 13(5) (as substituted: see note 6 supra).

25 Ie Form TM8. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

26 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10B(1) (art 10B added by SI 2004/948); Trade Marks Rules 2000, SI 2000/136, r 13A(1) (r 13A added by SI 2004/947). The holder of the international registration is required at this point to give an address for service in the United Kingdom: Trade Marks (International Registration) Order 1996, SI 1996/714, art 10B(1) (as so added). As to addresses for service see PARA 357 ante.

27 Ibid art 10B(2) (as added: see note 26 supra); Trade Marks Rules 2000, SI 2000/136, r 13A(2) (as added: see note 26 supra).

28 Ie filing Form TM8.

29 Ie Form TM9c.

30 Ie on Form TM9t.

31 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10B(3) (as added: see note 26 supra); Trade Marks Rules 2000, SI 2000/136, r 13A(3) (as added: see note 26 supra). The purpose of this provision is to allow the parties to agree a cooling off period to see if a settlement can be negotiated.

32 Ie filing Form TM8.

33 Ie on Form TM9c.

34 Ie on Form TM9t.

35 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10B(4) (as added: see note 26 supra); Trade Marks Rules 2000, SI 2000/136, r 13A(4) (as added: see note 26 supra).

36 Ie Form TM8.

37 Trade Marks Rules 2000, SI 2000/136, r 13A(1) (as added: see note 26 supra). The relevant period cannot be extended: r 68(3) (amended by SI 2004/947); and see PARA 356 ante. If the applicant fails to file a Form TM8 and counter-statement within the relevant period, the registrar has no discretion to permit the application to stand: *KML Invest AB's Trade Mark Application* [2004] RPC 972, Appointed Person.

38 le Form TM8.

39 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10B(1) (as added: see note 26 supra).

40 le Form TM8.

41 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(1) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13A(5) (as added: see note 26 supra).

42 Ibid r 13A(5) (as added: see note 26 supra); Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(1) (as added: see note 18 supra).

43 le under the Trade Marks Act 1994 s 5(1), (2): see PARAS 70-74 ante.

44 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13B(1), (2) (r 13B added by SI 2004/947). The registrar need not give reasons for the preliminary indication (although in practice he usually does so), and the preliminary indication is not subject to appeal: Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13B(5) (as so added).

45 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13B(3) (as added: see note 44 supra).

46 Notice of intention to proceed must be filed on Form TM53.

47 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13B(4)(a) (as added: see note 44 supra).

48 See note 46 supra.

49 See PARAS 374-375 ante.

50 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13B(4)(b) (as added: see note 44 supra).

51 See note 46 supra.

52 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13B(4)(c) (as added: see note 44 supra).

53 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13B(6) (as added: see note 44 supra).

54 For these purposes, evidence is only considered filed when it has been received by the registrar accompanied by Form TM54 and it has been sent to all other parties to the opposition: Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(7) (r 13C added by SI 2004/947).

55 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(1)(a) (as added: see note 54 supra).

56 See note 54 supra.

57 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(1)(b) (as added: see note 54 supra).

58 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(2) (as added: see note 54 supra). This provision gives the registrar a discretion. If the opponent does not need or wish to rely upon any evidence at all (eg because he alleges that the trade mark is descriptive or otherwise lacking in distinctive character), the registrar should normally exercise this discretion in favour of the opponent. Otherwise the proper exercise of the discretion will depend on the circumstances of the case.

59 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(3) (as added: see note 54 supra).

60 See note 54 supra.

61 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(4) (as added: see note 54 supra).

62 See note 54 supra.

63 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(5) (as added: see note 54 supra). As to what constitutes 'matters strictly in reply' see *Peckitt's Application*[1999] RPC 337, Comptroller-General.

64 See note 54 supra.

65 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(6) (as added: see note 54 supra).

66 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(8) (as added: see note 54 supra).

67 Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (as added: see note 18 supra); Trade Marks Rules 2000, SI 2000/136, r 13C(9) (as added: see note 54 supra).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **384 Opposition proceedings**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 17-20.

TEXT AND NOTES 15-67--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(viii) Opposition Proceedings/385. Registrar's decision.

### **385. Registrar's decision.**

When the registrar<sup>1</sup> has made a decision on the acceptability of an application for registration or of an international registration<sup>2</sup> following opposition proceedings<sup>3</sup>, he must send the applicant and the person opposing the application written notice of it, stating the reasons for his decision<sup>4</sup>.

1 As to the registrar see PARA 17 ante.

2 I.e. an international registration under the Madrid Protocol in respect of which a request for protection in the United Kingdom has been made: see PARA 13 ante. For the meaning of 'international registration' see PARA 12 note 2 ante. For the meaning of 'United Kingdom' see PARA 3 note 2 ante. As to the Madrid Protocol see PARA 8 ante.

3 I.e. following the procedure under the Trade Marks Rules 2000, SI 2000/136, rr 13-13C (as amended): see PARA 384 ante.

4 Ibid r 14(1) (amended by SI 2004/947); Trade Marks (International Registration) Order 1996, SI 1996/714, art 10C(2) (added by SI 2004/948). For the purposes of any appeal against the registrar's decision, the date of the decision is the date when notice of the decision is sent under the Trade Marks Rules 2000, SI 2000/136, r 14(1); r 14(2). In the case of an opposition to an application for protection of an international registration, the decision will stand as the registrar's decision as to whether to uphold the notice of provisional refusal under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10A(5) (as added) (see PARA 384 ante) required by art 11(4) (as added) (see PARA 382 ante).

### **UPDATE**

#### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **385 Registrar's decision**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 69.

NOTE 4--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(viii) Opposition Proceedings/386. Res judicata.

### **386. Res judicata.**

If an opponent is successful, and a fresh application is made and he opposes again, the matter may or may not be res judicata depending in particular on whether the different application date and any differences in the trade marks applied for affect the causes of action and/or the issues raised<sup>1</sup>. Lack of success will not preclude the opponent from subsequently challenging the validity of the registration unless the particular circumstances of the later challenge mean that it is an abuse of process<sup>2</sup>.

<sup>1</sup> *Re William Hunt & Sons, The Brades Ltd's Application* (1911) 28 RPC 302; *Re Massachusetts Saw Works' Application* (1918) 35 RPC 137; cf *Unilever Ltd's (Striped Toothpaste No 2) Trade Marks* [1987] RPC 13; *Philips Electronics NV v Remington Consumer Products Ltd (No 2)* [1999] ETMR 835, [1999] All ER (D) 351; *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822.

<sup>2</sup> *Special Effects Ltd v L'Oréal SA* [2007] EWCA Civ 1, [2007] RPC 380, [2007] All ER (D) 29 (Jan). This decision reflects the position regarding successive proceedings before the Office for Harmonisation in the Internal Market: see PARA 289 note 11 ante. As to the Office see PARA 180 et seq ante.

### **UPDATE**

#### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/ (ix) Observations on Registrability/387. In general.

## **(ix) Observations on Registrability**

### **387. In general.**

Where an application for registration of a trade mark has been published<sup>1</sup>, any person may, at any time before the registration<sup>2</sup> of the trade mark<sup>3</sup>, make observations in writing to the registrar<sup>4</sup> as to whether the trade mark should be registered<sup>5</sup>. Similarly, where a notice has been published that protection in the United Kingdom will be conferred on an international registration<sup>6</sup>, any person may, at any time before the trade mark becomes protected, make observations in writing to the registrar as to whether the trade mark should be protected<sup>7</sup>. A person who makes observations does not thereby become a party to the proceedings on the application or international registration<sup>8</sup>. The registrar must send<sup>9</sup> to the applicant for a United Kingdom trade mark a copy of any documents containing any such observations<sup>10</sup>.

1 As to publication of the application see PARA 383 ante.

2 For the meaning of 'registration' see PARA 19 note 2 ante.

3 For the meaning of 'trade mark' see PARA 57 ante.

4 As to the registrar see PARA 17 ante.

5 Trade Marks Act 1994 s 38(3).

6 I.e. a notice specifying particulars of the international registration and particulars of the goods and services in respect of which protection will be conferred published under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (as substituted): see PARA 383 ante. For the meaning of 'international registration' see PARA 12 note 2 ante. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

7 Ibid art 10(3) (substituted by SI 2004/948).

8 Trade Marks Act 1994 s 38(3); Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(3) (as substituted: see note 7 supra).

9 For the meaning of 'send' see PARA 25 note 14 ante.

10 Trade Marks Rules 2000, SI 2000/136, r 15; Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(3) (as substituted: see note 7 supra).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **387 In general**

NOTE 8--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

TEXT AND NOTES 9, 10--See now Trade Marks Rules 2008, SI 2008/1797, r 22.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(x) Registration/388. Registration of trade mark.

## **(x) Registration**

### **388. Registration of trade mark.**

Where an application has been accepted and:

- 522 (1) no notice of opposition<sup>1</sup> is given within the specified period<sup>2</sup>; or
- 523 (2) all opposition proceedings are withdrawn or decided in favour of the applicant<sup>3</sup>,

the registrar<sup>4</sup> must register the trade mark unless it appears to him, having regard to matters coming to his notice since he accepted the application<sup>5</sup>, that the registration requirements (other than the relative grounds for refusal<sup>6</sup>) were not met at that time<sup>7</sup>. A trade mark may not, however, be so registered unless any fee prescribed for the registration is paid within the prescribed period; if the fee is not paid within that period, the application is deemed to be withdrawn<sup>8</sup>.

On the registration of a trade mark the registrar must publish<sup>9</sup> the registration, specifying the date upon which the trade mark was entered in the register<sup>10</sup> and issue to the applicant a certificate of registration<sup>11</sup>.

1 As to opposition proceedings see PARAS 384-386 ante.

2 Trade Marks Act 1994 s 40(1)(a). The specified period is the period referred to in s 38(2) (see PARA 384 ante): s 40(1)(a).

3 Ibid s 40(1)(b).

4 As to the registrar see PARA 17 ante.

5 Eg as a result of third party observations (as to which see PARA 387 ante).

6 Ie under the Trade Marks Act s 5(1)-(3) (s 5(3) as amended): see PARA 70 et seq ante.

7 Ibid s 40(1) (amended by the Trade Marks (Proof of Use) Regulations 2004, SI 2004/946, reg 5). Once the relevant time limits have expired the registrar is obliged to take timely steps to enter the trade mark on the register: *CREOLA Trade Mark*[1997] RPC 507. The registrar has power to withdraw a registration if it is subsequently discovered that the registration was procedurally irregular: see *Andreas Stihl AG & Co's Trade Mark Application*[2001] RPC 215, Appointed Person; *BAT OUT OF HELL Trade Mark* (O/398/02), Appointed Person; and PARA 361 ante.

8 Trade Marks Act 1994 s 40(2). As to fees see PARA 16 ante.

9 For the meaning of 'publish' see PARA 17 note 10 ante.

10 Ie the date of filing of the application for registration: Trade Marks Act s 40(3): see PARA 21 ante.

11 Ibid s 40(4); Trade Marks Rules 2000, SI 2000/136, r 16.

## **UPDATE**

**381-408 Acceptance or refusal of application for a registered trade mark ...  
Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797  
(see PARA 352-375).

**388 Registration of trade mark**

TEXT AND NOTES 9-11--See now Trade Marks Rules 2008, SI 2008/1797, r 23.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/(x) Registration/389. Conferring of protection on an international registration.

### **389. Conferring of protection on an international registration.**

Where the period of 18 months expires from the date on which notification of the request for protection was sent to the United Kingdom<sup>1</sup> expires without any notice of provisional refusal having been given and without the International Bureau<sup>2</sup> having been informed that oppositions may be filed after the expiry of that period<sup>3</sup>, the trade mark which is the subject of the request must be granted protection<sup>4</sup>. Subject to this, the trade mark must be protected in respect of the relevant goods or services:

- 524 (1) where particulars of the international registration have been published<sup>5</sup> in respect of all or some of the goods or services comprised in the international registration and the period for giving notice of opposition<sup>6</sup> has expired without notice of opposition having been given and without notice of refusal not based on an opposition having been given and not withdrawn<sup>7</sup>;
- 525 (2) where particulars of the international registration have been published in respect of all or some of the goods or services comprised in the international registration and on the expiry of the period for giving notice of opposition notice of opposition has been given in relation to some only of the goods or services specified in the notice and no notice of refusal not based on an opposition has been given and not withdrawn in relation to the remaining goods or services<sup>8</sup>; and
- 526 (3) where particulars of the international registration have been published in respect of all or some of the goods or services comprised in the international registration and within the period for giving notice of opposition notice of opposition has been given in respect of all or some of the goods or services specified in the notice but subsequently a final decision<sup>9</sup> is made that the notice of provisional refusal given as a result of that opposition is withdrawn in respect of all or some of those goods or services and no notice of refusal (whether based on an opposition or otherwise) continues to subsist in relation to those goods or services<sup>10</sup>.

When a trade mark becomes protected pursuant to these provisions, the registrar must publish<sup>11</sup> a notice specifying the number of the international registration<sup>12</sup> in respect of that trade mark, the date on which protection is conferred<sup>13</sup> and the date and place of publication of the notice of acceptance<sup>14</sup>.

1 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

2 As to the International Bureau see PARAS 8 note 11, 12 note 5 ante.

3 I.e. pursuant to the Trade Marks (International Registration) Order 1996, SI 1996/714, art 11(2) (as substituted): see PARA 383 note 9 ante.

4 Ibid art 12(1) (substituted by SI 2002/692).

5 I.e. pursuant to the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (as substituted): see PARA 383 ante.

6 I.e. in accordance with ibid art 10(2) (as substituted): see PARA 384 ante.

- 7 Ibid art 12(1A) (added by SI 2002/692).
- 8 Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(1B) (added by SI 2002/692).
- 9 A final decision is made where the registrar, or the appointed person or the court on appeal from the registrar, decides whether the refusal will be upheld in whole or in part and any right of appeal against that decision expires or is exhausted: Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(1D) (added by SI 2002/692).
- 10 Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(1C) (added by SI 2002/692).
- 11 For the meaning of 'publish' see PARA 17 note 10 ante.
- 12 For the meaning of 'international registration' see PARA 13 ante.
- 13 As to the date on which protection is conferred see PARA 21 ante.
- 14 Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(3) (substituted by SI 2002/692).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(2) PROCEDURE ON APPLICATION FOR REGISTRATION OF TRADE MARK OR PROTECTION OF INTERNATIONAL MARK/ (xi) Supply of Information/390. Information about applications and registered trade marks.

## **(xi) Supply of Information**

### **390. Information about applications and registered trade marks.**

After publication of an application for registration of a trade mark<sup>1</sup>, the registrar<sup>2</sup> must on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject, however, to any prescribed restrictions<sup>3</sup>. Any request must be made on the appropriate form<sup>4</sup> and must be accompanied by the appropriate fee, if any<sup>5</sup>.

Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application must not be published by the registrar or communicated by him to any person except in such cases and to such extent as may be prescribed<sup>6</sup> or with the consent of the applicant, but subject as follows<sup>7</sup>. Where a person has been notified that an application for registration of a trade mark has been made, and that the applicant will, if the application is granted, bring proceedings against him in respect of acts done after publication of the application, he may make a request for information<sup>8</sup> notwithstanding that the application has not been published<sup>9</sup>.

Corresponding provisions apply to information in the possession of the registrar relating to international registrations<sup>10</sup> in respect of which protection is sought in the United Kingdom, before and after the registrar has published a notice<sup>11</sup> that protection will be conferred<sup>12</sup>.

1 As to the publication of the application see PARA 383 ante. For the meaning of 'trade mark' see PARA 57 ante; and for the meaning of 'publish' see PARA 17 note 10 ante.

2 As to the registrar see PARA 17 ante.

3 Trade Marks Act 1994 s 67(1). As to the restrictions see PARAS 25-26 ante.

4 I.e Form TM31C. As to the use of forms see PARA 353 ante.

5 Trade Marks Act 1994 s 67(1); Trade Marks Rules 2000, SI 2000/136, r 48. As to fees see PARA 16 ante.

6 Before publication of an application for registration the registrar must make available for inspection by the public the application and any amendments made to it and any particulars contained in a notice given to the registrar under *ibid* r 41 (see PARA 132 ante): r 49(1).

7 Trade Marks Act 1994 s 67(2). Nothing in s 67(2) relating to publication of information may be construed as preventing the publication of decisions on cases relating to trade marks decided by the registrar: Trade Marks Rules 2000, SI 2000/136, r 49(2).

8 I.e under the Trade Marks Act 1994 s 67(1): see the text to notes 1-5 *supra*.

9 *Ibid* s 67(3).

10 For the meaning of 'international registration' see PARA 12 note 2 ante.

11 I.e a notice specifying particulars of the international registration and particulars of the goods and services in respect of which protection will be conferred published under the Trade Marks (International Registration) Order 1996, SI 1996/714, art 10(1) (as substituted): see PARA 383 ante.

## **UPDATE**

**UPDATE**

**381-408 Acceptance or refusal of application for a registered trade mark ...  
Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797  
(see PARA 352-375).

**390 Information about applications and registered trade marks**

TEXT AND NOTES 4, 5--See now Trade Marks Rules 2008, SI 2008/1797, rr 56, 57.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(i) Merger, Reclassification and Alteration/391. Merger of separate registrations.

### **(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY**

#### **(i) Merger, Reclassification and Alteration**

##### **391. Merger of separate registrations.**

The proprietor<sup>1</sup> of two or more registrations of a trade mark<sup>2</sup> may request the registrar<sup>3</sup> to merge them into a single registration; and the registrar must, if satisfied that the registrations are in respect of the same trade mark, merge them into a single registration<sup>4</sup>. Where any registration of a trade mark to be so merged is subject to a disclaimer or limitation, the merged registration is also restricted accordingly<sup>5</sup>. Where any registration of a trade mark to be so merged has had registered in relation to it particulars relating to the grant of a licence or a security interest or any right in or under it, or of any memorandum or statement of the effect of a memorandum, the registrar must enter in the register the same particulars in relation to the merged registration<sup>6</sup>. The date of registration of the merged registration is, where the separate registrations bear different dates of registration, the latest of those dates<sup>7</sup>.

1 For the meaning of 'proprietor' see PARA 22 note 8 ante.

2 For the meaning of 'trade mark' see PARA 57 ante.

3 As to the registrar see PARA 17 ante. The request must be made on Form TM17. As to the use of forms see PARA 353 ante.

4 Trade Marks Act 1994 s 41(1)(b); Trade Marks Rules 2000, SI 2000/136, r 20(3).

5 Ibid r 20(4).

6 Ibid r 20(5).

7 Ibid r 20(6).

#### **UPDATE**

##### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

##### **391 Merger of separate registrations**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 27(3)-(6).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(i) Merger, Reclassification and Alteration/392. Reclassification; opposition to proposals.

### **392. Reclassification; opposition to proposals.**

The registrar<sup>1</sup> may amend an entry in the register<sup>2</sup> which relates to the classification of a registered trade mark so that it accords with the current Nice Classification<sup>3</sup>. This power may not be exercised so as to extend the rights conferred by the registration, except where it appears to the registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person<sup>4</sup>.

Before making any such amendment to the register, the registrar must give the proprietor<sup>5</sup> of the mark written notice of his proposals for amendment<sup>6</sup> and must at the same time advise him that:

- 527 (1) he may make written objections to the proposals, within three months of the date of the notice, stating the grounds of his objections<sup>7</sup>; and
- 528 (2) if no written objections are received within the period specified, the registrar will publish<sup>8</sup> the proposals and he will not be entitled to make any objections thereto upon such publication<sup>9</sup>.

If the proprietor makes no written objections within the period specified in head (1) above or at any time before the expiration of that period gives the registrar written notice of his intention not to make any objections, the registrar must as soon as practicable after the expiration of that period or upon receipt of the notice publish the proposals<sup>10</sup>. Where the proprietor makes written objections within the period specified in head (2) above, the registrar must, as soon as possible after he has considered the objections, publish the proposals or, where he has amended the proposals, publish the proposals as amended; and his decision is final and not subject to appeal<sup>11</sup>.

Any person may, within three months of the date on which the proposals were published<sup>12</sup>, give notice to the registrar of opposition to the proposals<sup>13</sup> which must include a statement of the grounds of opposition and, in particular, why the proposed amendments would be contrary<sup>14</sup> to the statutory provisions<sup>15</sup>. The registrar may require or admit evidence directed to the questions in issue and, if so requested by any person opposing the proposal, give that person the opportunity to be heard thereon before deciding the matter<sup>16</sup>. If no notice of opposition is so filed within the time specified, or where any opposition has been determined, the registrar must make the amendments as proposed and must enter in the register the date when they were made; and his decision is final and not subject to appeal<sup>17</sup>.

1 As to the registrar see PARA 17 ante.

2 As to the register see PARA 19 ante.

3 Trade Marks Rules 2000, SI 2000/136, r 46(1) (substituted by SI 2006/3039). As to classification of goods and services see PARA 369 ante; and as to the 'Nice Classification' see PARA 370 ante.

The Secretary of State may make provision by rules empowering the registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks: Trade Marks Act 1994 s 65(1). Provision may in particular be made for the amendment of existing entries on the register to accord with the new classification: s 65(2). The rules may

empower the registrar: (1) to require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the register; and (2) to cancel or refuse to renew the registration of the trade mark in the event of his failing to do so: s 65(4). Any such proposal must be advertised, and may be opposed, in such manner as may be prescribed: s 65(5). As to the Secretary of State see PARA 14 et seq; and as to the making of rules generally see PARA 15 ante.

4 Ibid s 65(3).

5 For the meaning of 'proprietor' see PARA 22 note 8 ante.

6 Trade Marks Rules 2000, SI 2000/136, r 46(2).

7 Ibid r 46(2)(a).

8 For the meaning of 'publish' see PARA 17 note 10 ante.

9 Trade Marks Rules 2000, SI 2000/136, r 46(2)(b).

10 Ibid r 46(3).

11 Ibid r 46(4).

12 Ie under ibid r 46: see the text to notes 1-11 supra.

13 Notice must be given on Form TM7. As to the use of forms see PARA 353 ante.

14 Ie how the proposed amendments would be contrary to the Trade Marks Act 1994 s 65(3): see the text to note 4 supra.

15 Trade Marks Rules 2000, SI 2000/136, r 47(1) (substituted by SI 2004/947).

16 Trade Marks Rules 2000, SI 2000/136, r 47(2).

17 Ibid r 47(3).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **392 Reclassification; opposition to proposals**

TEXT AND NOTES--See now Trade Marks Rules 2000, SI 2008/1797, rr 54, 55.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(i) Merger, Reclassification and Alteration/393. Alteration of registered trade mark at proprietor's request.

### **393. Alteration of registered trade mark at proprietor's request.**

A registered trade mark<sup>1</sup> may not be altered in the register<sup>2</sup> during the period of registration or on renewal<sup>3</sup>. Nevertheless the registrar<sup>4</sup> may, at the request of the proprietor<sup>5</sup>, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity<sup>6</sup> of the mark<sup>7</sup>.

The proprietor may request the registrar<sup>8</sup> for such alteration of his registered trade mark as is permitted under the above provisions; and the registrar may require evidence by statutory declaration or otherwise as to the circumstances in which the application is made<sup>9</sup>.

Where, upon the request of the proprietor, the registrar proposes to allow such alteration, he must publish<sup>10</sup> the mark as altered<sup>11</sup>.

Any person claiming to be affected by the alteration may within three months of the date of publication of the mark as altered give notice to the registrar of objection to the alteration<sup>12</sup> which must include a statement of the grounds of objection<sup>13</sup>. The registrar must send a copy of objection to the alteration<sup>14</sup> to the proprietor; and thereafter the procedure relating to opposition proceedings<sup>15</sup> applies with consequent modifications<sup>16</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 ante.

2 As to the register see PARA 19 ante.

3 Trade Marks Act 1994 s 44(1). An application under the Trade Marks Act 1938 s 35 (repealed) (alteration of registered trade mark) which was pending on 31 October 1994 must be dealt with under the old law and any necessary alteration made to the new register: Trade Marks Act 1994 s 105, Sch 3 para 16. For the meaning of 'the old law' see PARA 4 note 3 ante.

4 As to the registrar see PARA 17 ante.

5 For the meaning of 'proprietor' see PARA 22 note 8 ante.

6 As to the expression 'not substantially affecting its identity' see PARA 375 note 2 ante.

7 Trade Marks Act 1994 s 44(2) (which has no counterpart in EEC Council Directive 89/104 (OJ L40, 11.2.89, p 1) to approximate the laws of the member states relating to trade marks).

8 Ie on Form TM25. As to the use of forms see PARA 353 ante.

9 Trade Marks Act 1994 s 44(3); Trade Marks Rules 2000, SI 2000/136, r 25(1).

10 For the meaning of 'publish' see PARA 17 note 10 ante.

11 Trade Marks Act 1994 s 44(3); Trade Marks Rules 2000, SI 2000/136 r 25(2).

12 Ie on Form TM7.

13 Trade Marks Act 1994 s 44(3); Trade Marks Rules 2000, SI 2000/136 r 25(3) (substituted by SI 2004/947).

14 Ie on Form TM7.

15 As to the procedure relating to opposition proceedings see PARA 384 ante.

16 Trade Marks Act 1994 s 44(3); Trade Marks Rules 2000, SI 2000/136 r 25(4) (added by SI 2004/947).

**UPDATE**

**381-408 Acceptance or refusal of application for a registered trade mark ...  
Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

**393 Alteration of registered trade mark at proprietor's request**

TEXT AND NOTES 8-16--See now Trade Marks Rules 2008, SI 2008/1797, r 32.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(i) Merger, Reclassification and Alteration/394. Disclaimer or limitation of registered trade mark.

### **394. Disclaimer or limitation of registered trade mark.**

The proprietor of a registered trade mark<sup>1</sup> may<sup>2</sup>:

- 529 (1) disclaim any right to the exclusive use<sup>3</sup> of any specified element of the trade mark<sup>4</sup>; or
- 530 (2) agree that the rights conferred by the registration are to be subject to a specified territorial or other limitation<sup>5</sup>.

Disclaimers and limitations can similarly be made in relation to an international trade mark for which protection has been obtained in the United Kingdom<sup>6</sup>.

1 For the meaning of 'proprietor' see PARA 22 note 8 ante; and as to the meaning of 'registered trade mark' see PARA 127 ante.

2 Trade Marks Act 1994 s 13(1). The applicant for registration of a trade mark may also make disclaimers and limitations: see PARA 376 ante. As to the making of such disclaimers and limitations see PARA 83 ante. As to the effect of such disclaimers and limitations on the proprietor's rights see PARA 98 ante.

3 For the meaning of 'use' see PARA 60 note 8 ante.

4 Trade Marks Act 1994 s 13(1)(a).

5 Ibid s 13(1)(b).

6 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 4(4) (amended by SI 2002/692). For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(ii) Surrender/395. Procedure.

## **(ii) Surrender**

### **395. Procedure.**

The proprietor<sup>1</sup> may surrender a registered trade mark<sup>2</sup> in respect of some or all of the goods or services for which it is registered by sending<sup>3</sup> notice to the registrar<sup>4</sup>: (1) in respect of all the goods or services for which it is registered<sup>5</sup>; or (2) in respect of only those goods or services specified by him in the notice<sup>6</sup>.

Any such notice is, however, of no effect unless the proprietor in that notice: (a) gives the name and address of any person having a registered interest in the mark; and (b) certifies that any such person has been sent not less than three months' notice of the proprietor's intention to surrender the mark or is not affected or, if affected, consents thereto<sup>7</sup>.

Upon the surrender taking effect, the registrar must make the appropriate entry in the register<sup>8</sup> and must publish<sup>9</sup> the same<sup>10</sup>.

1 For the meaning of 'proprietor' see PARA 22 note 8 ante.

2 As to the meaning of 'registered trade mark' see PARA 127 post.

3 For the meaning of 'send' see PARA 25 note 14 ante.

4 As to the registrar see PARA 17 ante.

5 Trade Marks Act 1994 s 45(1), (2); Trade Marks Rules 2000, SI 2000/136, r 26(1)(a). Notice under these circumstances must be sent on Form TM22: r 26(1)(a). As to the use of forms see PARA 353 post.

6 Trade Marks Act 1994 s 45(1), (2); Trade Marks Rules 2000, SI 2000/136, r 26(1)(b). Notice under these circumstances must be sent on Form TM23: r 26(1).

7 Trade Marks Act 1994 s 45(2); Trade Marks Rules 2000, SI 2000/136, r 26(2).

8 As to the register see PARA 19 ante.

9 For the meaning of 'publish' see PARA 17 note 10 ante.

10 Trade Marks Act 1994 s 45(2); Trade Marks Rules 2000, SI 2000/136, r 26(3). As to when surrender takes effect see PARA 113 ante.

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **395 Procedure**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 33.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/396. Choice of forum.

### **(iii) Revocation, Declaration of Invalidity and Rectification**

#### **396. Choice of forum.**

An application for revocation, for a declaration of invalidity or for rectification of the register<sup>1</sup> in relation to a United Kingdom registered trade mark, or an application for revocation or a declaration of invalidity of the protection of a protected international trade mark (UK)<sup>2</sup>, may be made by any person<sup>3</sup>, and may be made either to the registrar<sup>4</sup> or to the court<sup>5</sup> except that:

- 531 (1) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court<sup>6</sup>; and
- 532 (2) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court<sup>7</sup>.

An applicant must take certain considerations into account in deciding whether to make his application to the registrar or to the court. The procedure before the registrar is significantly cheaper but often slower, not only because registry procedure is relatively relaxed but because the option to appeal as of right makes the possibility of delay greater. In practice disclosure is infrequently sought before the registrar and, where sought, limited. Furthermore, cross-examination is uncommon and, where it does occur, less intense and wide-ranging than in the court. In general, therefore, registry proceedings are appropriate where an amicable settlement is envisaged or where the parties are more or less friendly but desirous of having the position clarified, or where costs are the overriding concern.

<sup>1</sup> As to these applications and the circumstances in which they are appropriate see PARAS 114-121 ante; as to the additional grounds for revocation or invalidity of a collective mark see PARAS 163-164 ante; and as to the additional grounds for revocation or invalidity of a certification mark see PARAS 174-175 ante.

<sup>2</sup> See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 13 (amended by SI 2000/138; SI 2004/948; SI 2006/763; SI 2006/1080), which applies generally the grounds and procedures relating to revocation and declaration of invalidity of United Kingdom registered trade marks to protected international trade marks (UK). In particular it applies to them the Trade Marks Act 1994 ss 46, 47 (s 47 as amended) (see PARA 114 et seq ante), and the Trade Marks Rules 2000, SI 2000/136, rr 31-33B (as amended) (see PARA 398 et seq post). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

<sup>3</sup> The applicant does not have to show that he is aggrieved by, or otherwise interested in, the registration: *Pharmedica GmbH's Trade Mark Application* [2000] RPC 536, [2000] All ER (D) 28; cf *Oystertec plc's Patent* [2002] EWHC 2324 (Pat), [2003] RPC 559, sub nom *Oystertec plc v Edward Evans Barker* [2003] IP & T 1015.

<sup>4</sup> As to the registrar see PARA 17 ante. As to procedure on the application before the registrar see PARA 396 et seq post.

<sup>5</sup> Trade Marks Act 1994 s 46(4) (revocation), s 47(3) (declaration of invalidity), s 64(2) (rectification). As from 1 October 2007, so much of s 47(3) as provides that any person may make an application for a declaration of invalidity has effect subject to the Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, art 5 (not yet in force) (see PARA 119, note 5, 8 ante): art 5(3) (not yet in force). See also the Community Trade Mark Regulations 2006, SI 2006/1027, reg 3(1); and PARA 288 ante. For the meaning of 'the court' see PARA 349 ante.

<sup>6</sup> Trade Marks Act 1994 ss 46(4)(a), 47(3)(a), 64(2)(a).

7 Ibid ss 46(4)(b), 47(3)(b), 64(2)(b). In practice the registrar seldom exercises the power to refer to the court. If, within one month of receiving notification of the decision to refer, the applicant does not make to the High Court the appropriate application, he is deemed to have abandoned the application: *Practice Direction-- Patents and Other Intellectual Property Claims* PD63 para 20.1 This period may be extended by the registrar or the court: para 20.2.

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **396 Choice of forum**

NOTE 2--See now Trade Marks Rules 2008, SI 2008/1797, rr 38-43.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/397. 'No challenge' clauses; *res judicata*.

### **397. 'No challenge' clauses; *res judicata*.**

It is not uncommon for parties to enter into agreements which prohibit the making of a challenge to the validity of other parties' trade marks either as terms of trade mark licences<sup>1</sup> or of trade mark delimitation agreements. Whether such an agreement prevents the making of an application for revocation as distinct from an application for a declaration of invalidity depends on the true construction of the agreement<sup>2</sup>. Such agreements may or may not be unenforceable under Community competition law or under domestic restraint of trade law, depending on the circumstances<sup>3</sup>.

If an unsuccessful application for a declaration of invalidity is made the applicant will be precluded by *res judicata* from making a further application on different grounds, but will not be precluded from applying to revoke the registration; an application for revocation may or may not be an abuse of process depending on the circumstances<sup>4</sup>.

1 As to licences see PARAS 136-137 ante.

2 *Fenchurch Environmental Group Ltd v Ad Tech Holdings Ltd* (O/236/05), Appointed Person.

3 See Case 35/83 *BAT Cigaretten-Fabriken GmbH v EC Commission* [1985] ECR 363, [1985] 2 CMLR 470, ECJ; *Apple Corp Ltd v Apple Computer Inc* [1991] 3 CMLR 49; *WWF - World Wildlife Fund for Nature v World Wrestling Federation Entertainment Inc* [2002] EWCA Civ 196, [2003] IP & T 98; *Fenchurch Environmental Group Ltd v Ad Tech Holdings Ltd* (O/236/05), Appointed Person; *Fenchurch Environmental Group Ltd v Bactiguard AB* (O/095/07), Trade Marks Registry.

4 *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822.

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/398. Revocation for non-use.

### **398. Revocation for non-use.**

An application to the registrar<sup>1</sup> for revocation for non-use of a trade mark<sup>2</sup> must be made on the appropriate form<sup>3</sup> together with a statement of the grounds on which the application is made<sup>4</sup>. The registrar must send<sup>5</sup> a copy of that form<sup>6</sup> and the statement of grounds to the proprietor<sup>7</sup>. Within three months of the date on which the registrar sends a copy of the form<sup>8</sup> and the statement to the proprietor, the proprietor must file his own form<sup>9</sup> including a counter-statement and either: (1) two copies of evidence of use made of the mark; or (2) reasons for non-use of the mark<sup>10</sup>. Evidence of use of the mark must cover the period of non-use alleged by the applicant or<sup>11</sup> show that the use of the mark commenced or resumed after the end of that period but before the application for revocation was made<sup>12</sup>. Reasons for non-use must cover the period of non-use alleged by the applicant<sup>13</sup>. If the proprietor fails to file the form<sup>14</sup> and evidence of use or reasons for non-use within time, the registrar may treat him as not opposing the application<sup>15</sup>.

The registrar must send a copy of the proprietor's form<sup>16</sup> and any evidence of use or reasons for non-use filed by the proprietor to the applicant; and the date on which this is done is the 'initiation date'<sup>17</sup>. The applicant may, within three months of the initiation date, file<sup>18</sup> any evidence he may consider necessary to adduce in support of his application<sup>19</sup>. Where the applicant files no evidence<sup>20</sup>, the registrar must notify the proprietor of this<sup>21</sup>.

The proprietor may, within the relevant period, file<sup>22</sup> such further evidence as he may consider necessary to adduce in support of his case<sup>23</sup>. The relevant period is:

- 533 (a) where the applicant files evidence, the period beginning on the date when that evidence is filed and ending three months after that date;
- 534 (b) where the applicant does not file evidence, the period beginning on the date that the registrar sent the proprietor notice of this and ending three months after that date<sup>24</sup>.

Where the proprietor files such evidence, the applicant may within three months file<sup>25</sup> evidence in reply; such evidence must be confined to matters strictly in reply to the proprietor's evidence<sup>26</sup>.

The registrar may at any time if he thinks fit give leave to either party to file<sup>27</sup> evidence upon such terms as he thinks fit<sup>28</sup>.

When the periods for filing evidence have expired, the registrar must request that the parties give written notice of whether they wish to be heard<sup>29</sup>. If any party requests to be heard the registrar must send to the parties notice of a date for the hearing<sup>30</sup>.

1 As to the registrar see PARA 17 ante.

2 I.e. under the Trade Marks Act 1994 s 46(1)(a) or (b): see PARAS 114, 396 ante.

3 I.e. Form TM26(N). As to the use of forms see PARA 353 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 31(1) (r 31 substituted by SI 2004/947). Where the applicant seeks to revoke the registration from a date earlier than the date of the application for revocation, he must set out in

the statement of grounds the date as of which revocation is sought and then explicitly allege that grounds for revocation existed at that date: *Omega SA v Omega Engineering Inc* [2003] EWHC 1334 (Ch), [2003] FSR 893. Where the applicant fails to plead his case correctly (eg because he specifies a date for revocation which the registrar has no power to order) the registrar has power in an appropriate case to permit him to amend his statement of grounds without re-commencing the procedure: *BSA BY R2 Trade Mark* (O/144/07), Appointed Person.

5 For the meaning of 'send' see PARA 25 note 14 ante.

6 Ie Form TM26(N).

7 Trade Marks Rules 2000, SI 2000/136, r 31(2) (as substituted: see note 4 supra). For the meaning of 'proprietor' see PARA 22 note 8 ante.

8 Ie Form TM26(N).

9 Ie Form TM8. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

10 Trade Marks Rules 2000, SI 2000/136, r 31(3) (as substituted: see note 4 supra). The time limit laid down by r 31(3) (as substituted) cannot be extended: see r 68(3) (as amended); and PARA 356 ante. The proprietor may comply with r 31(3) (as substituted) if he files evidence within the time limit even if it is technically inadmissible for failure to comply with r 55 (see PARA 359 ante): *Argentum Ltd v Middlesex Silver Co Ltd* [2005] EWHC 2992 (Ch), sub nom *ARGENTUM Trade Mark* [2006] RPC 509. The proprietor cannot satisfy the Trade Marks Rules 2000, SI 2000/136, r 31(3) (as substituted) by filing evidence consisting of a bare assertion of use of the mark; the evidence must provide a sufficient explanation of how the mark has been used to enable the registrar to conclude that the proprietor has an arguable defence to the application for revocation. The evidence does not, however, have to be so persuasive that, if unanswered, it would necessarily discharge the burden of proof lying on the proprietor: *Almighty Marketing Ltd v Milk Link Ltd* [2005] EWHC 2584 (Ch), sub nom *MOO JUICE Trade Mark* [2006] RPC 501; *BSA BY R2 Trade Mark* (O/144/07) Appointed Person.

11 Where the proprietor intends to rely upon the Trade Marks Act 1994 s 46(3): see PARA 114 ante.

12 Trade Marks Rules 2000, SI 2000/136, r 31(4) (as substituted: see note 4 supra).

13 Ibid r 31(5) (as substituted: see note 4 supra).

14 Ie Form TM8.

15 Trade Marks Rules 2000, SI 2000/136, r 31(3) (as substituted: see note 4 supra). As to the exercise of the registrar's discretion if the proprietor files the documents late see *Lowden v Lowden Guitar Co Ltd* [2004] EWHC 2531 (Ch), sub nom *LOWDEN Trade Mark* [2005] RPC 377; *Music Choice Ltd v Target Brands Inc* [2005] EWHC 3323 (Ch), sub nom *Music Choice Ltd's Trade Mark* [2006] RPC 358; *Argentum Ltd v Middlesex Silver Co Ltd* [2005] EWHC 2992 (Ch), sub nom *ARGENTUM Trade Mark* [2006] RPC 509. The registrar must give the proprietor a hearing as required by the Trade Marks Rules 2000, SI 2000/136, r 54 (see PARA 358 ante) before exercising his discretion: *MOVIESTAR Trade Mark* [2005] RPC 623, Appointed Person.

16 Ie Form TM8.

17 Trade Marks Rules 2000, SI 2000/136, r 31(6) (as substituted: see note 4 supra).

18 For these purposes, evidence is only considered filed when it had been received by the registrar accompanied by Form TM54 and it has been sent to all other parties to the proceedings: *ibid* r 31A(7) (r 31A added by SI 2004/947).

19 Trade Marks Rules 2000, SI 2000/136, r 31A(1) (as substituted: see note 18 supra).

20 The applicant may well not need to file any evidence, since the burden of showing what use has been made of the mark lies upon the proprietor: see the Trade Marks Act 1994 s 100; and PARA 114 ante.

21 Trade Marks Rules 2000, SI 2000/136, r 31A(2) (as added: see note 18 supra).

22 See note 18 supra.

23 Trade Marks Rules 2000, SI 2000/136, r 31A(3) (as added: see note 18 supra). The proprietor may not need to file any further evidence if he has filed sufficient evidence under r 31(3) (as substituted): see the text to notes 8-10 supra.

24 Ibid r 31A(4) (as added: see note 18 supra).

25 See note 18 supra.

26 Trade Marks Rules 2000, SI 2000/136, r 31A(5) (as added: see note 18 supra). As to what constitutes 'matters strictly in reply' see PARA 384 note 63 ante.

27 See note 18 supra.

28 Trade Marks Rules 2000, SI 2000/136, r 31A(6) (as added: see note 18 supra).

29 Ibid r 31A(8) (as added: see note 18 supra).

30 Ibid r 31A(9) (as added: see note 18 supra).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **398 Revocation for non-use**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 38.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/399. Revocation for grounds other than non-use.

### **399. Revocation for grounds other than non-use.**

An application to the registrar<sup>1</sup> for revocation on grounds other than non-use<sup>2</sup> must be made on the appropriate form<sup>3</sup> together with a statement of the grounds on which the application is made<sup>4</sup>. The registrar must send<sup>5</sup> a copy of the form<sup>6</sup> and the statement of grounds to the proprietor<sup>7</sup>. Within six weeks of the date on which the registrar sends a copy of the form<sup>8</sup> and the statement to the proprietor, the proprietor must file his own form<sup>9</sup> including a counter-statement<sup>10</sup>. If the proprietor fails to file the necessary form<sup>11</sup> within that time, the registrar may treat him as not opposing the application<sup>12</sup>.

The registrar must send a copy of the form<sup>13</sup> to the applicant; and the date on which this is done is the 'initiation date'<sup>14</sup>. The applicant must, within six weeks of the initiation date, file<sup>15</sup> any evidence he may consider necessary to adduce in support of his application<sup>16</sup>. If the applicant files no evidence he is, unless the registrar otherwise directs, deemed to have withdrawn his application<sup>17</sup>. The registrar must notify the proprietor of any such direction<sup>18</sup>.

The proprietor may, within six weeks of the applicant's evidence being filed or the registrar sending him notification of a direction to permit the applicant to proceed without evidence, file<sup>19</sup> any evidence he may consider necessary to adduce in support of his case<sup>20</sup>.

Where the proprietor files such evidence, the applicant may within six weeks file<sup>21</sup> evidence in reply; such evidence must be confined to matters strictly in reply to the proprietor's evidence<sup>22</sup>.

The registrar may at any time if he thinks fit give leave to either party to file<sup>23</sup> evidence upon such terms as he thinks fit<sup>24</sup>.

When the periods for filing evidence have expired, the registrar must request that the parties give written notice of whether they wish to be heard<sup>25</sup>. If any party requests to be heard the registrar must send to the parties notice of a date for the hearing<sup>26</sup>.

1 As to the registrar see PARA 17 ante.

2 I.e. under the Trade Marks Act 1994 s 46(1)(c) or s 46(1)(d): see PARAS 115-116, 396 ante.

3 I.e. Form TM26(O). As to the use of forms see PARA 353 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 32(1) (r 32 substituted by SI 2004/947).

5 For the meaning of 'send' see PARA 25 note 14 ante.

6 I.e. Form TM26(O).

7 Trade Marks Rules 2000, SI 2000/136, r 32(2) (as substituted: see note 4 supra). For the meaning of 'proprietor' see PARA 22 note 8 ante.

8 I.e. Form TM26(O).

9 I.e. Form TM8. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

10 Trade Marks Rules 2000, SI 2000/136, r 32(3) (as substituted: see note 4 supra). The time limit laid down by r 32(3) (as substituted) cannot be extended: see r 68(3) (as amended); and PARA 356 ante.

11 le Form TM8.

12 Trade Marks Rules 2000, SI 2000/136, r 32(3) (as substituted: see note 4 supra). As to the exercise of the registrar's discretion if the proprietor files the Form TM8 late see *Lowden v Lowden Guitar Co Ltd* [2004] EWHC 2531 (Ch), sub nom *LOWDEN Trade Mark* [2005] RPC 377; *Music Choice Ltd v Target Brands Inc* [2005] EWHC 3323 (Ch), sub nom *Music Choice Ltd's Trade Mark* [2006] RPC 358; *Argentum Ltd v Middlesex Silver Co Ltd* [2005] EWHC 2992 (Ch), sub nom *ARGENTUM Trade Mark* [2006] RPC 509. The registrar must give the proprietor a hearing as required by the Trade Marks Rules 2000, SI 2000/136, r 54 (see PARA 358 ante) before exercising his discretion: *MOVIESTAR Trade Mark* [2005] RPC 623, Appointed Person.

13 le Form TM8.

14 Trade Marks Rules 2000, SI 2000/136, r 32(4) (as substituted: see note 4 supra).

15 For these purposes, evidence is only considered filed when it had been received by the registrar accompanied by Form TM54 and it has been sent to all other parties to the proceedings: *ibid* r 32A(7) (r 32A substituted by SI 2004/947).

16 Trade Marks Rules 2000, SI 2000/136, r 32A(1) (as substituted: see note 15 supra).

17 *Ibid* r 32A(2) (as substituted: see note 15 supra). It is difficult to envisage circumstances in which the registrar's discretion should be exercised in favour of the applicant unless the proprietor has admitted all the facts on which the application is based.

18 *Ibid* r 32A(3) (as substituted: see note 15 supra).

19 See note 15 supra.

20 Trade Marks Rules 2000, SI 2000/136, r 32A(4) (as substituted: see note 15 supra).

21 See note 15 supra.

22 Trade Marks Rules 2000, SI 2000/136, r 32A(5) (as substituted: see note 15 supra). As to what constitutes 'matters strictly in reply' see PARA 384 note 63 ante.

23 See note 15 supra.

24 Trade Marks Rules 2000, SI 2000/136, r 32A(6) (as substituted: see note 15 supra).

25 *Ibid* r 32A(8) (as substituted: see note 15 supra).

26 *Ibid* r 32A(9) (as substituted: see note 15 supra).

## UPDATE

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **399 Revocation for grounds other than non-use**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 39, 40 (r 40 amended by SI 2008/2300).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/400. Application for declaration of invalidity.

#### **400. Application for declaration of invalidity.**

An application to the registrar<sup>1</sup> for a declaration of invalidity<sup>2</sup> must be made on the appropriate form<sup>3</sup> together with a statement of the grounds on which the application is made<sup>4</sup>. Where the application is based on an earlier trade mark<sup>5</sup>, the statement of grounds must include a representation of that mark, details of the authority with which that mark is registered or has been applied for, the registration or application number of that mark, the classes<sup>6</sup> in respect of which that mark is registered or has been applied for, and the goods and services in respect of which that mark is registered and in respect of which the application is based<sup>7</sup>. In addition, where the earlier trade mark has been registered and neither of the relevant conditions applies<sup>8</sup>, the statement of grounds must include a statement detailing whether during the relevant period<sup>9</sup> the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based or whether there are proper reasons for non-use<sup>10</sup> (a 'statement of use')<sup>11</sup>. Where the application is based on an unregistered trade mark or other sign which the opponent claims to be protected by virtue of any rule of law (in particular the law of passing off)<sup>12</sup>, the statement of grounds must include a representation of that mark or sign and the goods or services in respect of which such protection is claimed<sup>13</sup>.

The registrar must send<sup>14</sup> a copy of the form<sup>15</sup> and the statement of grounds to the proprietor<sup>16</sup>. Within six weeks of the date on which the registrar sends a copy of the form<sup>17</sup> and the statement to the proprietor, the proprietor must file his own form<sup>18</sup> including a counter-statement<sup>19</sup>. If the proprietor fails to file such a form<sup>20</sup> within that time, the registrar may treat him as not opposing the application<sup>21</sup>.

The registrar must send a copy of the form<sup>22</sup> to the applicant; and the date on which this is done is the 'initiation date'<sup>23</sup>. The applicant must, within six weeks of the initiation date, file<sup>24</sup> any evidence he may consider necessary to adduce in support of his application<sup>25</sup>. Where the application is based on an earlier trade mark, neither of the relevant conditions applies<sup>26</sup>, and the applicant or holder has either denied or not admitted the truth of a matter set out in the statement of use, then the opponent must also file<sup>27</sup> evidence supporting the statement of use<sup>28</sup>. Where the applicant files no evidence he is, unless the registrar otherwise directs, deemed to have withdrawn his application<sup>29</sup>. The registrar must notify the proprietor of any such direction<sup>30</sup>.

The proprietor may, within six weeks of the applicant's evidence being filed or the registrar sending him notification of a direction to permit the applicant to proceed without evidence, file<sup>31</sup> such evidence as he may consider necessary to adduce in support of his case<sup>32</sup>.

Where the proprietor files such evidence, the applicant may within six weeks file<sup>33</sup> evidence in reply; such evidence must be confined to matters strictly in reply to the proprietor's evidence<sup>34</sup>.

The registrar may at any time if he thinks fit give leave to either party to file<sup>35</sup> evidence upon such terms as he thinks fit<sup>36</sup>.

When the periods for filing evidence have expired, the registrar must request that the parties give written notice of whether they wish to be heard<sup>37</sup>. If any party requests to be heard the registrar must send to the parties notice of a date for the hearing<sup>38</sup>.

1 As to the registrar see PARA 17 ante.

2 le under the Trade Marks Act 1994 s 47(1): see PARAS 118, 396 ante.

3 le on Form TM26(I). As to the use of forms see PARA 353 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 33(1) (r 33 substituted by SI 2004/947).

5 For the meaning of 'earlier trade mark' see PARA 70 ante. The applicant need not be the proprietor of the earlier trade mark relied upon (*BALMORAL Trade Mark* [1999] RPC 297, Appointed Person) unless the Trade Marks Act 1994 s 60(3) applies (see PARA 154 ante). If it is registered the earlier trade mark must be presumed to be validly registered unless the applicant brings separate proceedings to challenge that registration: see s 72; and PARA 110 ante.

6 As to classification of goods and services see PARA 369 et seq ante.

7 Trade Marks Rules 2000, SI 2000/136, r 33(2)(a)-(d), (3) (as substituted: see note 4 supra).

8 le the conditions specified in the Trade Marks Act 1994 s 47(2A)(a) or (b) (as added): see PARA 119 ante.

9 le the period specified in ibid s 47(2B)(a) (as added): see PARA 119 ante.

10 As to genuine use and proper reasons for non-use see PARA 114 ante.

11 Trade Marks Rules 2000, SI 2000/136, r 33(2)(e) (as substituted: see note 4 supra).

12 As to reliance upon such earlier rights see PARA 77 ante. The opponent need not be the proprietor of the earlier right relied upon: *WILD CHILD Trade Mark* [1998] RPC 455, Appointed Person.

13 Trade Marks Rules 2000, SI 2000/136, r 33(4) (as substituted: see note 4 supra).

14 For the meaning of 'send' see PARA 25 note 14 ante.

15 le Form TM26(I).

16 Trade Marks Rules 2000, SI 2000/136, r 33(5) (as substituted: see note 4 supra). For the meaning of 'proprietor' see PARA 22 note 8 ante.

17 le Form TM26(I).

18 le Form TM8. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

19 Trade Marks Rules 2000, SI 2000/136, r 33(6) (as substituted: see note 4 supra).

20 le Form TM8.

21 Trade Marks Rules 2000, SI 2000/136, r 33(6) (as substituted: see note 4 supra). As to the exercise of the registrar's discretion if the proprietor files the Form TM8 late see *Lowden v Lowden Guitar Co Ltd* [2004] EWHC 2531 (Ch), sub nom *LOWDEN Trade Mark* [2005] RPC 377; *Music Choice Ltd v Target Brands Inc* [2005] EWHC 3323 (Ch), sub nom *Music Choice Ltd's Trade Mark* [2006] RPC 358; *Argentum Ltd v Middlesex Silver Co Ltd* [2005] EWHC 2992 (Ch), sub nom *ARGENTUM Trade Mark* [2006] RPC 509. The registrar must give the proprietor a hearing as required by the Trade Marks Rules 2000, SI 2000/136, r 54 (see PARA 358 ante) before exercising his discretion: *MOVIESTAR Trade Mark* [2005] RPC 623, Appointed Person.

22 le Form TM8.

23 Trade Marks Rules 2000, SI 2000/136, r 33(7) (as substituted: see note 4 supra).

24 For these purposes, evidence is only considered filed when it had been received by the registrar accompanied by Form TM54 and it has been sent to all other parties to the proceedings: ibid r 33A(7) (r 33A added by SI 2004/947).

25 Trade Marks Rules 2000, SI 2000/136, r 33A(1)(a) (as added: see note 24 supra).

26 See note 8 supra.

27 See note 24 supra.

28 Trade Marks Rules 2000, SI 2000/136, r 33A(1)(b) (as added: see note 24 supra).

29 Ibid r 33A(2) (as added: see note 24 supra). As to the exercise of the registrar's discretion see PARA 384 note 58 ante.

30 Ibid r 33A(3) (as added: see note 24 supra).

31 See note 24 supra.

32 Trade Marks Rules 2000, SI 2000/136, r 33A(4) (as added: see note 24 supra).

33 See note 24 supra.

34 Trade Marks Rules 2000, SI 2000/136, r 33A(5) (as added: see note 24 supra). As to what constitutes 'matters strictly in reply' see PARA 384 note 63 ante.

35 See note 24 supra.

36 Trade Marks Rules 2000, SI 2000/136, r 33A(6) (as added: see note 24 supra).

37 Ibid r 33A(8) (as added: see note 24 supra).

38 Ibid r 33A(9) (as added: see note 24 supra).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

## **400 Application for declaration of invalidity**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 41, 42.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/401. Application for rectification of the register.

#### **401. Application for rectification of the register.**

An application to the registrar<sup>1</sup> for rectification of an error or omission in the register<sup>2</sup> must be made on the appropriate form<sup>3</sup> together with a statement of the grounds on which the application is made and any evidence in support of those grounds<sup>4</sup>. Where the application is made by a person other than the proprietor<sup>5</sup>, the registrar must send<sup>6</sup> a copy of the application, statement and any evidence filed to the proprietor, and may give such direction as he thinks fit with regard to the filing of subsequent evidence upon such terms as he thinks fit<sup>7</sup>. Such a direction may include a requirement that evidence is only to be considered filed when it has been received by the registrar accompanied by the relevant form<sup>8</sup> and it has been sent to all other parties to the application<sup>9</sup>.

When the periods for filing evidence specified in such directions have expired, the registrar must request the parties to state by notice to him in writing whether they wish to be heard; if any party requests to be heard the registrar must send to the parties notice of a date for the hearing<sup>10</sup>.

- 1 As to the registrar see PARA 17 ante.
- 2 I.e. under the Trade Marks Act 1994 s 64(1); see PARA 121 ante.
- 3 I.e. Form TM26(R). As to the use of forms see PARA 353 ante.
- 4 Trade Marks Rules 2000, SI 2000/136, r 34(1).
- 5 For the meaning of 'proprietor' see PARA 22 note 8 ante.
- 6 For the meaning of 'send' see PARA 25 note 14 ante.
- 7 Trade Marks Rules 2000, SI 2000/136, r 34(2).
- 8 I.e. Form TM54.
- 9 Trade Marks Rules 2000, SI 2000/136, r 34(2A) (added by SI 2004/947).
- 10 Trade Marks Rules 2000, SI 2000/136, r 34(3) (amended by SI 2004/947).

#### **UPDATE**

#### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

#### **401 Application for rectification of the register**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 44.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/402. Interveners.

## **402. Interveners.**

Any person, other than the registered proprietor<sup>1</sup>, claiming to have an interest<sup>2</sup> in proceedings on an application to the registrar<sup>3</sup> for revocation or for a declaration of invalidity or for rectification may file an application to the registrar<sup>4</sup> for leave to intervene, stating the nature of his interest; and the registrar may, after hearing the parties concerned if so required, refuse such leave or grant leave upon such terms or conditions, including any undertaking as to costs, as he thinks fit<sup>5</sup>.

1 For the meaning of 'proprietor' see PARA 22 note 8 ante.

2 See *Gardinol Chemical Co Ltd's Application* (1948) 65 RPC 455; *Silexine Paints Ltd's Application* (1953) 71 RPC 91.

3 As to the registrar see PARA 17 ante.

4 See Form TM27. As to the use of forms see PARA 353 ante. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

5 Trade Marks Rules 2000, SI 2000/136, r 35(1). Any person granted leave to intervene ('the intervener') is treated, subject to the terms and conditions imposed in respect of the intervention, as a party for the purposes of the application of the provisions of rr 31-31B (as amended), rr 32-32B (as amended), rr 33-33B (as amended) or r 34 (as substituted) as appropriate (see PARAS 398-401 ante) to the proceedings on such an application: r 35(2) (amended by SI 2004/947).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

## **402 Interveners**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 45.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(3) OTHER PROCEEDINGS IN THE TRADE MARKS REGISTRY/(iii) Revocation, Declaration of Invalidity and Rectification/403. Notification of decision.

#### **403. Notification of decision.**

When the registrar<sup>1</sup> has made a decision on an application to him for revocation or for a declaration of invalidity or for rectification following any opposition, intervention or proceedings duly held<sup>2</sup>, he must send the parties<sup>3</sup> to the proceedings written notice of it, stating the reasons for his decision<sup>4</sup>; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent is taken to be the date of the decision<sup>5</sup>.

<sup>1</sup> As to the registrar see PARA 17 ante.

<sup>2</sup> Is held in accordance with the Trade Marks Rules 2000, SI 2000/136, rr 31-31B (as amended), rr 32-32A (as amended), rr 33-33A (as amended) or r 34 (as substituted): see PARAS 398-401 ante.

<sup>3</sup> This includes interveners: see PARA 402 ante.

<sup>4</sup> Trade Marks Rules 2000, SI 2000/136, rr 31B(1), 32B(1), 33B(1), 34(4) (rr 31B, 32B, 33B added, and r 34 substituted, by SI 2004/947).

<sup>5</sup> Trade Marks Rules 2000, SI 2000/136, rr 31B(2), 32B(2), 33B(2), 34(4) (rr 31B, 32B, 33B as added, and r 34 as substituted: see note 4 supra).

#### **UPDATE**

#### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/(i) Right of Appeal/404. Registrar's decision.

## **(4) APPEALS FROM THE REGISTRAR**

### **(i) Right of Appeal**

#### **404. Registrar's decision.**

When, in any proceedings before him<sup>1</sup>, the registrar<sup>2</sup> has made a decision, he must send<sup>3</sup> notice of his decision in writing to each party to the proceedings; and, for the purpose of any appeal against the registrar's decision, the date of the decision is the date when the notice is sent<sup>4</sup>. Where, however, a statement of the reasons for the decision is not included in the notice so sent, any party may, within one month of the date on which the notice was sent to him, request the registrar<sup>5</sup> to send him a statement of the reasons for the decision and upon such request the registrar must send such a statement; and the date on which that statement is sent is deemed to be the date of the registrar's decision for the purpose of any appeal against it<sup>6</sup>.

1 As to the procedural powers of the registrar see PARA 358 et seq ante.

2 As to the registrar see PARA 17 ante.

3 For the meaning of 'send' see PARA 25 note 14 ante.

4 Trade Marks Rules 2000, SI 2000/136, r 62(1). Where the registrar has issued a reasoned decision the decision is final and the registrar has no power to reconsider it save in exceptional circumstances: *Andreas Stihl AG & Co's Trade Mark Application*[2001] RPC 215, Appointed Person; *Hyde's Trade Mark Application (No 2)* (O/333/05), Appointed Person.

5 Ie on Form TM5. As to the use of forms see PARA 353 ante.

6 Trade Mark Rules 2000, SI 2000/136, r 62(2). As to appeals from decisions of the registrar, including acts of the registrar in exercise of a discretion, see PARA 405 et seq post. The registrar's practice is to give interim decisions orally and/or by letter. Even if these contain outline reasons, the registrar will issue a formal decision containing full reasons upon receipt of Form TM5. It is not clear whether the registrar has power to reconsider his decision between giving notice of the decision and giving his full reasons.

### **UPDATE**

#### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

#### **404 Registrar's decision**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 69.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/(i) Right of Appeal/405. Choice of forum.

#### **405. Choice of forum.**

An appeal lies from any decision<sup>1</sup> of the registrar under the Trade Marks Act 1994, except as otherwise expressly provided by rules<sup>2</sup>. The registrar's practice is to treat the filing of an appeal as suspensive of the decision under appeal<sup>3</sup>.

Any such appeal may be brought either to an appointed person<sup>4</sup> or to the court<sup>5</sup>. Subject only to the appointed person's power to refer the appeal to the court<sup>6</sup>, the appellant may bring the appeal before the tribunal of his choice. The appointed person is a specialist tribunal which is intended to provide a more informal, speedier and cheaper forum<sup>7</sup>. Thus there are no restrictions on rights of audience and the usual practice of the appointed persons is not to award costs in ex parte appeals<sup>8</sup> and, like the registrar<sup>9</sup>, only to make modest awards of costs in inter partes appeals. On an appeal to the court there is a further right of appeal in the ordinary way<sup>10</sup>. Where an appeal is made to an appointed person and he does not refer it to the court, he must hear and determine the appeal and his decision is final<sup>11</sup>. However, such a decision will doubtless be open to attack by way of judicial review in case of error of law<sup>12</sup>.

1 For these purposes, 'decision' includes any act of the registrar in exercise of a discretion vested in him by or under the Trade Marks Act 1994: s 76(1). As to the registrar see PARA 17 ante; and as to his decision see PARA 404 ante.

2 Ibid s 76(1). The only matters in respect of which the Trade Marks Rules 2000, SI 2000/136 (as amended) exclude appeals and render the decision of the registrar final are matters involving a change of classification (see rr 46(4), 47(3); and PARA 392 ante) which are consistent with the Trade Marks Act 1994 s 34(2) (see PARA 369 ante) and a decision to make a filed document or part of it confidential (see the Trade Marks Rules 2000, SI 2000/136, r 50(5); and PARA 25 ante).

3 *Nettec Solutions Ltd's Trade Mark Application* [2003] RPC 308, Appointed Person.

4 For the meaning of 'appointed person' see PARA 406 post. As to the procedure on appeals to the appointed person see PARA 407 post. The provisions of the Trade Marks Act 1994 s 76 in effect widen the former system under which essentially only certain disputes between a party and the registrar could optionally be appealed to the Secretary of State (see eg the Trade Marks Act 1938 s 17(4) (repealed)). As to the Secretary of State see PARA 14 ante.

5 Trade Marks Act 1994 s 76(2). For the purposes of appeals in England and Wales 'the court' means the High Court: s 76(6) (added by the High Court and County Courts Jurisdiction (Amendment) Order 2005, SI 2005/587, art 4(1), (3)).

6 See the Trade Marks Act 1994 s 76(3); and PARA 408 ante.

7 See *AJ & MA Levy's Trade Mark (No 2)* [1999] RPC 358, Appointed Person; *ACADEMY Trade Mark* [2000] RPC 35, Appointed Person.

8 *AD2000 Trade Mark* [1997] RPC 168, Appointed Person; cf *SM Jaleel & Co Ltd's Trade Mark Application* [2000] RPC 471, Appointed Person. Ex parte appeals are those in disputes between an applicant and the registrar.

9 See PARA 360 ante.

10 As to appeals to the Court of Appeal generally see CIVIL PROCEDURE vol 12 (2009) PARA 1701 et seq.

11 See the Trade Marks Act 1994 s 76(4); and PARA 407 post.

12 *Hyde's Trade Mark Application (No 2)* (O/333/05), Appointed Person.

**UPDATE**

**381-408 Acceptance or refusal of application for a registered trade mark ...  
Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

**405 Choice of forum**

NOTE 2--See now Trade Marks Rules, SI 2008/1797, rr 54(4), 55(2), 58(5).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (ii) Appeals to the Appointed Person/406. Persons appointed to hear and determine appeals.

## **(ii) Appeals to the Appointed Person**

### **406. Persons appointed to hear and determine appeals.**

An 'appointed person' means<sup>1</sup> a person appointed by the Lord Chancellor to hear and decide appeals under the Trade Marks Act 1994<sup>2</sup>. A person is not eligible for such appointment unless: (1) he has a seven-year general qualification<sup>3</sup>; (2) he is an advocate or solicitor in Scotland of at least seven years' standing<sup>4</sup>; (3) he is a member of the Bar of Northern Ireland or solicitor of the Supreme Court of Northern Ireland of at least seven years' standing<sup>5</sup>; or (4) he has held judicial office<sup>6</sup>.

An appointed person holds and must vacate office in accordance with his terms of appointment, subject to the following<sup>7</sup>:

- 535 (a) there must be paid to him such remuneration (whether by way of salary or fees), and such allowances, as the Secretary of State<sup>8</sup> with the approval of the Treasury may determine<sup>9</sup>;
- 536 (b) he may resign his office by notice in writing to the Lord Chancellor<sup>10</sup>;
- 537 (c) the Lord Chancellor may by notice in writing remove him from office if he has become bankrupt or made an arrangement with his creditors or, in Scotland, his estate has been sequestrated or he has executed a trust deed for his creditors or entered into a composition contract; or if he is incapacitated by physical or mental illness; or if he is in the opinion of the Lord Chancellor otherwise unable or unfit to perform his duties as an appointed person<sup>11</sup>.

The Lord Chancellor must consult the Secretary of State before exercising his powers under the above provisions<sup>12</sup>. He may only remove an appointed person from office with the concurrence of the appropriate senior judge<sup>13</sup>.

1    Ie for the purposes of the Trade Marks Act 1994 s 76: see PARAS 405 ante, 407-408 post.

2    Ibid s 77(1). A person so appointed is disqualified for membership of the House of Commons: see the House of Commons Disqualification Act 1975 s 1(1)(f), Sch 1 Pt III (amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 6). In practice the persons so appointed are selected from lawyers experienced in trade mark matters.

3    Trade Marks Act 1994 s 77(2)(a). As to the qualification see the Courts and Legal Services Act 1990 s 71 (as amended); and LEGAL PROFESSIONS vol 65 (2008) PARA 742.

4    Trade Marks Act 1994 s 77(2)(b).

5    Ibid s 77(2)(c). As from a day to be appointed this provision is amended so as to refer to a member of the Bar of Northern Ireland or solicitor of the Court of Judicature: s 77(3)(c) (prospectively amended by the Constitutional Reform Act 2005 s 59(5), Sch 11 Pt 3 para 5). At the date at which this volume states the law no such day had been appointed.

6    Trade Marks Act 1994 s 77(2)(d).

7    Ibid s 77(3).

8 As to the Secretary of State see PARA 14 ante.

9 Trade Marks Act 1994 s 77(3)(a). As to the Treasury see CONSTITUTIONAL LAW AND HUMAN RIGHTS vol 8(2) (Reissue) PARA 512 et seq.

10 Ibid s 77(3)(b).

11 Ibid s 77(3)(c).

12 Ibid s 77(4) (amended by virtue of the Transfer of Functions (Lord Advocate and Secretary of State) Order 1999, SI 1999/678, art 2(1), Schedule).

13 Trade Marks Act 1994 s 77(5) (added by the Constitutional Reform Act 2005 s 15(1), Sch 4 para 238). The appropriate senior judge is the Lord Chief Justice of England and Wales unless the person to be removed exercises functions wholly or mainly in Scotland (in which case it is the Lord President of the Court of Session) or in Northern Ireland (in which case it is the Lord Chief Justice of Northern Ireland): Trade Marks Act 1994 s 77(6) (as so added).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **406 Persons appointed to hear and determine appeals**

TEXT AND NOTES 3-5--1994 Act s 77(2)(a) substituted, s 77(2)(b), (c) amended: Tribunals, Courts and Enforcement Act 2007 Sch 10 para 25.

NOTE 5--Appointed day is 1 October 2009: SI 2009/1604.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (ii) Appeals to the Appointed Person/407. Procedure on appeal to appointed person.

#### **407. Procedure on appeal to appointed person.**

Notice of appeal to the appointed person<sup>1</sup> must be filed on the appropriate form<sup>2</sup> which must include the appellant's grounds of appeal and his case in support of the appeal<sup>3</sup>. The notice must be filed with the registrar<sup>4</sup> within the period of 28 days beginning on the date of the registrar's decision<sup>5</sup> which is the subject of the appeal<sup>6</sup>. The registrar must send<sup>7</sup> the notice and statement to the appointed person<sup>8</sup>. Where any person other than the appellant was a party to the proceedings before the registrar in which the decision appealed against was made, the registrar must send to that person a copy of the notice and the statement<sup>9</sup>.

Where an appeal is made to an appointed person and he does not refer it to the court<sup>10</sup>, he must send written notice of the time and place appointed for the oral hearing of the appeal<sup>11</sup>:

538 (1) where no person other than the appellant was a party to the proceedings in which the decision appealed against was made, to the registrar and to the appellant<sup>12</sup>; and

539 (2) in any other case, to the registrar<sup>13</sup> and to each person who was a party to those proceedings<sup>14</sup>.

540 The notice must be sent at least 14 days before time appointed for the oral hearing<sup>15</sup>. If all the persons notified inform the appointed person that they do not wish to make oral representations, the appointed person may hear and determine the case on the basis of any written representations and the oral hearing may be vacated<sup>16</sup>.

The appointed person has the same powers in relation to costs, security for costs and evidence as the registrar<sup>17</sup>. He also has an inherent power to regulate procedure before him<sup>18</sup>; and this includes power to allow amendment to the grounds of appeal before him, even at a late stage<sup>19</sup>.

The appointed person must hear and determine the appeal<sup>20</sup>, and his decision is final<sup>21</sup>. He must send a copy of his decision, with a statement of his reasons for it, to the registrar and to each person who was a party to the proceedings before him<sup>22</sup>.

1    I.e. the person appointed under the Trade Marks Act 1994 s 76: see PARA 405 ante. For the meaning of 'appointed person' see PARA 406 ante.

2    I.e. Form TM55. As to the use of forms see PARA 353 ante. For the meaning of references to 'filing' see PARA 25 note 2 ante. As to the filing of documents by electronic means see PARA 354 ante.

3    Trade Marks Rules 2000, SI 2000/136, r 63(1) (substituted by SI 2004/947). Neither prolixity nor formality are required in the statement of case; it should outline each of the grounds of appeal relied upon and state the case relied upon in support of those grounds. It is not acceptable to reserve the right to elaborate further unidentified arguments at the hearing of the appeal: *COFFEEMIX Trade Mark* [1998] RPC 717, Appointed Person.

4    As to the registrar see PARA 17 ante.

5    As to the registrar's decision see PARA 404 ante.

6    Trade Marks Rules 2000, SI 2000/136, r 63(1A) (added by SI 2004/947).

7    For the meaning of 'send' see PARA 25 note 14 ante.

8 Trade Marks Rules 2000, SI 2000/136, r 63(2).

9 Ibid r 63(3). The rules do not provide for the service of a respondent's notice if the respondent wishes to contend that the registrar's decision should be upheld for additional or alternative reasons, but nevertheless the appointed person can permit one to be served and it is good practice to do so: *ACADEMY Trade Mark* [2000] RPC 35, Appointed Person; *Mustafov's Trade Mark Application* (O/218/05), Appointed Person. It is unclear whether the appointed person has power to permit the respondent to cross-appeal by way of respondent's notice: *EXTREME Trade Mark* (O/161/07), Appointed Person.

10 As to the referral of questions to the court see the Trade Marks Act 1994 s 76(3); and PARA 408 post. For the meaning of 'the court' see PARA 405 note 5 ante.

11 Trade Marks Rules 2000, SI 2000/136, r 65(1) (r 65 substituted by SI 2004/947).

12 Trade Marks Rules 2000, SI 2000/136, r 65(1)(a) (as substituted: see note 11 supra).

13 This enables the registrar to appear if he so wishes in appeals which involve parties opposed to each other. He appears not so much as an adversary to the appellant but with a view to commenting on matters of trade mark law and other matters affecting the registry: *CORGI Trade Mark* [1999] RPC 549, Appointed Person.

14 Trade Marks Rules 2000, SI 2000/136, r 65(1)(b) (as substituted: see note 11 supra).

15 Ibid r 65(2) (as substituted: see note 11 supra).

16 Ibid r 65(3) (as substituted: see note 11 supra).

17 Trade Marks Act 1994 s 76(5), applying ss 68-69 (see PARAS 358-360 ante). The Trade Marks Rules 2000, SI 2000/136, r 55 (see PARA 359 ante), r 56 (see PARA 359 ante), r 57 (see PARA 359 ante), r 58 (as amended) (see PARA 358 ante), r 60 (see PARA 360 ante) and r 61 (see PARA 360 ante) apply to the appointed person and to proceedings before him as they apply to the registrar and to proceedings before the registrar: r 65(4) (as substituted: see note 11 supra). If there is an oral hearing r 59 (see PARA 358 ante) applies: r 65(5) (as so substituted).

18 *ACADEMY Trade Mark* [2000] RPC 35, Appointed Person; *Pharmedica GmbH's Trade Mark Application* [2000] RPC 536, [2000] All ER (D) 28.

19 *COFFEEMIX Trade Mark* [1998] RPC 717, Appointed Person.

20 CPR 52.11 does not apply to appeals to the appointed person, but the appointed person adopts the same approach of treating appeals as limited to a review of the registrar's decision unless justice requires a re-hearing: *ROYAL ENFIELD Trade Marks* [2002] RPC 508, Appointed Person. Accordingly, the appointed person applies the same principles as the court (as to which see PARA 414 post). See also PARA 409 et seq post.

21 Trade Marks Act 1994 s 76(4). The appointed person may only re-consider his decision in exceptional circumstances: *Hyde's Trade Mark Application (No 2)* (O/333/05), Appointed Person. It appears that in principle the appointed person is amenable to judicial review.

22 Trade Marks Rules 2000, SI 2000/136, r 65(6) (as substituted: see note 11 supra).

## UPDATE

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **407 Procedure on appeal to appointed person**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, rr 71-73. An interim decision may only be appealed against independently of any appeal against a final decision with the leave of the registrar: r 70.





Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (ii) Appeals to the Appointed Person/408. Transfer to the court of an appeal to appointed person.

#### **408. Transfer to the court of an appeal to appointed person.**

Where an appeal is made to an appointed person<sup>1</sup>, he may refer the appeal to the court<sup>2</sup> if:

- 541 (1) it appears to him that a point of general legal importance is involved<sup>3</sup>;
- 542 (2) the registrar<sup>4</sup> requests that it be so referred<sup>5</sup>; or
- 543 (3) such a request is made by any party to the proceedings before the registrar in which the decision appealed against was made<sup>6</sup>.

Before doing so the appointed person must give the appellant and any other party to the appeal an opportunity to make representations as to whether the appeal should be referred to the court<sup>7</sup>.

In any case where it appears to the appointed person that a point of general legal importance is involved in the appeal, he must send<sup>8</sup> to the registrar and to every party to the proceedings in which the decision appealed against was made notice thereof<sup>9</sup>; and, within 28 days of the date on which a notice is so sent, the person to whom it was sent may make representations as to whether the appeal should be referred to the court<sup>10</sup>.

Any request made under head (2) or head (3) above must be made within 28 days of the date on which the notice of appeal is sent<sup>11</sup> by the registrar<sup>12</sup>; and a request under head (3) above must be sent to the registrar who must send it to the appointed person and send a copy of the request to any other party to the proceedings<sup>13</sup>. Where the registrar so requests that the appeal be referred to the court, he must send a copy of the request to each party to the proceedings<sup>14</sup>. Within 28 days of the date on which a copy of a request is sent<sup>15</sup> by the registrar, the person to whom it is sent may make representations as to whether the appeal should be referred to the court<sup>16</sup>.

Where the appointed person refers an appeal to the Chancery Division of the High Court, the appeal must be brought within 14 days of the reference<sup>17</sup>.

1 For the meaning of 'appointed person' see PARA 406 ante.

2 Trade Marks Act 1994 s 76(3). The power to refer appeals to the High Court should be used sparingly and in the absence of a point of legal importance should be very rare. In addition to points of legal importance, considerations to be taken into account are the views of the parties, the expense involved and the public interest: *ACADEMY Trade Mark* [2000] RPC 35, Appointed Person. The need for authoritative guidance on a point of law, particularly if a request for referral is supported by the registrar and one of the parties, can outweigh the additional expense: *AJ & MA Levy's Trade Mark (No 2)* [1999] RPC 358, Appointed Person. For the meaning of 'the court' in this context see PARA 405 note 5 ante.

3 Trade Marks Act 1994 s 76(3)(a). See also note 2 supra.

4 As to the registrar see PARA 17 ante.

5 Trade Marks Act 1994 s 76(3)(b).

6 Ibid s 76(3)(c).

7 Ibid s 76(3). See also note 2 supra.

- 8 For the meaning of 'send' see PARA 25 note 14 ante.
- 9 Trade Marks Rules 2000, SI 2000/136, r 64(5). See also note 2 supra.
- 10 Ibid r 64(6). See also note 2 supra.
- 11 Ie under ibid r 63(3): see PARA 407 ante.
- 12 Ibid r 64(1).
- 13 Ibid r 64(3).
- 14 Ibid r 64(2).
- 15 Ie under ibid r 64(2) or r 64(3): see the text and notes 13-14 supra.
- 16 Ibid r 64(4).
- 17 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 28.1(1).

## **UPDATE**

### **381-408 Acceptance or refusal of application for a registered trade mark ... Transfer to the court of an appeal to appointed person**

Trade Marks Rules 2000, SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

### **408 Transfer to the court of an appeal to appointed person**

TEXT AND NOTES--See now Trade Marks Rules 2008, SI 2008/1797, r 72.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (iii) Appeals to the High Court/A. BRINGING OF APPEAL/409. In general.

### **(iii) Appeals to the High Court**

#### **A. BRINGING OF APPEAL**

##### **409. In general.**

In England and Wales appeals to the court<sup>1</sup> are assigned to Chancery Division of the High Court<sup>2</sup>. Such appeals are subject to the ordinary procedural rules applying to appeals<sup>3</sup>. Where they require a document to be served, it must also be served on the registrar<sup>4</sup>. The appellant's notice must be served within 28 days after the date of the registrar's decision the subject of the appeal<sup>5</sup> or (if later) the date on which the appellant receives the registrar's statement of reasons<sup>6</sup>.

1 As to the meaning of 'the court' in this context see PARA 405 note 5 ante

2 CPR 63.17(2).

3 I.e. those under CPR Pt 52: CPR 63.17(1).

4 CPR 63.17(3).

5 *Practice Direction--Appeals* PD52 para 17.3. See also Tribunal Practice Notice (TPN 1/2003). Tribunal Practice Notices are available from the Patent Office or on its website, accessible at the date at which this title states the law at [www.patent.gov.uk](http://www.patent.gov.uk) or [www.ipo.gov.uk](http://www.ipo.gov.uk). As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

6 *Practice Direction--Appeals* PD52 para 17.4. As to the registrar's statement of reasons see PARA 404 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (iii) Appeals to the High Court/A. BRINGING OF APPEAL/410. The registrar's role in appeals.

#### **410. The registrar's role in appeals.**

In the case of an appeal from an *ex parte* decision of the registrar (for example, a refusal of an application to register a mark), the registrar is the respondent and normally appears by counsel. In the case of an appeal from a *inter partes* matter (for example, opposition, revocation, invalidity or rectification), the registrar is not the respondent, but in certain cases he is entitled to appear and may be directed to appear by the court<sup>1</sup>. Even when the registrar is entitled to appear, however, he normally does not do so unless a matter of public interest or registry practice arises<sup>2</sup>. If the case is one in which the registrar is not entitled to appear as of right, he may seek permission to intervene if a matter of public interest or registry practice arises<sup>3</sup>. Even if the registrar does not appear (or submit a written statement in lieu of an appearance<sup>4</sup>), the court may request him to provide information as to his practice<sup>5</sup>.

1 See the Trade Marks Act 1994 s 74(1); and PARA 460 post.

2 In such circumstances the registrar asks by letter to be informed if any order other than that asked for or a refusal of the application is to be made, and to be given an opportunity to comment on any such order.

3 See eg *Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, [2002] RPC 639.

4 As to the registrar's power to submit to the court a written statement instead of appearing see the Trade Marks Act 1994 s 74(2); and PARA 460 post.

5 See eg *Phones4U Ltd v Phone4u.co.uk Ltd* [2006] EWCA Civ 244, [2007] RPC 83.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (iii) Appeals to the High Court/B. CONDUCT OF APPEAL/411. Further steps.

## ***B. CONDUCT OF APPEAL***

### **411. Further steps.**

The proceedings on an appeal from the registrar to the High Court are regulated by the general provisions dealing with appeals to the High Court from lower courts or tribunals<sup>1</sup>. After being served with the appellant's notice, the respondent may within 14 days serve a respondent's notice, and must do so if he wishes to ask the High Court to uphold the order of the registrar for reasons different from or additional to those given by the registrar<sup>2</sup>. There is no longer any specific statutory prohibition on fresh grounds of objection (not taken below) being raised on appeal<sup>3</sup> and so the matter will be governed by general principles<sup>4</sup>.

1    Ie by CPR Pt 52, and practice directions made thereunder.

2    CPR 52.5(2)(b), (4)(b).

3    Cf the Trade Marks Act 1938 ss 17(6), 18(9) (both repealed).

4    As to amendment of the grounds of appeal see CPR 52.8. As to admission of fresh evidence see CPR 52.11(2); and PARA 412 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (iii) Appeals to the High Court/B. CONDUCT OF APPEAL/412. Fresh evidence; cross-examination on appeal.

#### **412. Fresh evidence; cross-examination on appeal.**

There is no express mention in the Trade Marks Act 1994 or the rules made under it of any power in the court to admit fresh evidence<sup>1</sup>. The general rule in relation to appeals which by or under any enactment lie to the High Court from any tribunal or person is that such evidence is not admissible unless the court orders otherwise<sup>2</sup>. The discretion to admit fresh evidence is exercised on essentially the same principles as those applicable to any appeal, but there are certain factors which are peculiar to trade mark cases<sup>3</sup>. It may be appropriate for the admissibility of fresh evidence to be heard as a preliminary issue on the appeal<sup>4</sup>.

Under the Trade Marks Act 1938 there was a practice whereby the court allowed on appeal cross-examination of deponents to statutory declarations used before the registrar<sup>5</sup>. This practice has not been adopted under the Trade Marks Act 1994<sup>6</sup> because the registrar is now given power to order disclosure and all the powers of an official referee (now referred to as a judge of the Technology and Construction Court)<sup>7</sup>, thus equating proceedings in the Trade Marks Registry with proceedings in the Patent Office under which cross-examination had to be sought in the tribunal of first instance, namely the Patent Office<sup>8</sup>.

1 There was in some but not all circumstances such a power under the Trade Marks Act 1938: see eg s 18(8) (repealed).

2 See CPR 52.11(2); and CIVIL PROCEDURE vol 12 (2009) PARA 1672.

3 See *El Du Pont De Nemours & Co v ST Dupont* [2003] EWCA Civ 1368, [2006] 1 WLR 2793, sub nom *DU PONT Trade Mark* [2004] FSR 293 (in which the earlier authorities are reviewed); *Ladd v Marshall* [1954] 3 All ER 745, [1954] 1 WLR 1489, CA (in which the basic factors are set out). Additional factors which may be relevant are the nature of the mark and the objections to it, the desirability of avoiding multiplicity of proceedings and the public interest in not admitting invalid trade marks onto the register.

4 *El Du Pont De Nemours & Co v ST Dupont* [2003] EWCA Civ 1368, [2006] 1 WLR 2793, sub nom *DU PONT Trade Mark* [2004] FSR 293.

5 See *Re Kidax Ltd's Application* [1959] RPC 167, CA. Justification for this included the fact that the registrar under the Trade Marks Act 1938 had limited powers eg he had no power to order disclosure.

6 See *Alliance & Leicester plc's Trade Mark Application* [2002] RPC 573.

7 See the Trade Marks Rules 2000, SI 2000/136, r 58; and PARA 358 ante.

8 *J Sainsbury Ltd's Application* [1981] FSR 406, CA. Cf PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 595. As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

#### **UPDATE**

#### **412 Fresh evidence; cross-examination on appeal**

NOTE 7--SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (iii) Appeals to the High Court/B. CONDUCT OF APPEAL/413. Costs of appeals.

#### **413. Costs of appeals.**

In appeals to the High Court under the Trade Marks Act 1994 costs normally follow the event in accordance with the general practice<sup>1</sup>. There is no longer any express statutory provision as to the registrar's costs<sup>2</sup> so they are in the discretion of the court in the normal way. The general rule is, however, likely to remain unchanged, namely that, where the registrar appears to defend his own decision and loses, he will be ordered to pay the costs<sup>3</sup>. Where he appears primarily to assist the court, no order as to his costs will normally be made<sup>4</sup>, but he nevertheless may be ordered to pay costs<sup>5</sup>. Where rights in a pending application are assigned while proceedings are pending, an order for costs may be made in favour of both assignor and assignee<sup>6</sup>.

1 As to costs generally see PARA 449 post; and CIVIL PROCEDURE vol 12 (2009) PARA 1672.

2 ie as there was under the Trade Marks Act 1938 s 48 (repealed).

3 See *Svenska AB Gasaccumulator's Application* [1962] 1 All ER 886 at 896, [1962] 1 WLR 657n at 671n, [1962] RPC 106 at 117, CA; *STILTON Trade Mark* [1967] RPC 173.

4 See eg *PHANTOM Trade Mark* [1978] RPC 245, CA.

5 See *PNEUVEYOR Trade Mark* [1967] FSR 542 (where administrative errors caused the dispute between the parties, and the registrar was ordered to pay both the applicant's and the respondent's costs of rectification proceedings).

6 *Re Marly Laboratory Ltd's Application* [1952] 1 All ER 1057, 69 RPC 156, CA.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (iii) Appeals to the High Court/C. THE COURT'S POWERS/414. The court's power to review the registrar's decision.

### **C. THE COURT'S POWERS**

#### **414. The court's power to review the registrar's decision.**

An appeal to the High Court from the registrar is limited to a review of the decision below unless the court considers that in the circumstances of an individual appeal it would be in the interests of justice to hold a re-hearing<sup>1</sup>. Unlike under the Trade Marks Act 1938<sup>2</sup>, the court has no power to exercise its own discretion as opposed to reviewing the registrar's exercise of discretion<sup>3</sup>. This is mainly relevant to case management issues, since the registrar has no discretion to refuse to register a trade mark which satisfies the requirements for registration<sup>4</sup>.

Neither the Trade Marks Act 1994 nor the Trade Marks Rules 2000<sup>5</sup> provide for the court's powers on an appeal. Accordingly the court has all the powers of the registrar<sup>6</sup>.

1 CPR 52.11(1). See also *El Du Pont De Nemours & Co v ST Dupont*[2003] EWCA Civ 1368, [2006] 1 WLR 2793, sub nom *DU PONT Trade Mark* [2004] FSR 293. This applies even in the case of an appeal from an ex parte decision of the registrar: *Dyson Ltd v Registrar of Trade Marks* [2003] EWHC 1062 (Ch), [2003] 1 WLR 2406, sub nom *Dyson Ltd's Trade Mark Application*[2003] RPC 821. As to the correct approach to a review of the registrar's decision see *South Cone Inc v Bessant (t/a Reef)* [2002] EWCA Civ 763, sub nom *REEF Trade Mark*[2003] RPC 101; *El Du Pont De Nemours & Co v ST Dupont*, sub nom *DU PONT Trade Mark* supra.

2 Trade Marks Act 1938 s 52 (repealed).

3 See the Trade Marks Act 1994 s 76(1); and PARA 405 ante.

4 See PARA 111 ante.

5 Ie the Trade Marks Rules 2000, SI 2000/136 (as amended).

6 CPR 52.10(1).

### **UPDATE**

#### **414 The court's power to review the registrar's decision**

NOTE 5--SI 2000/136 replaced: Trade Marks Rules 2008, SI 2008/1797 (see PARA 352-375).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(4) APPEALS FROM THE REGISTRAR/ (iii) Appeals to the High Court/D. REGISTRATION AFTER APPEAL AND OF COURT ORDERS/415. In general.

#### ***D. REGISTRATION AFTER APPEAL AND OF COURT ORDERS***

##### **415. In general.**

If the court on appeal decides in favour of registration, then, unless the court otherwise orders, the mark is registered at once, even though the registrar or opponent appeals further<sup>1</sup>. There is no longer any express provision in the Trade Marks Act 1994 or the rules made thereunder governing the registration of orders of the court<sup>2</sup>. Such orders are normally registered all the same.

<sup>1</sup> *Re Dubonnet SA's Application* (1915) 32 RPC 241, CA; *Re F Reddaway & Co Ltd's Application* [1925] Ch 693, 42 RPC 397, CA.

<sup>2</sup> As to the matters required to be entered in the register see PARA 22 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(i) Bringing of Proceedings/416. In general.

## **(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF**

### **(i) Bringing of Proceedings**

#### **416. In general.**

An infringement<sup>1</sup> of a registered trade mark<sup>2</sup> or of a protected international trade mark (UK)<sup>3</sup> is actionable by the proprietor<sup>4</sup> of the trade mark<sup>5</sup>.

No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such; but nothing in the Trade Marks Act 1994 affects the law of passing off<sup>6</sup>.

Actions for infringement of a registered trade mark or a protected international trade mark (UK) may be brought in the High Court or a designated county court; while actions for passing off may be brought in the High Court or, it would seem, any county court<sup>7</sup>. Such actions are, therefore, subject to the Civil Procedure Rules generally, there being no special rules relating to passing off, and only limited special provisions<sup>8</sup> relating to infringement of trade marks. Actions are often brought for both infringement and passing off; and for procedural purposes it is convenient to discuss them together, although they are distinct causes of action.

The jurisdiction of the courts, and of the courts of other member states, in relation to actions for infringement of a Community trade mark is dealt with elsewhere in this title<sup>9</sup>.

1 For the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see the Trade Marks Act 1994 s 10; and PARA 86 et seq ante. An action in respect of a threatened act of infringement may be brought on the quia timet basis on ordinary principles: see CIVIL PROCEDURE vol 11 (2009) PARAS 362, 365, 367; EQUITY vol 16(2) (Reissue) PARA 484.

2 As to the meaning of 'registered trade mark' see PARA 127 ante.

3 As to protected international trade marks (UK) see PARA 13 ante.

4 For the meaning of references to the proprietor of a registered trade mark in the provisions relating to infringement see the Trade Marks Act 1994 s 31(1), (2); and PARA 419 note 5 post.

5 Ibid s 14(1). In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to the proprietor as is available in respect of the infringement of any other property right: s 14(2). As to infringement proceedings by a co-proprietor see s 23(5); and PARA 128 ante.

Section 14 applies in relation to infringement of an existing registered mark committed on or after 31 October 1994, subject to s 105, Sch 3 para 4(2) (see PARA 97 ante), and the old law continues to apply in relation to infringements committed before that date: Sch 3 para 4(1). For the meaning of 'existing registered mark' see PARA 4 note 2 ante; and for the meaning of 'the old law' see PARA 4 note 3 ante.

6 Ibid s 2(2). See *Inter Lotto (UK) Ltd v Camelot Group plc* [2003] EWCA Civ 1132, [2003] 4 All ER 575, [2004] RPC 186. As to passing off see PARA 304 et seq ante.

7 See PARA 349 ante.

8 Ie CPR 63.14, 63.15; and *Practice Direction--Patents and Other Intellectual Property Claims* PD63 paras 18.1-23.1.

9 See PARAS 257 et seq, 349 ante. Note, however, that where the legislation providing for the Community trade mark does not cover a specific matter, the court must apply the rules applicable in national proceedings: see PARA 257 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(i) Bringing of Proceedings/417. Parties.

#### **417. Parties.**

The claimant in an action for infringement of a registered trade mark<sup>1</sup> is usually the registered proprietor. Nevertheless it seems probable that, as under previous Acts<sup>2</sup>, the assignee of a mark may commence proceedings even though his title has not yet been registered<sup>3</sup>. Licensees<sup>4</sup> and exclusive licensees<sup>5</sup> and authorised users of a registered collective mark<sup>6</sup> or a registered certification mark<sup>7</sup> are provided for separately. Civil proceedings lie against the Crown for an infringement committed by a servant or agent of the Crown, with the authority of the Crown, of a registered trade mark<sup>8</sup>.

In an action for passing off the proper claimant is the trader whose goodwill has been or is likely to be injured by the passing off<sup>9</sup>.

All persons may be joined as defendants against whom the right to any relief is alleged to exist, whether jointly, severally or in the alternative<sup>10</sup>. Vicarious<sup>11</sup> and joint<sup>12</sup> liability may be asserted on ordinary principles.

1 As to the meaning of 'registered trade mark' see PARA 127 ante.

2 See *Ihlee v Henshaw* (1886) 31 ChD 323; *Magnolia Metal Co v Atlas Metal Co* (1897) 14 RPC 389, CA.

3 See, by way of further illustration, the Trade Marks Act 1994 s 9 (see PARAS 84-85 ante), s 10 (see PARA 86 et seq ante) and s 14 (see PARA 416 ante), which refer to 'the proprietor' not 'the registered proprietor'. Doubtless the registered proprietor would have to be joined in the action as either claimant or defendant; and the assignee ought to register his assignment as soon as possible, particularly since by virtue of s 25(4) (see PARA 130 ante), he loses his rights to financial compensation. Cf the similar position of an assignee of a patent: see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 521.

4 See PARA 418 post.

5 See PARA 419 post.

6 See PARA 162 ante.

7 See PARA 173 ante.

8 Crown Proceedings Act 1947 s 3(1)(b) (s 3(1) substituted by the Copyright, Designs and Patents Act 1988 s 303(1), Sch 7 para 4(1); and amended by the Trade Marks Act 1994 s 106(1), Sch 4 para 1(1), (2)). Save as so provided, no proceedings lie against the Crown by virtue of the Crown Proceedings Act 1947 in respect of an infringement of a registered trade mark: s 3(1) (as so substituted and amended).

9 It is common to join a number of claimants where there is some doubt as to which owns the relevant goodwill. As to the right of one of several traders entitled to a shared reputation to sue see PARA 311 ante. A trade association does not have locus to sue in a passing off action to protect the goodwill of the businesses of its members, but in some circumstances it may be entitled to sue to protect its own goodwill: see PARA 310 notes 4-5 ante.

10 See eg *A Macaulay (Tweeds) Ltd v Hepworths Ltd* [1961] RPC 184 (where, in an action for passing off concerning the use of label 'Harris Tweed' on goods, a Scottish trade association and Scottish manufacturers were properly joined as defendants).

11 See eg *Grierson, Oldham & Co Ltd v Birmingham Hotel & Restaurant Co Ltd* (1901) 18 RPC 158; *E Cusenier et Fils, Ainé, et Compagnie and George Idle Chapman & Co Ltd v Gaiety Bars & Restaurant Co Ltd* (1902) 19 RPC 357; *Havana Cigar Factories Ltd v Tiffin (1905) Ltd* (1909) 26 RPC 473, CA.

12 See *CBS Songs Ltd v Amstrad Consumer Electronics plc* [1988] AC 1013, [1988] RPC 567, HL; *Unilever plc v Gillette (UK) Ltd* [1989] RPC 583, CA; *Credit Lyonnais Bank Nederland NV v Export Credit Guarantee Department* [1998] 1 Lloyd's Rep 19, [1997] 34 LS Gaz R 29, CA; *MCA Records Inc v Charly Records Ltd* [2001] EWCA Civ 1441, [2002] EMLR 1.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(i) Bringing of Proceedings/418. General provisions as to rights of licensees in case of infringement.

#### **418. General provisions as to rights of licensees in case of infringement.**

On general principles a licensee of a trade mark has no proprietary right in the mark; any right of action in such a licensee is, therefore, merely that conferred by the Trade Marks Act 1994<sup>1</sup>.

The following provisions have effect with respect to the rights of a licensee<sup>2</sup> in relation to infringement<sup>3</sup> of a registered trade mark<sup>4</sup>; but they do not apply where or to the extent that the licensee has a right<sup>5</sup> to bring proceedings in his own name<sup>6</sup>.

A licensee is entitled, unless his licence<sup>7</sup>, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings<sup>8</sup> in respect of any matter which affects his interests<sup>9</sup>. If the proprietor refuses to do so or fails to do so within two months after being called upon, the licensee may bring the proceedings in his own name as if he were the proprietor<sup>10</sup>.

Where infringement proceedings are so brought by a licensee<sup>11</sup>, the licensee may not, without the leave of the court<sup>12</sup>, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant; but this does not affect the granting of interim relief on an application by a licensee alone<sup>13</sup>. A proprietor who is so added as a defendant may not be made liable for any costs in the action unless he takes part in the proceedings<sup>14</sup>.

In infringement proceedings brought by the proprietor of a registered trade mark any loss suffered or likely to be suffered by licensees must be taken into account, and the court may give such directions as it thinks fit as to the extent to which the claimant is to hold the proceeds of any pecuniary remedy on behalf of licensees<sup>15</sup>.

The above provisions apply in relation to an exclusive licensee<sup>16</sup> if or to the extent that he has<sup>17</sup> the rights and remedies of an assignee as if he were the proprietor of the registered trade mark<sup>18</sup>.

1 *Northern & Shell plc v Condé Nast & National Magazine Distributors Ltd and Penthouse Publications Ltd* [1995] RPC 117.

2 For the meaning of 'licensee' see PARA 136 note 7 ante. As to licences see PARAS 136-137 ante.

3 For the meaning of 'infringement' see PARA 84 note 4 ante.

4 As to the meaning of 'registered trade mark' see PARA 127 ante.

5 I.e. by virtue of the Trade Marks Act 1994 s 31(1): see PARA 419 post.

6 *Ibid* s 30(1). Section 30 applies to licences granted before 31 October 1994, but only in relation to infringements committed on or after that date: s 105, Sch 3 para 6(1). For provisions in relation to authorised users of collective marks corresponding to the provisions of s 30 see s 49(2), Sch 1 para 12; and PARA 162 ante. As to authorised users of certification marks see s 50(2), Sch 2 para 14; and PARA 173 ante.

7 For the meaning of 'licence' see PARA 136 note 7 ante.

8 For the meaning of 'infringement proceedings' see PARA 85 note 4 ante.

9 Trade Marks Act 1994 s 30(2). See also note 6 supra.

10 Ibid s 30(3). See also note 6 supra. Section 30(3) is similar to the Trade Marks Act 1938 s 28(3) (repealed), which was held to be a complete code so that the licensee (then called a registered user) had no entitlement to sue apart from that provision: *Levi Strauss & Co v French Connection Ltd* [1982] FSR 443. The same reasoning would lead to the same result under the Trade Marks Act 1994 s 30(3).

11 Ie by virtue of *ibid* s 30.

12 For the meaning of 'the court' see PARA 349 ante.

13 Trade Marks Act 1994 s 30(4). See also note 6 supra. Success on such an application might be prejudiced by the licensee's enforced two months' wait, though probably not if he gave the defendant due warning.

14 Ibid s 30(5). See also note 6 supra.

15 Ibid s 30(6). See also note 6 supra.

16 For the meaning of 'exclusive licensee' see PARA 137 ante.

17 Ie by virtue of the Trade Marks Act 1994 s 31(1): see PARA 419 post.

18 Ibid s 30(7). Thus his licensees have the right to take action and so on. See also note 6 supra.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(i) Bringing of Proceedings/419. Exclusive licensee having rights and remedies of assignee.

#### **419. Exclusive licensee having rights and remedies of assignee.**

An exclusive licence<sup>1</sup> may provide that the licensee<sup>2</sup> is to have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment<sup>3</sup>. Where or to the extent that such provision is made, the licensee is entitled, subject to the provisions of the licence and to the following provisions, to bring infringement proceedings<sup>4</sup>, against any person other than the proprietor<sup>5</sup>, in his own name<sup>6</sup>.

Any such rights and remedies of an exclusive licensee<sup>7</sup> are concurrent with those of the proprietor of the registered trade mark<sup>8</sup>.

In an action so brought by an exclusive licensee a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark<sup>9</sup>.

Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court<sup>10</sup> and subject to any agreement to the contrary between the exclusive licensee and the proprietor, proceed with the action unless the other is either joined as a claimant or added as a defendant; but this does not affect the granting of interim relief on an application by a proprietor or exclusive licensee alone<sup>11</sup>. A person who is so added as a defendant may not be made liable, subject to any agreement to the contrary between the exclusive licensee and the proprietor, for any costs in the action unless he takes part in the proceedings<sup>12</sup>.

Subject to any agreement to the contrary between the exclusive licensee and the proprietor, where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action<sup>13</sup>:

- 544 (1) the court must, in assessing damages, take into account the terms of the licence and any pecuniary remedy already awarded or available to either of them in respect of the infringement<sup>14</sup>;
- 545 (2) no account of profits may be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement<sup>15</sup>; and
- 546 (3) the court must, if an account of profits is directed, apportion the profits between them as the court considers just, subject to any agreement between them<sup>16</sup>.

The proprietor of a registered trade mark must, subject to any agreement to the contrary between the exclusive licensee and the proprietor, notify any exclusive licensee who has a concurrent right of action before applying for an order for delivery up<sup>17</sup>; and the court may on the application of the licensee make such order as it thinks fit having regard to the terms of the licence<sup>18</sup>.

- 1 For the meaning of 'exclusive licence' see PARA 137 ante.
- 2 For the meaning of 'licensee' see PARA 136 note 7 ante.
- 3 Trade Marks Act 1994 s 31(1). As to assignment of registered trade marks see PARA 129 et seq ante.
- 4 For the meaning of 'infringement proceedings' see PARA 85 note 4 ante; and for the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see *ibid* s 10; and PARA 86 et seq ante.
- 5 References to the proprietor of a registered trade mark in the provisions of the Trade Marks Act 1994 relating to infringement are to be construed accordingly: s 31(2). As to the meaning of 'registered trade mark' see PARA 127 ante. An action against the proprietor would have to be for breach of contract. The exclusive licensee would not have any remedies under the Trade Marks Act 1994 against the proprietor.
- 6 *Ibid* s 31(1).
- 7 For the meaning of 'exclusive licensee' see PARA 137 ante.
- 8 Trade Marks Act 1994 s 31(2).
- 9 *Ibid* s 31(3). This would seem to prevent a successful action in trade mark infringement by the exclusive licensee in respect of goods of his licensor made abroad (either by the licensor or his licensee). See *Northern & Shell plc v Condé Nast & National Magazine Distributors Ltd and Penthouse Publications Ltd* [1995] RPC 117; but see more generally the cases relating to parallel imports cited at para 107 ante.
- 10 For the meaning of 'the court' see PARA 349 ante.
- 11 Trade Marks Act 1994 s 31(4), (8).
- 12 *Ibid* s 31(5), (8).
- 13 *Ibid* s 31(6), (8). The provisions of s 31(6) apply whether or not the proprietor and the exclusive licensee are both parties to the action; and, if they are not both parties, the court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other: s 31(6).
- 14 *Ibid* s 31(6)(a), (8). See also note 13 *supra*.
- 15 *Ibid* s 31(6)(b), (8). See also note 13 *supra*.
- 16 *Ibid* s 31(6)(c), (8). See also note 13 *supra*.
- 17 Ie an order under *ibid* s 16: see PARA 461 post.
- 18 *Ibid* s 31(7), (8).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(i) Bringing of Proceedings/420. Claim.

#### **420. Claim.**

In an action for infringement of a registered trade mark<sup>1</sup> the claimant need only assert his registered title<sup>2</sup> and allege the facts constituting infringement. Those facts will depend upon the type of infringement alleged<sup>3</sup>. The mark must actually be registered, or have become protected, at the date of commencement of the action. It is not enough that registration has been applied for but not yet granted, even though it will date back to the date of application if granted<sup>4</sup>.

In a claim for passing off, whether alone or in conjunction with a claim for infringement, the claimant must allege the facts on which the claim to goodwill in the name or the mark is based, and this applies also where he is complaining of confusion likely to be caused by the trading name of some other person<sup>5</sup>. If he alleges fraudulent intent, he must plead it specifically<sup>6</sup>.

Particulars must be given sufficient to identify any individual instances of infringement or passing off as to which the claimant proposes to give evidence at the trial<sup>7</sup>. Where an account or inquiry as to damages is claimed<sup>8</sup>, it is not necessary that more than a few instances should be given. Without alleging individual sales or deception of named persons, the claimant may rely on the similarity of a name or mark as in itself establishing probability of confusion<sup>9</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 ante.

2 *La Radiotechnique v Weinbaum* [1928] Ch 1, 44 RPC 361. As to evidence of registration see PARA 428 post. In the case of a protected international trade mark (UK), the proprietor will rely upon his registration as holder of the mark on the international register, which is prima facie evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it: see PARA 110 ante. However, there is no statutory presumption of the validity of its protected status in the United Kingdom although such a presumption would appear to arise on general principles of the presumption of validity of official acts following the publication by the registrar of particulars stating the date upon which, and the goods or services in respect of which, protection is conferred (see the Trade Marks (International Registration) Order 1996, SI 1996/714, art 12(3) (as substituted); and PARA 389 ante). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante. For the meaning of 'international register' see PARA 12 note 2 ante.

3 See the Trade Marks Act 1994 s 10; and PARA 86 et seq ante.

4 See *ibid* s 9(3) (see PARA 85 ante) and s 40(3) (see PARA 21 ante). Similarly, it is not enough if an international registration designating the United Kingdom has not yet achieved protected status: see PARA 389 ante. For the meaning of 'international registration designating the United Kingdom' see PARA 13 ante.

5 As to the burden of proof in actions for passing off see PARA 307 et seq ante.

6 *Claudius Ash, Son & Co Ltd v Invicta Manufacturing Co Ltd* (1912) 29 RPC 465 at 475, HL; *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79 at 121, CA. The relevant intention must be to deceive, a mere knowledge that the acts concerned will do so not being sufficient. See PARA 330 ante. See also *India Rubber, Gutta Percha and Telegraph Works Ltd v County Golf Co* (1925) 42 RPC 225 (amendment of claim alleging fraud).

7 See the cases cited at para 432 note 1 post.

8 See PARAS 442-444 post.

9 *Reddaway v Bentham Hemp-Spinning Co* [1892] 2 QB 639, 9 RPC 503, CA.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/ (ii) Defences/421. Defences to proceedings for infringement; counterclaims or applications for revocation, invalidity or rectification.

## (ii) Defences

### **421. Defences to proceedings for infringement; counterclaims or applications for revocation, invalidity or rectification.**

Apart from traversing the facts alleged, a defendant in an infringement action may plead that what he is doing does not come within the statutory meaning of 'infringement'<sup>1</sup>, or that he comes within one of the statutory or other exemptions from infringement<sup>2</sup>. He may also deny the claimant's title or allege that the registration is invalid or should be revoked. If so, he may put in issue the validity of the trade mark in his defence or may apply by counterclaim<sup>3</sup> for an order for revocation of the registration or for a declaration of invalidity of the registration or for rectification of the register, or he may do all of those things<sup>4</sup>.

1 See the Trade Marks Act 1994 ss 9, 10 (s 10 as amended); and PARA 84 et seq ante.

2 See PARA 96 et seq ante.

3 Ie under CPR Pt 20: see CIVIL PROCEDURE vol 11 (2009) PARA 618 et seq.

4 CPR 63.15. As to claims for revocation, declaration of invalidity or rectification see PARA 458 post. Although CPR Pt 63 does not expressly provide, these provisions must presumably apply to international trade marks (UK) in the same way as to United Kingdom registered trade marks since the relevant provisions of the Trade Marks Act 1994 (ie s 46 (revocation) and s 47 (declaration of invalidity)) apply generally to protected international trade marks (UK): see PARA 396 note 2 ante.

## **UPDATE**

### **421 Defences to proceedings for infringement; counterclaims or applications for revocation, invalidity or rectification**

TEXT AND NOTES 3, 4--CPR Pt 63 substituted: SI 2009/2092.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/ (ii) Defences/422. Defences in actions for passing off.

#### **422. Defences in actions for passing off.**

A defendant in an action for passing off may deny the claimant's claim that the name or get-up is distinctive of the claimant's goods or services<sup>1</sup>, or he may allege fraud<sup>2</sup> or acquiescence or a licence disentitling the claimant to succeed<sup>3</sup>. He may also plead that there was no real and tangible danger of deception arising by the use of the mark or indicium complained of<sup>4</sup>. The defendant may allege that he has an independent or concurrent right to use the mark, name or get-up<sup>5</sup>. Where the defendant merely traverses the claimant's allegation that a name or mark is distinctive of the claimant's goods, the defendant will not be ordered to serve particulars of use of the name or mark by others<sup>6</sup>.

1 Cf paras 317 et seq, 338 et seq ante.

2 See PARA 330 ante.

3 See PARA 316 ante.

4 See PARA 326 et seq ante.

5 See PARA 346 ante.

6 *La Radiotechnique v Weinbaum* [1928] Ch 1, 44 RPC 361. If, however, the defendant pleads affirmatively that the name or mark has been in common use, particulars identifying any prior user may be ordered to be given: *Aquascutum Ltd v Moore and Scantlebury* (1903) 20 RPC 640; *Schweppes Ltd v Gibbens* (1905) 22 RPC 113, CA.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/ (ii) Defences/423. Stay pending application for registration by defendant.

#### **423. Stay pending application for registration by defendant.**

It is a defence to an action for infringement of a registered trade mark or of a protected international trade mark (UK) that the defendant is himself using a validly registered mark<sup>1</sup>. Occasions arise when a defendant is sued in respect of the use of a mark which is itself the subject of an application by the defendant to register. As registration, if effected, will date back to the date of the application<sup>2</sup>, the success of that application would provide a complete defence to the action. Accordingly, it is possible for a defendant, in such circumstances, to apply for a stay of the action against him<sup>3</sup> or even a stay of a final injunction<sup>4</sup>. A defendant who is the holder of an international registration for which protection has been requested in the United Kingdom may similarly apply for a stay until the procedure leading to the mark becoming protected has been completed<sup>5</sup>. A stay will be granted only where the interests of justice (taking into account the claims of both parties) so require<sup>6</sup>. It will be relevant if the action and defendant's application before the registrar raise essentially the same issues. Where this is so, a stay of the action will not normally be granted because as a general rule a claimant has a right of choice of tribunal<sup>7</sup>.

1 See the Trade Marks Act 1994 s 11(1); and PARA 92 ante. As to the meaning of 'registered trade mark' see PARA 127 ante; and as to protected international trade marks (UK) see PARA 13 ante.

2 See *ibid* s 40(3); and PARA 21 ante.

3 See eg *JU James & Sons Ltd v Wafer Razor Co Ltd* (1932) 49 RPC 597, CA. As to stay of proceedings generally see CIVIL PROCEDURE vol 11 (2009) PARA 529 et seq.

4 See *Electrolux Ltd v Electrix Ltd* (1953) 70 RPC 127; on appeal (1954) 71 RPC 23, CA (stay of an injunction granted because of the defendant's long concurrent use). However, the application to register ultimately failed: see *Electrix Ltd v Electrolux Ltd* [1960] AC 722, [1959] 3 All ER 170, [1959] RPC 283, HL.

5 Once the mark becomes protected, its effect will date back to the date of the international registration: see PARA 21 ante.

6 See *Berlei (UK) Ltd v Bali Brassiere Co Inc* [1970] RPC 469 (stay refused). The final injunction permitted the defendants to continue their application for concurrent registration: see [1972] RPC 568. See also *JU James & Sons Ltd v Wafer Razor Co Ltd* (1932) 49 RPC 597, CA; *Flowerdale Ltd v Hale Electric Co Ltd* (1949) 66 RPC 333, CA (stay refused because the infringement action raised essentially the same issues as the registry proceedings, which were themselves stayed (see (1949) 66 RPC 86)); *Agfa AG v Ilford Ltd* [1960] RPC 108 (stay refused); *Second Sight Ltd v Novell UK Ltd* [1995] RPC 423 (stay granted).

7 *Flowerdale Ltd v Hale Electric Co Ltd* (1949) 66 RPC 333, CA; *Ravenhead Brick Co Ltd v Ruabon Brick and Terra Cotta Co Ltd* (1937) 54 RPC 341; *Colibri Lighters Ltd v Markt & Co (London) Ltd* [1959] RPC 8.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/ (ii) Defences/424. Stay of proceedings by way of settlement.

**424. Stay of proceedings by way of settlement.**

In accordance with general principles it is possible for an action to be compromised on agreed terms, the action being stayed except for the purposes of enforcing the agreed terms<sup>1</sup>. Where an undertaking to inform the registrar of any proposed order has been given<sup>2</sup>, he should be informed of the proposed order. Such an order, if not observed, can be enforced by the grant of an injunction and an inquiry as to damages<sup>3</sup>. Settlements in passing off and trade mark cases often contain undertakings to the court (as to non-use of a mark complained of) in addition to such agreed terms.

1     le by a so-called 'Tomlin' order: see CIVIL PROCEDURE vol 12 (2009) PARA 1141.

2     See PARA 410 ante.

3     *Hyatt Roller Bearing Co and Delco Remy and Hyatt Ltd v Frederick Pollard & Co (Bearings) Ltd* (1934) 52 RPC 115.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/ (ii) Defences/425. Discontinuance.

#### **425. Discontinuance.**

The discontinuance of an action for infringement of a trade mark or for passing off is governed by the ordinary rules<sup>1</sup>. Normally the court will require the claimant to undertake not to bring any future action in respect of any such act as was alleged in the action concerned to be wrongful, whenever that act was committed<sup>2</sup>.

1 See CPR Pt 38; and CIVIL PROCEDURE vol 11 (2009) PARA 723 et seq.

2 See *American International Group Inc v London American International Corp'n Ltd* [1982] FSR 441.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/ (ii) Defences/426. Effect of beginning proceedings on right to give warning against infringement while proceedings are pending.

**426. Effect of beginning proceedings on right to give warning against infringement while proceedings are pending.**

When proceedings relating to the validity of a registered trade mark, or proceedings against the proprietor of the mark for passing off, are pending, the sending by or on behalf of the proprietor of a warning letter to a trade journal or to a member of the trade against the consequences of infringing the mark does not in itself amount to contempt of court, even though no mention is made of the pending proceedings, unless the letter is likely to harm the other party to the proceedings in the preparation and presentation of his case by tending to discourage people from giving evidence on his behalf<sup>1</sup>.

Apart from any question of contempt when there are pending proceedings, the proprietor of a trade mark must be careful not to expose himself to proceedings in respect of groundless threats of trade mark proceedings<sup>2</sup>.

<sup>1</sup> *Carl-Zeiss-Stiftung v Rayner & Keeler Ltd, Re Trade Mark No 249,457* [1960] 3 All ER 289, [1960] 1 WLR 1145, [1961] RPC 1. See also *Thorley's Cattle Food Co v Massam* (1880) 14 ChD 763, CA; cf *J and P Coats v Chadwick* [1894] 1 Ch 347 (where a circular issued to the trade while an action for infringement was pending did not amount to a mere warning but libelled the defendants, and was calculated to create bias in the minds of recipients and to deter them from coming forward as witnesses for the defendants). Cf PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 526. It has been said in relation to advertisements of proceedings concerning the infringement of patents that the claimant must not state that his success is certain or that the defendant has infringed: see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 526. Cf *Carl-Zeiss-Stiftung v Rayner & Keeler Ltd, Re Trade Mark No 249,457* supra at 294, 301, at 1153, 1162, and at 9, 16 (criticising a dictum in *Goulard and Gibbs v Lindsay & Co Ltd and Ferranti* (1887) 4 RPC 189 at 190; and commenting on *Mullard Radio Valve Co Ltd v Rothermel Corpn Ltd* (1933) 51 RPC 1). As to contempt of court by comment on pending proceedings generally see CONTEMPT OF COURT vol 9(1) (Reissue) PARA 409 et seq.

<sup>2</sup> See the Trade Marks Act 1994 s 21; and PARAS 123-125 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iii) Disclosure/427. Disclosure.

### (iii) Disclosure

#### 427. Disclosure.

The normal rules as to disclosure apply to actions for infringement and for passing off<sup>1</sup>. It is normal for the claimant to seek an inquiry as to damages or an account of profits, and therefore disclosure in these actions before trial has usually been limited to those matters relevant to the issue of liability, as distinct from matters relevant to quantum<sup>2</sup>. The latter arise only if the claimant succeeds; the courts have been reluctant to compel the defendant to disclose, for example, the names of his customers to a trade rival until the claimant's rights have been established<sup>3</sup>. Once liability has been established, however, the claimant is entitled to certain disclosure to enable him to elect between an inquiry as to damages and an account of profits<sup>4</sup>. For the purposes of an account of profits or an inquiry as to damages all necessary disclosure must be given<sup>5</sup>.

The normal rules as to privilege apply in relation to these classes of action. In addition, communications as to any matter relating to the protection of any design or trade mark, or as to any matter involving passing off, with trade mark agents and patent agents, attracts legal professional privilege in the same way as communications with a solicitor<sup>6</sup>.

1 See CPR Pt 31; and CIVIL PROCEDURE vol 11 (2009) PARA 538 et seq. In an appropriate case disclosure may be obtained from a non-party: see CPR 31.17; and *American Home Products Corp v Novartis Pharmaceuticals UK Ltd (No 2)* [2001] EWCA Civ 165, [2001] FSR 41, [2001] IP & T 752.

2 See *Baldock v Addison* [1995] 3 All ER 437, [1995] 1 WLR 158.

3 *Carver v Pinto Leite* (1871) 7 Ch App 90; *Fennessy v Clark* (1887) 37 ChD 184, CA; *Re Wills' Trade Marks* [1892] 3 Ch 201, 9 RPC 346, CA. Cf *Howe v M'Kernan* (1862) 30 Beav 547; *Aubanel and Alabaster Ltd v Aubanel* (1950) 67 RPC 222, CA. As to the position where actual deception is alleged see PARA 432 note 1 post.

4 *Island Records Ltd v Tring International plc* [1995] 3 All ER 444, [1996] 1 WLR 1256; *Brugger v Medicaid* [1996] FSR 362.

5 See *Leather Cloth Co Ltd v Hirschfeld* (1863) 1 Hem & M 295; *Powell v Birmingham Vinegar Brewery Co Ltd* (1896) 14 RPC 1, CA (names and addresses of customers); *Manus Akt v Rj Fullwood and Bland Ltd* [1949] Ch 208, [1949] 1 All ER 205, 66 RPC 71, CA. Cf PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 535.

6 See the Trade Marks Act 1994 s 87 (trade mark agents: see PARA 34 ante); and the Copyright, Designs and Patents Act 1988 s 280 (as amended) (patent agents: see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 618).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/428. Evidence of registration.

## **(iv) Evidence**

### **428. Evidence of registration.**

In all legal proceedings relating to a registered trade mark<sup>1</sup>, including proceedings for rectification of the register<sup>2</sup>, the registration of a person as proprietor of a trade mark is prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it<sup>3</sup>. Similar provisions apply in relation to protected international trade marks (UK)<sup>4</sup>.

Entries in the register are provable by the original certificate of registration<sup>5</sup> or by a certified copy of the entry<sup>6</sup>. Judicial notice must be taken of copies issued by the International Bureau of entries in the international register and copies of the gazette published by the International Bureau, and they are admissible as evidence of any instrument or other act thereby communicated of the International Bureau<sup>7</sup>.

A statement in writing submitted to the court by the registrar, when he is not directed by the court to appear, is deemed to form part of the evidence in proceedings for revocation, declaration of invalidity or rectification<sup>8</sup>.

1 As to the meaning of 'registered trade mark' see PARA 127 ante.

2 As to proceedings for rectification of the register see PARA 396 et seq ante. As to the register see PARA 19 ante.

3 See the Trade Marks Act 1994 s 72; and PARA 110 ante.

4 See PARA 110 ante.

5 I.e. the certificate issued under the Trade Marks Act 1994 s 40(2): see PARA 388 ante. The certificate of registration is the legal and proper proof of registration: *Re William Crawford & Sons' Application* (1917) 34 RPC 97.

6 As to the supply of certified copies of entries in the register see PARA 24 ante. Whenever legal proceedings concerning a registered trade mark arise, such a certified copy should be requested. Often, especially at the interim relief stage, evidence of registration is given by producing a photocopy of the advertisement of the mark concerned in the relevant Trade Marks Journal together with evidence as to the state of the register revealed by an inspection. As to the International Bureau see PARAS 8 note 11, 12 note 5 ante.

7 Trade Marks (International Registration) Order 1996, SI 1996/714, art 27(2), (3).

8 See the Trade Marks Act 1994 s 74(2); and PARA 460 post.

## **UPDATE**

### **428 Evidence of registration**

NOTE 7--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/429. Evidence as to other registrations.

**429. Evidence as to other registrations.**

Evidence as to other trade marks that have been registered is in principle irrelevant when considering whether a particular mark satisfies the requirements for registration<sup>1</sup>. The same applies when considering whether the use of one mark infringes another<sup>2</sup>. If the marks have been used concurrently, however, evidence of this is relevant and admissible<sup>3</sup>.

1 *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305 per Jacob J. As to the requirements for registration see PARA 55 et seq ante.

2 *Neutrogena Corp v Golden Ltd* [1996] RPC 473 at 502-503, CA, per Jacob J (a case under the Trade Marks Act 1938 s 30 (repealed)).

3 See PARA 432 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/430. Evidence as to trade usage etc.

#### **430. Evidence as to trade usage etc.**

In any action relating to a trade mark or trade name under the provisions of the Trade Marks Act 1938, evidence had to be admitted as to the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons<sup>1</sup>. Notwithstanding the repeal of that provision by, and its not being re-enacted in, the Trade Marks Act 1994, it is clear that such evidence is admissible on general principles; it is relevant probative matter<sup>2</sup>.

<sup>1</sup> See the Trade Marks Act 1938 s 49 (repealed).

<sup>2</sup> Thus such evidence has routinely been admitted in passing off actions for many years. Cf *Mitchell v Henry* (1880) 15 ChD 181, CA. References to trade papers are admissible for this purpose: see *Singer Manufacturing Co v Loog* (1882) 8 App Cas 15 at 24, HL; *Daimler Motor Car Co Ltd v British Motor Traction Co Ltd* (1901) 18 RPC 465. Interrogatories might be served on this point: *Perry & Co Ltd v Hessin & Co* (1910) 28 RPC 108. Interrogatories have now been replaced by requests for further information: see CPR Pt 18.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/431. Similarity a question of fact for the court; admissibility of evidence.

#### **431. Similarity a question of fact for the court; admissibility of evidence.**

It is for the court or other tribunal concerned to decide whether the similarity of the mark, name or get-up complained of to that registered or employed by the claimant is such as (in combination with the similarity of goods or services) to give rise to a likelihood of confusion or to be calculated to deceive (depending on the nature of the proceedings). The tribunal is entitled to make a decision based on its own experience even in the absence of evidence<sup>1</sup>. It is not proper for witnesses to be asked whether in their opinion confusion or deception is likely<sup>2</sup>. Witnesses may, however, be properly called to show the custom of the trade as to the use of names or matters of get-up<sup>3</sup>, the circumstances in which the articles are sold<sup>4</sup> and the method in which the claimant's name etc is used<sup>5</sup>, and any other matters necessary to instruct the court and enable it to arrive at a decision on this point<sup>6</sup>, and the court should decide in view of this evidence and not merely on an inspection of the objects<sup>7</sup>. The court may refer to dictionaries as to the meaning of a word and the use to which it is put<sup>8</sup>. A witness may be asked if he himself would be deceived; an expert witness may legitimately give evidence that, according to his experience of the conduct of the business concerned, traders or customers will adopt certain practices<sup>9</sup>.

What degree of similarity is likely to deceive or cause confusion in any instance is incapable of definition a priori<sup>10</sup>; and the observations of judges upon other and quite different facts are usually of little help<sup>11</sup>.

1 *North Cheshire and Manchester Brewery Co Ltd v Manchester Brewery Co Ltd* [1899] AC 83, HL; *Tokalon Ltd v Davidson & Co* (1914) 31 RPC 74, Ct of Sess (affd 32 RPC 133, CA); *AG Spalding & Bros v AW Gamage Ltd and Benetfink & Co Ltd* (1915) 32 RPC 273, HL; *Tavener Rutledge Ltd v Specters Ltd* [1959] RPC 355, CA; *Neutrogena Corp v Golden Ltd* [1996] RPC 473, CA; *Premier Luggage and Bags Ltd v Premier Co (UK) Ltd* [2002] EWCA Civ 387, [2003] FSR 796.

2 *Mothercare UK Ltd v Penguin Books Ltd* [1988] RPC 113 at 116, CA; *Island Trading Co v Anchor Brewing Co* [1989] RPC 287; *Payton & Co Ltd v Snelling, Lampard & Co Ltd* [1901] AC 308 at 312, 17 RPC 628 at 635, HL; *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 286, 290, HL. See also *North Cheshire and Manchester Brewery Co Ltd v Manchester Brewery Co Ltd* [1899] AC 83 at 85, HL; *Claudius Ash, Son & Co Ltd v Invicta Manufacturing Co Ltd* (1912) 29 RPC 465 at 476, HL; *Re Spiller Ltd's Application* (1952) 69 RPC 327 (on appeal) (1953) 70 RPC 51, CA; affd (1954) 71 RPC 234, HL; *Harker Stagg Ltd's Trade Mark* (1954) 71 RPC 136 at 140, CA; *Tavener Rutledge Ltd v Specters Ltd* [1959] RPC 355 at 360-361, CA. See also note 9 infra.

3 See eg *George Ballantine & Son Ltd v Ballantyne Stewart & Co Ltd* [1959] RPC 273 at 279-280, CA (tendency to abbreviate composite name).

4 These circumstances include the class of purchasers (*R Johnston & Co v Archibald Orr Ewing & Co* (1882) 7 App Cas 219, HL; *Wilkinson v Griffith* (1891) 8 RPC 370), their likely reactions and behaviour (*Guccio Gucci SpA v Paolo Gucci* [1991] FSR 89), the manner in which articles are asked for (*Imperial Tobacco Co (of Great Britain and Ireland) Ltd v Purnell & Co* (1904) 21 RPC 598, CA; *Havana Cigar and Tobacco Factories Ltd v Oddenino* (1923) 40 RPC 229 at 241; *John Jaques & Sons Ltd v Chess* [1940] 2 All ER 285, 57 RPC 77, CA; *GB Delavelle Ltd v Stanley* (1946) 63 RPC 103 at 109; *Sales Affiliates Ltd v Le Jean Ltd* [1947] Ch 295 at 301-302, [1947] 1 All ER 287 at 290-291, 64 RPC 103 at 110), and the features to which customers attach importance (*Perry & Co Ltd v T Hessin & Co* (1912) 29 RPC 509 at 533, CA; *Dunhill v Bartlett and Bickley* (1922) 39 RPC 426). See generally *BACH and BACH FLOWER REMEDIES TRADE MARKS* [2000] RPC 513, sub nom *Bach Flower Remedies Ltd v Healing Herbs Ltd* [1999] IP & T 146, CA.

5 *Daimler Motor Car Co Ltd v British Motor Traction Co Ltd* (1901) 18 RPC 465; *Standard Bank of South Africa Ltd v Standard Bank Ltd* (1909) 26 RPC 310.

6 As to evidence generally in passing off cases see *North Cheshire and Manchester Brewery Co Ltd v Manchester Brewery Co Ltd* [1899] AC 83, HL. In *Wilkinson v Griffith* (1891) 8 RPC 370 at 372, the court admitted evidence of increase in the defendant's sales after the adoption of the label complained of as showing that this had caused the goods to be bought as the plaintiff's goods.

7 See eg *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341 at 397, HL ('Jif Lemon'). See also *London General Omnibus Co Ltd v Lavell* [1901] 1 Ch 135 at 138, 18 RPC 74 at 79, CA.

8 *Textron Inc and Textron Ltd v Henry C Stevens Ltd and Blick Office Equipment Ltd* [1977] RPC 283 (where the court had regard to a letter from the publishers of the Oxford English Dictionary as to the meaning of a word not yet in the dictionary); *Hormel Foods Corp v Antilles Landscape Investments NV* [2005] EWHC 13 (Ch), [2005] RPC 657, [2005] IP & T 822; *Re Elliott Optical Co Ltd's Application* (1952) 69 RPC 169 at 173 (a decision of the registrar to the effect that statements in year books as to a word being a trade mark are not admissible) would probably no longer be followed, now that hearsay evidence is admissible.

9 *Claudius Ash, Son & Co Ltd v Invicta Manufacturing Co Ltd* (1912) 29 RPC 465, HL; *Royal Warrant Holders' Association v Edward Deane and Beal Ltd* [1912] 1 Ch 10, 28 RPC 721; *Perry & Co Ltd v T Hessin & Co* (1912) 29 RPC 509, CA; *Harrods Ltd v R Harrod Ltd* (1923) 41 RPC 74, CA; *George Ballantine & Son Ltd v Ballantyne, Stewart & Co Ltd* [1959] RPC 273 at 280, CA. It has been suggested (on motion) that trade witnesses could give evidence of direct opinion as to the probability of deception (*Sodastream Ltd v Thorn Cascade Co Ltd* [1982] Com LR 64, [1982] RPC 459, CA); and that in an area which requires specialised knowledge it was admissible for trade witnesses to give evidence as to whether their customers would be confused (*Guccio Gucci SpA v Paolo Gucci* [1991] FSR 89). See also *Taittinger SA v Allbev Ltd* [1994] 4 All ER 75, [1993] 2 CMLR 741, [1993] FSR 641, CA; *NAD Electronics Inc v NAD Computer Systems Ltd* [1997] FSR 380; *Antec International Ltd v South-Western Chicks (Warren) Ltd* [1998] FSR 738, [1998] 18 LS Gaz R 32; *Premier Brands Ltd v Typhoon Europe Ltd* [2000] FSR 767, [2000] IP & T 218. However it has also been held that such experts are not experts as to the likelihood of confusion: *The European Ltd v The Economist Newspaper Ltd* [1998] FSR 283, [1998] ETMR 307, CA.

10 *Seixo v Provezende* (1866) 1 Ch App 192 at 196 per Lord Cranworth, cited in *Re Rysta Ltd's Application, Re Aristoc Ltd's Opposition* [1943] 1 All ER 400 at 406, 60 RPC 87 at 108, CA, per Luxmoore LJ.

11 *R Johnston & Co v Archibald Orr Ewing & Co* (1882) 7 App Cas 219 at 219-220, HL, per Lord Watson. Citing previous decisions on a question of fact is neither a useful nor a proper exercise: *Mölnlycke AB v Procter & Gamble Co (No 5)* [1994] RPC 49 at 114, CA; *Oska's Ltd's Trade Mark Application* [2005] RPC 525, Appointed Person. Accordingly, many decided cases involving comparison of two or more marks have not been cited in this title.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/432. Evidence of actual deception.

#### **432. Evidence of actual deception.**

Evidence may be given as to cases of actual deception, where persons have traded with the defendant under the impression that they were trading with the claimants, or have bought the infringing goods under the impression that they were the goods of the claimants<sup>1</sup>. If such instances relate to direct dealing with the defendants or their agents, they may constitute part of the cause of action, but, even if they do not, they are still available as evidence to show that the similarity is such as is likely to deceive<sup>2</sup>. The absence of actual deception may also be relevant, depending upon the extent and nature of the use of the parties' respective marks<sup>3</sup>.

Evidence may also be given of persons having asked for goods by the claimant's trade name and having been given the wrong goods, whether in fact such persons were deceived or not<sup>4</sup>. The court attaches importance to evidence that both marks have actually been in use for a long time, or that goods bearing the marks have been sold through the same outlets to the public, without any instances of confusion having arisen<sup>5</sup>. Such absence of confusion may, however, be capable of explanation<sup>6</sup>.

1 Note that evidence of actual confusion does not necessarily show that anyone has been deceived by a misrepresentation as is required for a case in passing off: *Premier Luggage and Bags Ltd v Premier Co (UK) Ltd* [2002] EWCA Civ 387, [2003] FSR 796. Where actual deception is alleged, the names and addresses of the persons deceived have been ordered to be disclosed: *Humphries & Co v Taylor Drug Co* (1888) 39 ChD 693, 5 RPC 687; cf *Duke & Sons v Wisden & Co* (1897) 77 LT 67, CA. In practice, now that witness statements of evidence in chief are supplied in advance of trial, this may no longer be necessary. Where the defendant seeks to show that the wrong goods were given inadvertently in these cases, other instances may be proved by the claimant to rebut this defence: *Parozone Co Ltd v Johnston Gibson* (1904) 21 RPC 317, Ct of Sess.

2 *John Brinsmead & Sons Ltd v Brinsmead* (1913) 30 RPC 137 at 146. Where the defendants pleaded that, if any salesman of theirs had made such representations as were alleged by the plaintiffs, he had acted contrary to the defendants' express instructions, particulars were ordered to be given of the instructions: *Boston Marine Patents Co Ltd v Wheeler and Thomson* (1954) 71 RPC 432.

3 Compare *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79, CA, with *Portakabin Ltd v Powerblast Ltd* [1990] RPC 471. If absence of confusion is to be relied upon, it must first be shown that there has been an opportunity for confusion to occur: *Phones4U Ltd v Phone4u.co.uk Ltd* [2006] EWCA Civ 244, [2007] RPC 83.

4 See PARA 433 note 2 post.

5 *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père et Fils* [1978] RPC 79, CA. See also *Re White Rose Application* (1885) 30 ChD 505; *Re Lambert's Trade Mark* (1889) 6 RPC 344, CA; *Re Talbot's Trade Mark* (1894) 11 RPC 77 at 81; *Re Holbrook's Ltd's Application* (1909) 26 RPC 791; *Re Carborundum Co's Application* (1909) 26 RPC 504; *Kidax (Shirts) Ltd's Applications* [1959] RPC 295 at 308 (approved on appeal [1960] RPC 117, CA); *Re Helena Rubenstein Ltd's Application* [1960] RPC 229.

6 *Berlei (UK) Ltd v Bali Brassiere Co Inc* [1969] 2 All ER 812, [1969] 1 WLR 1306, [1969] RPC 472, HL. See also *Schweppes Ltd v Gibbens* (1905) 22 RPC 113, CA (on appeal 22 RPC 601, HL); *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 286, HL; *Electrolux Ltd v Electrix Ltd* (1953) 70 RPC 127 at 132 (on appeal (1954) 71 RPC 23, CA).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/433. Trap orders.

### 433. Trap orders.

The claimant may rely on 'trap orders', or orders given for the claimant's goods by persons sent for that purpose<sup>1</sup> to shops where it is expected that in response to an order for the claimant's goods the infringing goods will be supplied. Although recognising the necessity for this class of evidence, the court scrutinises very closely all the circumstances surrounding the trap orders and insists that the evidence show that the order was given in a perfectly clear manner, so that the defendant or his employees fully realised what was being asked for<sup>2</sup>. Unless the defendants have been informed promptly that the claimants propose to rely on particular sales after they have occurred, they may be unfairly handicapped, as a shop assistant cannot be expected to remember the details of every sale effected<sup>3</sup>. It is not sufficient to send a trap order to a person who is known to stock only an alleged infringing article, in a form which implies that the goods required are stocked, nor will deception necessarily be inferred from the fact of supplying the infringing article in response to orders for the claimant's goods if this is negated by the get-up of the goods<sup>4</sup>.

1 It is permissible for such a person to be a solicitor even if he conceals his qualification, and whether or not he may offend against the rules of professional conduct is irrelevant: *Marie Claire Album SA v Hartstone Hosiery Ltd* [1993] FSR 692.

2 *Stillitz v Jones and Higgins Ltd* (1942) 60 RPC 15 at 17. Where possible, it is preferable that the orders should be in writing: *Cart & Sons v Crisp & Co Ltd* (1902) 19 RPC 497 at 500; *Smith's Potato Crisps Ltd v Paige's Potato Crisps Ltd* (1928) 45 RPC 132, CA; *Cellular Clothing Co Ltd v G White & Co Ltd* (1952) 70 RPC 9. Evidence based on trap orders was treated as unsatisfactory in *Natural Chemicals Ltd and Veno's Drug Co Ltd and Irving's Yeast-Vite Ltd (Consolidated) v Amblins (Chemists) Ltd* (1940) 57 RPC 323; *Cellular Clothing Co Ltd v G White & Co Ltd* supra; but such evidence was accepted in *Showerings Ltd v Cheltenham and Hereford Breweries Ltd* [1958] RPC 446; *Thomas French & Sons Ltd v John Rhind & Sons Ltd* [1958] RPC 82; *Showerings Ltd v Blackpool Tower Co Ltd* [1975] FSR 40.

3 *Ripley v Griffiths* (1902) 19 RPC 590 at 597; *HP Truefitt Ltd and Truefitt v Edney* (1903) 20 RPC 321; *Re Burroughs, Wellcome & Co's Trade Marks, Wellcome v Thompson and Capper* (1904) as reported in 21 RPC 69 at 84; *Lever Bros Ltd v Masbro' Equitable Pioneer Society Ltd* (1912) 29 RPC 225 at 235, CA; *Cellular Clothing Co Ltd v G White & Co Ltd* (1952) 70 RPC 9. See also *John Knight & Sons Ltd v Crisp & Co Ltd* (1904) 21 RPC 670 at 673; *CC Wakefield & Co Ltd v Board* (1928) 45 RPC 261; *Broads v Cast Iron Drainage* [1970] FSR 363.

4 *Re Registered Trade Marks, Fitchetts Ltd v Loubet & Co Ltd* (1919) 36 RPC 296 at 304; cf *Showerings Ltd v Blackpool Tower Co Ltd* [1975] FSR 40.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/434. Survey evidence.

#### 434. Survey evidence.

Attempts have been made in a number of cases to ascertain the opinions of members of the public by means of market research techniques involving a survey. The polls have varied in degree of sophistication<sup>1</sup>. In general, these surveys have had little effect on the case concerned<sup>2</sup>, and the courts have generally accepted them as corroborative evidence only. Where they have been successful, a number of persons polled have given direct evidence<sup>3</sup>.

There are two distinct problems associated with such surveys. First, it is a difficult task to frame questions which are totally fair and not open to criticism<sup>4</sup>. The mere fact of asking a question may often have an effect invalidating the result<sup>5</sup>. Secondly, there is the problem of getting the evidence properly before the court. It is clear that full information as to the whole survey must be given, including details as to how the respondents were chosen, as otherwise the survey will be rejected as valueless. Such information can be provided by giving evidence as to how the survey was conducted and making available to the opposite party all the answers received<sup>6</sup>.

It has been held that a properly conducted poll does not constitute hearsay evidence because it is evidence of an external fact, namely public opinion<sup>7</sup>. Differing views have been expressed as to whether the evidence of market researchers reporting the results of surveys constitutes expert evidence<sup>8</sup>.

1 For an example of an inexact poll see *Treasure Cot Co Ltd v Hamleys Bros Ltd* (1950) 67 RPC 89 at 93. More statistically valid surveys were carried out in *Coca-Cola Co v William Struthers & Sons Ltd* [1968] RPC 231, Ct of Sess; *GE Trade Mark* [1969] RPC 418 at 446 per Graham J (on appeal [1970] RPC 339, CA; revsd [1973] RPC 297 at 321, HL); *Customglass Boats Ltd v Salthouse Bros Ltd* [1976] RPC 589 (NZ); *Tetrosyl Ltd v Silver Paint and Lacquer Co Ltd* [1980] FSR 68, CA; *Lego System A/S v Lego M Lemelstrich Ltd* [1983] FSR 155.

2 *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341 at 397, HL ('Jif Lemon'), is a notable exception. For a summary of the surveys see *Reckitt & Colman Products Ltd v Borden Inc* supra at 350 per Walton J. Even in that case there was, however, one 'experiment' which was not really a survey at all: the reactions of members of the public were tested in supermarkets after they had put the defendants' 'lemon' in their shopping baskets with a genuine view to purchase.

3 Eg *McDonald's Hamburgers Ltd v Burgerking (UK) Ltd* [1986] FSR 45; *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873, [1990] 1 WLR 491, [1990] RPC 341, HL ('Jif Lemon'); *Neutrogena Corp v Golden Ltd* [1996] RPC 473, CA. In recent years surveys have increasingly been used as a means to obtain witnesses rather than as evidence in their own right. The courts have placed limits on the number of such witnesses that can be called: see *BACH and BACH FLOWER REMEDIES TRADE MARKS* [2000] RPC 513, sub nom *Bach Flower Remedies Ltd v Healing Herbs Ltd* [1999] IP & T 146, CA.

4 *Scott Ltd v Nice-Pak Products Ltd* [1989] FSR 100, CA. See also the cases cited in note 1 supra; and *Re Hack's Application* (1940) 58 RPC 91 at 110; *United Biscuits (UK) Ltd v Burtons Biscuits Ltd* [1992] FSR 14 (another case where a poll was held to be of no value); *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501, [1984] FSR 175 (revsd [1984] RPC 501 at 525, CA). Nor is it acceptable to conduct a survey which excludes a relevant class of persons: *Dualit Ltd's (Toaster Shapes) Trade Mark Applications* [1999] RPC 890.

5 *Imperial Group plc v Phillip Morris Ltd* [1984] RPC 293 at 303; *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049.

6 *A Baily & Co Ltd v Clark, Son and Morland* [1938] AC 557, [1938] 2 All ER 377, 55 RPC 253, HL.

7 See *Lego System A/S v Lego M Lemelstrich Ltd* [1983] FSR 155. Whether this view would be universally accepted remains to be seen. If the view is correct, then it means that there is no opportunity of testing that opinion by cross-examination, a result which seems hardly consistent with normal principles of litigation.

8     *Reckitt & Colman Products Ltd v Borden Inc (No 2)* [1987] FSR 407 (which held that it did not); *O2 Holdings Ltd and O2 (UK) Ltd v Hutchinson 3G Ltd (No 2)* [2006] EWHC 601 (Ch), [2006] RPC 766, [2006] ETMR 55 (which held that it did).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(iv) Evidence/435. Evaluation of likelihood of confusion on appeal.

**435. Evaluation of likelihood of confusion on appeal.**

An appellate court will be reluctant to interfere with the first instance tribunal's evaluation of the likelihood of confusion in the absence of an error of principle<sup>1</sup>.

<sup>1</sup> *South Cone Inc v Bessant (t/a Reef)* [2002] EWCA Civ 763, sub nom *REEF Trade Mark* [2003] RPC 101; *El Du Pont De Nemours & Co v ST Dupont* [2003] EWCA Civ 1368, [2006] 1 WLR 2793, sub nom *DU PONT Trade Mark* [2004] FSR 293.

**UPDATE**

**435 Evaluation of likelihood of confusion on appeal**

NOTE 1--See *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] All ER (D) 166 (Mar).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/A. IN GENERAL/436. Types of relief available.

## **(v) Relief**

### **A. IN GENERAL**

#### **436. Types of relief available.**

Following judgment at trial for a claimant in an action for infringement of a registered trade mark or a protected international trade mark (UK)<sup>1</sup>, or for passing off<sup>2</sup>, the types of relief available are those generally available in respect of the infringement of a property right<sup>3</sup>. These include a permanent injunction<sup>4</sup>, a declaration<sup>5</sup>, an inquiry as to damages<sup>6</sup> or an account of profits<sup>7</sup>, an order for delivery up, erasure or destruction<sup>8</sup>, a certificate of contested validity of a registered trade mark<sup>9</sup>, and costs<sup>10</sup>. In relation to registered trade marks the statutory remedies of erasure<sup>11</sup> and delivery up<sup>12</sup> are also available. In addition the court may order appropriate measures for the dissemination and publication of the judgment to be taken at the defendant's expense<sup>13</sup>.

Following judgment at trial for a claimant in an action for infringement of a Community trade mark<sup>14</sup>, the court must, unless there are special reasons for not doing so, grant a permanent injunction<sup>15</sup>; otherwise it must give the same relief as for infringement of a registered trade mark<sup>16</sup>.

Interim remedies are of particular importance in infringement and passing off cases<sup>17</sup>. These remedies include interim injunctions<sup>18</sup>, search orders<sup>19</sup>, orders for immediate disclosure<sup>20</sup>, freezing injunctions<sup>21</sup> and, on occasions, certain orders under the protective jurisdiction of equity against non-infringers (for example, disclosure of names of infringers and interim preservation)<sup>22</sup>. Summary judgment<sup>23</sup> is also available in suitable cases<sup>24</sup>. Applications for interim relief should be considered in all cases, as a successful application almost always results in an early termination of the infringement and also a considerable saving in time and costs.

1 As to actions for infringement see PARA 84 et seq ante. As to the meaning of 'registered trade mark' see PARA 127 ante. As to protected international trade marks (UK) see PARA 13 ante.

2 As to passing off see PARA 304 et seq ante.

3 This is explicit in relation to registered trade marks (see the Trade Marks Act 1994 s 14(2); and PARA 416 ante); but in relation to passing off it follows under the general law.

4 See PARAS 437-440 post.

5 See PARA 441 post.

6 See PARA 443 post.

7 See PARA 444 post.

8 See PARA 445 post.

9 See PARA 447 post.

10 See PARA 449 post.

11 See PARA 446 post.

12 See PARAS 461-463 post.

13 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 29.2.

14 As to the bringing of an action for infringement of a Community trade mark see PARA 250 et seq ante.

15 See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 98(1); and PARA 258 ante. See also Case C-316/05 *Nokia Corp v Wärdele* [2007] IP & T 499, [2006] All ER (D) 219 (Dec). The practical effect of this requirement is similar to the English practice as to the grant of injunctions: see PARAS 437-440 post.

16 Ie if the acts of infringement were committed or threatened to be committed in the United Kingdom. See EC Council Regulation 40/94 (OJ L11, 14.1.94, p 1) on the Community trade mark, art 98(2) (which provides that, as regards sanctions for infringement, the court must apply the law of the member state in which the acts of infringement were committed); and PARA 258 ante.

17 'The very life of a trade mark depends upon the promptitude with which it is vindicated': see *Orr Ewing & Co v Johnston & Co* (1880) 13 ChD 434 at 464, CA, per James LJ; approved (1882) 7 App Cas 219, HL. As a general proposition this statement remains as true today as when it was said: *Phones4U Ltd v Phone4u.co.uk Ltd* [2006] EWCA Civ 244, [2007] RPC 83.

18 See PARAS 450-451 post.

19 These were formerly known as Anton Piller orders. See PARA 452 post.

20 See PARA 453 post.

21 These were formerly known as Mareva injunctions. See PARA 455 post.

22 See PARAS 453-454 post.

23 Ie under CPR Pt 24: see CIVIL PROCEDURE vol 11 (2009) PARA 524 et seq.

24 See PARA 456 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/B. INJUNCTION AND DECLARATION/437. Permanent injunction.

## **B. INJUNCTION AND DECLARATION**

### **437. Permanent injunction.**

An infringement of a registered or protected international trade mark, or the passing off of goods or services, gives generally<sup>1</sup> the right to an injunction to restrain its continuance<sup>2</sup>; but, where it is clear that the defendant has no intention of continuing the wrongful acts, a declaration may be granted in lieu of an injunction, together with liberty to apply for an injunction<sup>3</sup>. Where the act is an isolated and innocent act<sup>4</sup> or where the acts were inadvertent<sup>5</sup>, particularly if the defendant has promptly admitted the claimant's rights<sup>6</sup>, an injunction may not be granted. Where, however, there was evidence of the act having been done by mistake but the defendant refused to give an apology or to offer any undertaking, an injunction has been granted<sup>7</sup>. Similarly, where a defendant insists on a claim of right to do certain things, it is no ground for refusing an injunction to restrain him from doing them to prove that he has not yet done them in fact<sup>8</sup>. An application by the defendant for the registration of a trade mark is a sufficient threat to use the mark<sup>9</sup>. Even if the defendant offers an undertaking, the claimant may well be entitled (as, for example, where publicity is desirable) to an order in open court if the infringement was deliberate<sup>10</sup>.

If an offer made after the commencement of proceedings is to deny the claimant an injunction, it must be an offer that would give the claimant all to which he is entitled<sup>11</sup>. Offers can be made without prejudice except on the question of costs<sup>12</sup>. Where such an offer is made, the subsequent costs of continuing proceedings to obtain an order in open court may not be recoverable<sup>13</sup>.

1 In proceedings against the Crown the court may not grant an injunction but may make an order declaratory of the parties' rights: see the Crown Proceedings Act 1947 s 21; and CROWN PROCEEDINGS AND CROWN PRACTICE vol 12(1) (Reissue) PARA 134. See, however, *Re M*[1994] 1 AC 377, sub nom *M v Home Office*[1993] 3 All ER 537, HL (court has jurisdiction in proceedings for judicial review to grant an injunction against a Minister of the Crown).

2 *Edelsten v Edelsten* (1863) 1 DeGJ & Sm 185 at 199 (non-statutory mark); *Upmann v Forester*(1883) 24 ChD 231 (non-statutory mark); *Slazenger & Sons v Spalding & Bros*[1910] 1 Ch 257, 27 RPC 20 (registered trade mark); *Forth and Clyde and Sunnyside Iron Cos Ltd v William Sugg & Co Ltd* (1928) 45 RPC 382. As to the need to allege and show an intention to continue the wrongful acts see *Cellular Clothing Co Ltd v G White & Co Ltd* (1952) 70 RPC 9; and as to the enforcement by injunction of an order staying proceedings on agreed terms (a 'Tomlin' order) see PARA 424 ante.

3 *Treasure Cot Co Ltd v Hamley Bros Ltd* (1950) 67 RPC 89; *Sterwin AG v Brocades (Great Britain) Ltd*[1979] RPC 481. There is no power to make an interim declaration: see note 1 supra.

4 *Leahy, Kelly and Leahy v Glover* (1893) 10 RPC 141 (act of employee without principal's knowledge); *Burberrys v Watkinson* (1906) 23 RPC 141 (isolated mistake); *Kodak Ltd v Grenville* (1908) 25 RPC 416 (honest isolated act); *John Knight & Sons Ltd v Crisp & Co Ltd* (1904) 21 RPC 670 (single instance of passing off with no intention of continuance and no proof of damage). Cf *Société Française Radio-Electrique v West Central Wireless Supplies* (1928) 45 RPC 276 (single sale of article, but article previously publicly exhibited under plaintiff's trade mark; plaintiff entitled to injunction or undertaking, but order drafted to make clear that infringement was innocent, so that this fact might appear if order advertised).

5 *Wayne V Myers Co Ltd v LE Fields Auto Services Ltd* (1954) 71 RPC 435 (infringement of trade mark and passing off).

6 *Upmann v Elkan*(1871) 7 Ch App 130.

7 *Steiner Products Ltd v Stevens* [1957] RPC 439.

8 *Havana Cigar and Tobacco Factories Ltd v Oddenino* [1924] 1 Ch 179 at 190, 41 RPC 47 at 54, CA.

9 *Ravenhead Brick Co Ltd v Ruabon Brick and Terra Cotta Co Ltd* (1937) 54 RPC 341. See also the Trade Marks Act 1994 s 32(3); and PARA 363 ante.

10 *Gandy Belt Manufacturing Co Ltd v Fleming, Birkby and Goodall Ltd* (1901) 18 RPC 276 (followed in *JT Smith and JE Jones Ltd v Service, Reeve & Co Ltd* [1914] 2 Ch 576, 31 RPC 319); *Fox v Luke* (1925) 43 RPC 37; *Kodak Ltd v T Illingworth & Co Ltd* (1925) 43 RPC 33; and see PARA 436 ante.

11 See *Colgate-Palmolive Ltd v Markwell Finance Ltd* [1989] RPC 497, CA; *Brugger v Medicaid* [1996] FSR 362; *Illustrated Newspapers Ltd v Publicity Services (London) Ltd* [1938] Ch 414 at 424, [1938] 1 All ER 321 at 329, 55 RPC 172 at 183. Thus the offer should include costs: *Société Française Radio-Electrique v West Central Wireless Supplies* (1928) 45 RPC 276. See also *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 287, HL.

12 These are now known as 'Part 36 offers': see CPR Pt 36, codifying the procedure approved in *Calderbank v Calderbank* [1976] Fam 93, [1975] 3 All ER 333, CA, extended to all cases by *Cutts v Head* [1984] Ch 290, [1984] 1 All ER 597, CA. See CIVIL PROCEDURE vol 11 (2009) PARA 729 et seq. Where such an offer is made, the fact that such an offer has been made must not be communicated to the judge until the case has been decided: CPR 36.13(2).

13. <sup>13.</sup> See *Slazenger v Pigott* (1895) 12 RPC 439; *Winkle & Co Ltd v Gent & Son* (1914) 31 RPC 473; *Rippingilles Albion Lamp Co Ltd v Clarke's Syphon Stove Co Ltd* (1917) 34 RPC 365.

## UPDATE

### 437 Permanent injunction

NOTE 2--See also *Boehringer Ingelheim Ltd v Vetplus Ltd* [2007] EWCA Civ 583, [2007] Bus LR 1411.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/B. INJUNCTION AND DECLARATION/438. Form of permanent injunction.

#### **438. Form of permanent injunction.**

The form of injunction varies according to the acts to be restrained<sup>1</sup>. In an action for infringement of a registered trade mark, the injunction restrains the infringement of the mark generally<sup>2</sup>. In an action for passing off, the injunction may relate to the use of a trading name or to the use of a mark or name on goods<sup>3</sup>. A passing off injunction relating to the use of a mark or name on goods may restrain user of the mark or name without clearly distinguishing the goods from the claimant's<sup>4</sup>, but it is difficult to comply with such an injunction<sup>5</sup>. An injunction may be granted restraining user calculated to deceive<sup>6</sup>, or imitation of get-up<sup>7</sup>, or sale under a name or mark so closely resembling the claimant's as to be calculated to pass off or enable others to pass off goods as his<sup>8</sup>, or the sale of goods other than the claimant's goods under a particular name unless it is first ascertained that the claimant's goods are not required<sup>9</sup>. In other passing off cases, the order may not give the defendant the opportunity to distinguish his goods from the claimants'<sup>10</sup>. In special cases, the order may permit sales under a mark only if certain labelling precautions are taken<sup>11</sup>. In general a passing off injunction will extend to the whole of England and Wales, even though the claimant has established a reputation in a limited area only<sup>12</sup>. A mandatory injunction requiring a company to change its name may be ordered<sup>13</sup>.

1 In practice, an injunction is not granted in a form so qualified that it might be said subsequently to have amounted to the court laying down a course of conduct which the defendant might pursue: see *Kerfoot v RA Cooper Ltd* (1908) 25 RPC 508. An undertaking agreed between the parties may, however, be in such a form: see *Twentieth Century Fox Film Corp v Gala Film Distributors Ltd* [1957] RPC 105. For the apt words restraining acts by agents etc see *Marengo v Daily Sketch and Sunday Graphic Ltd* [1948] 1 All ER 406, 65 RPC 242, HL.

2 See eg *Dunlop Rubber Co Ltd v AA Booth & Co Ltd* (1926) 43 RPC 139; *Forth and Clyde and Sunnyside Iron Cos Ltd v William Sugg & Co Ltd* (1928) 45 RPC 382; *Reynolds v Lafferty's Ltd* [1958] RPC 387 at 396; cf *Coflexip SA v Stolt Comex Seaway MS Ltd* [2001] 1 All ER 952, [2001] RPC 182, CA (a patents case). Occasionally the injunction contains a reference to the specific infringing mark complained of. It may contain a saving corresponding to the terms of the Trade Marks Act 1994 s 11(2)(a) (see PARA 93 ante) for the defendant to use his own name in accordance with honest practices: *Parker-Knoll (Textiles) Ltd's Trade Mark, Parker-Knoll Ltd v Knoll International Ltd* [1961] RPC 346 at 373, CA; affd [1962] RPC 265, HL. A qualified injunction may be granted in some circumstances: *Microsoft Corp v Plato Technology Ltd* [1999] IP & T 1, CA (restricted injunction granted where defendant infringed claimant's rights only in a relatively minor and unintended way and no evidence of intention of repeating infringements); *Glaxo Group Ltd v Dowelhurst Ltd* [2004] EWCA Civ 290, [2004] IP & T 1035, [2005] ETMR 104 (qualified injunction granted in PARALLEL import case where it was difficult for defendant to tell whether goods were in free circulation or not); *Sun Microsystems Inc v Amtec Computer Corp Ltd* [2006] EWHC 62 (Ch), [2006] FSR 630 (differently qualified injunction granted in PARALLEL import case). For a case where the court granted a full injunction, and refused the qualification sought by the defendant on the ground that to include it could involve the court in deciding management and commercial questions, see *British Telecommunications plc v Nextcall Telecom plc* [2000] FSR 679.

3 As to the restraint of the use of a trader's own name see PARA 344 ante.

4 See eg *R Johnston & Co v Archibald Orr Ewing & Co* (1882) 7 App Cas 219 at 234, HL; *Frank Reddaway & Co Ltd v George Banham & Co Ltd* [1896] AC 199 at 221, HL; *Re Teofani & Co's Trade Mark, Teofani & Co Ltd v Teofani* [1913] 2 Ch 545, 30 RPC 446; *Brittain Publishing Co (London) Ltd and London and Local Newspapers Ltd v Trade and Commercial Press Ltd* [1957] RPC 134; *Parker-Knoll (Textiles) Ltd's Trade Mark, Parker-Knoll Ltd v Knoll International Ltd* [1961] RPC 346 at 373, CA (affd [1962] RPC 265, HL).

5 As to the problems involved see eg *Parker-Knoll Ltd v Knoll International Ltd* [1962] RPC 243, CA (proceedings for infringement), although the defendants did ultimately succeed in distinguishing (see *Parker-Knoll plc v Knoll Overseas Ltd* [1985] FSR 349).

6 See eg *Ideal General Supply Co Ltd v Louis Edelson and Bette Edelson (t/a the Ideal Clothing Co)* [1957] RPC 252 at 259; *Siebert v Findlater* (1878) 7 ChD 801 at 814.

7 *William Edge & Sons Ltd v William Nicolls & Sons Ltd* [1911] AC 693, 28 RPC 582, HL; *Biro Swan Ltd v Tallon Ltd* [1961] RPC 326.

8 See *Adrema Ltd v Adrema-Werke GmbH and BEM Business Efficiency Machines Ltd* [1958] RPC 323 at 332.

9 *Havana Cigar and Tobacco Factories Ltd v Oddenino* [1924] 1 Ch 179, 41 RPC 47, CA; *Goddard v Watford Co-operative Society* (1924) 41 RPC 218; and see *Treasure Cot Co Ltd v Hamley Bros Ltd* (1950) 67 RPC 89 at 94 (declaration granted in lieu of an injunction). Such an injunction will not be qualified by a proviso excusing the defendant if he uses his best endeavours to comply: *Showerings Ltd v Entam* [1975] FSR 45.

10 See *Montgomery v Thompson* [1891] AC 217, 8 RPC 361, HL (where it was not thought practicable to allow the defendant to distinguish).

11 See *Sony KK v Saray Electronics (London) Ltd* [1983] FSR 302, CA (disclaiming labels required).

12 *Chelsea Man Menswear Ltd v Chelsea Girl Ltd* [1987] RPC 189, CA.

13 *Glaxo plc v Glaxowellcome Ltd, Cullen and MacDonald* [1996] FSR 388. If the company refuses or neglects to change its name it appears that an order should be sought against the members of the company requiring them to pass the appropriate special resolution: *Halifax plc v Halifax Repossessions Ltd* [2004] EWCA Civ 331, [2004] FSR 903, [2004] IP & T 905.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/B. INJUNCTION AND DECLARATION/439. Stay of permanent injunction.

#### **439. Stay of permanent injunction.**

A stay of a permanent injunction may be granted in accordance with general principles<sup>1</sup>. In particular, a stay may be granted pending appeal<sup>2</sup> to give the defendant sufficient time to comply with the injunction<sup>3</sup>. Where a stay pending appeal is sought, the claimant will now normally be required to give a cross-undertaking in damages if the stay is to be refused<sup>4</sup>.

1 See CIVIL PROCEDURE vol 12 (2009) PARA 1357 et seq.

2 See CIVIL PROCEDURE vol 11 (2009) PARA 363. A stay pending appeal on terms that the defendant paid 10% of its gross proceeds of sale into a joint account was granted in *CPC (United Kingdom) Ltd v Keenan* [1986] FSR 527 ('Oxbridge' marmalade). This was an interlocutory appeal but the same sort of consideration may arise after full trial. For a form of order after trial see *HP Bulmer Ltd and Showerings Ltd v J Bollinger SA and Champagne Lanson Père & Fils* [1976] RPC 97 at 150.

3 Eg where it would involve re-labelling or a change of company name: see eg *Saville Perfumery Ltd v June Perfect Ltd and FW Woolworth & Co Ltd* (1941) 58 RPC 147 at 169, HL.

4 See *Minnesota Mining and Manufacturing Co v Johnson and Johnson Ltd* [1976] RPC 671, CA (a patent case).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/B. INJUNCTION AND DECLARATION/440. Enforcement of injunction.

#### **440. Enforcement of injunction.**

An injunction or undertaking is enforced in the usual way, for example by committal<sup>1</sup> as against an individual, or by sequestration<sup>2</sup> as against a body corporate or, possibly, its directors. Personal service of the order must have normally been effected on the directors if the order is to be so enforced against them<sup>3</sup>. If contempt is alleged, the court must decide the matter even if it means deciding a question of liability in a pending action<sup>4</sup>. Costs on a successful application are normally awarded on an indemnity basis<sup>5</sup>.

1 See CPR Sch 1 RSC Ord 52; and CIVIL PROCEDURE vol 12 (2009) PARAS 1245, 1249, 1514 et seq.

2 See *Edward Grey Ltd v Greys (Midlands) Ltd* (1952) 70 RPC 25; *C Alexander & Co Ltd v Devon Cold Wave Co Ltd* [1957] RPC 331; *English Rose Ltd v Daintifyt Brassiere Co Ltd* [1958] RPC 359 (affd [1959] RPC 41, CA) (cases where no order was made save for payment of the plaintiff's costs as between solicitor and client); *Brittain Publishing Co (London) Ltd v Trade and Commercial Press Ltd* [1957] RPC 271 (no order made); *General Radio Co v General Radio Co (Westminster) Ltd* [1958] RPC 68 (no order except that costs of motion should be plaintiff's costs in action). See also CIVIL PROCEDURE vol 12 (2009) PARAS 1245, 1249, 1269, 1380 et seq. Leave for withdrawing sequestration proceedings is needed: see *Showerings Ltd v Fern Vale Brewery Co Ltd* [1958] RPC 462. A clear breach must be shown if sequestration is to be granted: *Redwing Ltd v Redwing Forest Products Ltd* (1947) 64 RPC 67.

3 See CPR Sch 1 RSC Ord 45 r 7(2); and CIVIL PROCEDURE vol 12 (2009) PARA 1249. See also *Redwing Ltd v Redwing Forest Products Ltd* (1947) 64 RPC 67.

4 *Chanel Ltd v FGM Cosmetics Ltd* [1981] FSR 471. See, however, *Spectravest Inc v Aperknit Ltd* [1988] FSR 161, where Millett J held that, in the case of an interlocutory injunction not to infringe the plaintiff's copyright, the injunction meant the copyright claimed by the plaintiff and that the subsistence and ownership of the copyright was to be assumed. Cf *Staver Co Inc v Digitext Display Ltd* [1985] FSR 512, where Scott J took the view that such a form of injunction required the plaintiff to prove his case in full to succeed on a contempt motion. It is always better to frame an interim injunction by reference to precise acts only and omitting any reference to a legal right.

5 As to the indemnity basis see CPR 44.4(1). Assessment of costs is now generally either on the standard basis or on the indemnity basis: see CPR 44.4; and CIVIL PROCEDURE vol 12 (2009) PARA 1747.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/B. INJUNCTION AND DECLARATION/441. Declaration.

#### **441. Declaration.**

Normally a declaration that a defendant has infringed a trade mark is unnecessary because the grant of the injunction speaks for itself. Occasionally an injunction is not awarded, as being unnecessary in the circumstances<sup>1</sup>.

<sup>1</sup> See eg *Treasure Cot Co Ltd v Hamley Bros Ltd* (1950) 67 RPC 89; *Sterwin AG v Brocades (Great Britain) Ltd* [1979] RPC 481; and PARA 437 ante. Normally a declaration would be the appropriate remedy against the Crown: see PARA 437 note 1 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/C. PECUNIARY REMEDIES/442. Damages or account of profits.

### **C. PECUNIARY REMEDIES**

#### **442. Damages or account of profits.**

The two pecuniary remedies of an inquiry as to damages or account of profits are alternatives. Following judgment on the question of liability<sup>1</sup> the claimant is given an election as to which he prefers<sup>2</sup>. It is possible for the court to refuse either remedy and instead to award nominal damages only, but it will do so only where it is very clear that there is no actual damage<sup>3</sup>. An account of profits is an equitable remedy and on general principles<sup>4</sup> may be refused or limited where the claimant is at fault in some way<sup>5</sup> or where the defendant is blameless<sup>6</sup>.

1 It is the usual practice in trade mark and passing off cases for the claimant to claim an inquiry as to damages or an account of profits at his election and for there to be a split trial between liability and quantum. This is particularly convenient in this class of case where the primary remedy is an injunction and where quantifying damages or profits may be difficult. If a case were to arise where it was sensible to deal with the claim for pecuniary relief at the same time as trial, the claimant would have to elect between damages or an account at an earlier stage.

2 See *Weingarten Bros v Bayer & Co* (1905) 22 RPC 341 at 351, 92 LT 511 at 513, HL. An inquiry as to damages or an account of profits is a remedy additional to an injunction: *Weingarten Bros v Bayer & Co* supra. It seems usually to have been left to the option of the claimant whether an inquiry as to damages or an account of profits should be granted (see *Weingarten Bros v Bayer & Co* supra; *Saxlehner v Apollinaris Co* [1897] 1 Ch 893 at 902, 14 RPC 645 at 656), but in *Van Zeller v Mason, Cattley & Co* (1907) 25 RPC 37 at 41, Joyce J treated the matter as one for the discretion of the court. As to disclosure to enable the claimant to make his election see PARA 427 ante.

3 *McDonald's Hamburgers Ltd v Burgerking (UK) Ltd* [1987] FSR 112 at 122, CA, per Kerr LJ. For earlier cases see *Sanitas Co Ltd v Condy* (1886) 4 RPC 195; *Magnolia Metal Co v Atlas Metal Co* (1897) 14 RPC 389, CA. The costs of an inquiry are in the discretion of the court so that, if the claimant fails to prove damage (or to overtop a payment into court), he will be ordered to pay the costs of the inquiry.

4 See EQUITY vol 16(2) (Reissue) PARAS 553, 558-560.

5 See eg *Lever Bros, Port Sunlight Ltd v Sunniewite Products Ltd* (1949) 66 RPC 84 at 102 (account only from date of letter before action because plaintiff had delayed).

6 See eg *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 283, HL, per Lord Parker. See also *Henry Heath Ltd v Frederick Gorrings Ltd* (1924) 41 RPC 457.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/C. PECUNIARY REMEDIES/443. Inquiry as to damages.

#### **443. Inquiry as to damages.**

Where in an action for infringement of an intellectual property right the defendant knew, or had reasonable grounds to know, that he engaged in infringing activity, the damages awarded to the claimant must be appropriate to the actual prejudice he suffered as a result of the infringing activity<sup>1</sup>. When awarding such damages, all appropriate aspects must be taken into account, including in particular<sup>2</sup>:

- 547 (1) the negative economic consequences, including any lost profits, that the claimant has suffered and any unfair profits made by the defendant; and
- 548 (2) elements other than economic factors, including the moral prejudice caused to the claimant by the infringement.

Where appropriate, such damages may be awarded on the basis of the royalties or fees which would have been due had the defendant obtained a licence<sup>3</sup>.

Except to the extent that they are inconsistent with these provisions<sup>4</sup>, substantially the same principles govern inquiries as to damages and the measure of damages in actions for the infringement of trade marks as in actions for passing off<sup>5</sup>. The claimant can recover only in respect of such damage as he can be shown to have in fact sustained or as must be presumed to flow from the acts proved to have been committed by the defendant<sup>6</sup>. It is no defence to a claim for more than nominal damages<sup>7</sup> that the defendant acted innocently<sup>8</sup>. An inquiry as to damages may be refused if there is no evidence of such damage<sup>9</sup> or a payment into court has been made sufficient to cover any damage<sup>10</sup>. Such an inquiry is normally granted at the risk of the claimant as to costs<sup>11</sup>. An inquiry as to damages may be ordered against both a company and individuals who have been responsible for the company's tortious acts<sup>12</sup>. The form of an order for inquiry as to damages should indicate that the inquiry is to be limited to damage suffered by the claimant through the defendant's wrongful acts as distinct from damage caused by mere trade competition<sup>13</sup>.

The measure of damages recoverable is largely a question of fact to be determined in the light of the evidence by the tribunal in the way in which a jury would estimate damages<sup>14</sup>. In general the claimant is entitled to damages for all loss actually sustained by him as the natural and direct consequence of the defendant's wrongful acts, including any loss of trade sustained either directly from those acts or properly attributable to the injury to the claimant's reputation and goodwill caused by the acts<sup>15</sup>. It will not be assumed in the absence of evidence that, where the defendant has sold deceptive articles, every one of the sales would, but for the deception, have necessarily been obtained by the claimant<sup>16</sup>. The court will, however, presume that the presence on the market of a large quantity of deceptive goods will have an adverse effect on the claimant's business; and where such goods have been sold to a middleman, it is not necessary for the claimant to prove that there has been a fraudulent resale by the middleman<sup>17</sup>. Where the claimant cannot prove diversion of trade or any specific damage to goodwill, he may be able to claim damages assessed on a reasonable royalty basis<sup>18</sup>. The costs of putting innocent third parties on notice are recoverable as damages<sup>19</sup>, as are the costs of a prior legal action for disclosure to find out the name of the defendant<sup>20</sup>.

Where damages will fall to be included by the claimant in his statement of profits, no account should be taken of income tax in assessing them<sup>21</sup>. VAT may be payable on a sum of damages received by way of settlement<sup>22</sup>.

Damages can be recovered only in respect of an act which has taken place within the six years preceding the issue of the writ<sup>23</sup>, unless concealed fraud is established<sup>24</sup>. Damages have been refused on the ground of delay<sup>25</sup>.

1 Intellectual Property (Enforcement, etc) Regulations 2006, SI 2006/1028, reg 3(1).

2 Ibid reg 3(2)(a). Regulation 3 is derived from EC Parliament and Council Directive 2004/48 (OJ L157 30.4.04, p 45) art 13.

3 Intellectual Property (Enforcement, etc) Regulations 2006, SI 2006/1028, reg 3(2)(b).

4 Ibid reg 3(3).

5 Cf *Manus Akt v RJ Fullwood and Bland Ltd* (1954) 71 RPC 243 (damages for infringement and passing off assessed together).

6 See *Draper v Trist* [1939] 3 All ER 513, 56 RPC 429, CA; *Ideal General Supply Co Ltd v Louis Edelson and Bette Edelson (t/a the Ideal Clothing Co)* [1957] RPC 252 at 258. As to the assessment of damages in tort generally see DAMAGES vol 12(1) (Reissue) PARA 851 et seq.

7 As to entitlement to nominal damages see *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273, HL; *Draper v Trist* [1939] 3 All ER 513 at 518, 56 RPC 429 at 435, CA. Nominal damages have, however, been refused where the plaintiff had promptly put an end to the wrongful act of the defendant and had not shown that it had suffered any loss: *Ideal General Supply Co Ltd v Louis Edelson and Bette Edelson (t/a the Ideal Clothing Co)* [1957] RPC 252 at 258.

8 *Gillette UK Ltd v Edenwest Ltd* [1994] RPC 279.

9 See PARA 442 note 2 ante.

10 *Samuelson v Producers Distributing Co Ltd* (1931) as reported in 48 RPC 580 at 590.

11 *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273, HL. See also eg *Draper v Trist* (1939) as reported in 56 RPC 429 (claim put forward for £48,000; £2,000 recovered; plaintiffs awarded half their costs); *Manus Akt v RJ Fullwood and Bland Ltd* (1954) 71 RPC 243 (claim for between £67,000 and £76,000, but £10,000 was awarded; plaintiff awarded costs of inquiry).

12 *Middlemas and Wood v Moliver & Co Ltd* (1921) 38 RPC 97; *Oertli AG v EJ Bowman (London) Ltd* [1956] RPC 282 (where it was said that a director would not be liable for any new passing off which occurred after he ceased to be a director).

13 *Baume & Co Ltd v AH Moore Ltd* [1958] RPC 319, CA (where the defendants withdrew an objection to an order referring to sale under any name 'calculated' to pass off the goods as the plaintiffs'). See also *Singer Manufacturing Co v British Empire Manufacturing Co Ltd* (1903) 20 RPC 313 at 320. As to disclosure in relation to an inquiry as to damages see PARA 427 ante.

14 See *Alexander & Co v Henry & Co, Mitchell and Waller & Co* (1895) 12 RPC 360; *Ledger Sons & Co v J Munro & Co Ltd* (1916) 33 RPC 53, Ct of Sess; *Juggi Lal-Kamlapat and Juggilal-Kamlapat Mills Co of Cawnpore v Swadeshi Co Ltd* (1928) 46 RPC 74, PC; *Manus Akt v RJ Fullwood and Bland Ltd* (1954) 71 RPC 243 at 250; and see generally *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1975] 2 All ER 173, [1975] 1 WLR 819, [1976] RPC 197, HL.

15 *AG Spalding & Bros v AW Gamage Ltd* (1918) 35 RPC 101, CA. Such damages may include the cost of advertisements to counteract the effect of the defendant's conduct.

16 *Leather Cloth Co Ltd v Hirschfield* (1865) LR 1 Eq 299; *Alexander & Co v Henry & Co, Mitchell and Waller & Co* (1895) 12 RPC 360; *Magnolia Metal Co v Atlas Metal Co* (1897) 14 RPC 389, CA; *Ledger Sons & Co v J Munro & Son Ltd* (1916) 33 RPC 53 at 59, Ct of Sess; *Draper v Trist* [1939] 3 All ER 513 at 520, 56 RPC 429 at 437, CA; *PC Products Ltd v Dalton* [1957] RPC 199 at 202, Ct of Sess.

17 *Draper v Trist* [1939] 3 All ER 513, 56 RPC 429, CA.

18 *Road Tech Computer Systems Ltd v Mandata (Management and Data Services) Ltd* [2000] IP & T 1029, Master (distinguishing *Dormeuil Frères SA v Feraglow Ltd* [1990] RPC 449). This is an application of the 'user principle': see also *Stoke on Trent City Council v W & J Wass Ltd* [1988] 3 All ER 394, [1988] 1 WLR 1406, CA; *Inverugie Investments Ltd v Hackett* [1995] 3 All ER 841, [1995] 1 WLR 713, PC; *A-G v Blake* [2001] 1 AC 268,



[2000] 4 All ER 385, HL. The user principle is well-established in relation to other intellectual property rights: see *Meters v Metropolitan Gas Meters Ltd* (1911) 28 RPC 157, 104 LT 113, CA (patents); *Stovin-Bradford v Volpoint Properties Ltd* [1971] Ch 1007, [1971] 3 All ER 570, CA (copyright); *Michael O'Mara Books Ltd v Express Newspapers plc* [1998] EMLR 383, [1999] FSR 49 (copyright); *Blayney (t/a Aardvark Jewelry) v Clogau St David's Gold Mines Ltd* [2002] EWCA Civ 1007, [2003] FSR 360, CA (copyright); *Seager v Copydex Ltd (No 2)* [1969] 2 All ER 718, [1969] 1 WLR 809, CA (confidential information); *Dowson & Mason Ltd v Potter* [1986] 2 All ER 418, [1986] 1 WLR 1419, CA (confidential information). However, it has been doubted whether the user principle is always applicable to trade mark cases: *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 767, [2004] IP & T 1049.

19 *Dormeuil Frères SA v Feraglow Ltd* [1990] RPC 449.

20 *Morton-Norwich Products Inc v Intercen Ltd (No 2)* [1981] FSR 337.

21 *PC Products Ltd v Dalton* [1957] RPC 199 at 202, Ct of Sess.

22 *Cooper Chasney Ltd v Customs and Excise Comrs* [1992] FSR 298.

23 See the Limitation Act 1980 s 2 (actions founded on tort); and LIMITATION PERIODS vol 68 (2008) PARA 979 et seq.

24 See *ibid* s 32 (as amended); and LIMITATION PERIODS vol 68 (2008) PARA 1220 et seq.

25 *F Reddaway & Co Ltd v Stevenson & Bro Ltd and Stevenson* (1902) 20 RPC 276; *GH Gledhill & Sons Ltd v British Perforated Toilet Paper Co* (1911) 28 RPC 429. It is difficult to see the justification for this, unless delay is such as to debar the entire cause of action or there has been such delay in pursuing an inquiry that it is struck out for want of prosecution. As to the effect of delay and acquiescence generally see PARA 99 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/C. PECUNIARY REMEDIES/444. Account of profits.

#### **444. Account of profits.**

The court may grant an account of profits<sup>1</sup> where one party knowingly marks his goods with the trade mark of the claimant or passes off his goods as those of the claimant<sup>2</sup>. An account may also be granted where one party owes a duty to another; the person to whom the duty is owed is entitled to recover from the other party every benefit which that other party has received by virtue of his fiduciary position, if in fact he has obtained it without the knowledge or consent of the party to whom he owes the duty<sup>3</sup>. An account is normally refused if the defendant was ignorant of the claimant's rights, and is limited to the period, if any, during which the defendant had knowledge of the claimant's rights<sup>4</sup>. An account cannot be granted in respect of any matter which arose more than six years before the commencement of the action<sup>5</sup>, except in a case of concealed fraud<sup>6</sup>. Where the claimant has without excuse failed for a considerable period to take proceedings after he has become aware that an infringement of his rights has taken place, an account may be granted of profits only up to the time when he became aware of his rights<sup>7</sup>, or may be dated only from the time when he complained to the defendants<sup>8</sup>, or may be refused except as regards the period since the commencement of proceedings<sup>9</sup>. The costs of taking an account are normally reserved.

In taking an account of profits, which is an equitable relief, the damage which the claimant has suffered is totally immaterial, the object of the account being to give the claimant the actual profits which the defendant has made and of which equity strips him as soon as it is established that the profits were improperly made<sup>10</sup>. The claimant is, however, only entitled to an account of such profits as ought to be treated as having been improperly made by the defendant<sup>11</sup>. Accordingly, on the sale of goods by the defendant to a middleman, the profit for which the defendant must account is the profit which he has made by the sale of the goods in fraudulent dress to the middleman and it is immaterial whether the middleman sells the goods to retailers fraudulently or not<sup>12</sup>.

1 An account of profits and an inquiry as to damages are alternative remedies: see PARA 442 ante. As to the remedy of account generally see EQUITY vol 16(2) (Reissue) PARA 691 et seq; as to accounts as ancillary to injunctions see CIVIL PROCEDURE vol 11 (2009) PARA 335; and as to disclosure in relation to an account of profits see PARA 427 ante.

2 *AG Spalding & Bros v AW Gamage Ltd* (1915) 32 RPC 273 at 283, HL, per Lord Parker.

3 *Electrolux Ltd v Electrix Ltd* (1953) 70 RPC 158 at 159. As to the disability of a person in a fiduciary position to make a profit from that position generally see EQUITY vol 16(2) (Reissue) PARAS 856-858; TRUSTS vol 48 (2007 Reissue) PARA 926 et seq.

4 *Edelsten v Edelsten* (1863) 1 DeGJ & Sm 185 at 199; *Ellen v Slack* (1880) 24 Sol Jo 290; *Slazenger & Sons v Spalding & Bros* [1910] 1 Ch 257, 27 RPC 20.

5 See the Limitation Act 1980 s 23, applying the time limit applicable to the claim which is the basis of the duty to account. See also s 2 (actions founded on tort); and LIMITATION PERIODS vol 68 (2008) PARA 1008.

6 See *ibid* s 32 (as amended); and LIMITATION PERIODS vol 68 (2008) PARA 1220 et seq.

7 See *Electrolux Ltd v Electrix Ltd* (1953) 70 RPC 158 at 159 (order made that the plaintiffs should be entitled to recover any damages proved); *Edward Young & Co Ltd v Holt* (1947) 65 RPC 25 at 31 (plaintiff's delay held justified).

8 *Lever Bros, Port Sunlight Ltd v Sunniewite Products Ltd* (1949) 66 RPC 84 at 102.

9 *Harrison v Taylor* (1865) 12 LT 339; *Ford v Foster* (1872) 7 Ch App 611. As to the effect of delay or acquiescence on the right of action see PARA 100 ante.

10 *Draper v Trist* [1939] 3 All ER 513 at 522, 56 RPC 429 at 439, CA.

11 See *My Kinda Town Ltd v Soll* [1983] RPC 15, CA (where the principles of an account in a passing off case are discussed); cf *Celanese International Corp v BP Chemicals Ltd* [1999] RPC 203, [1998] All ER (D) 493 (a patent case).

12 *Lever v Goodwin* (1887) 36 ChD 1 at 7; cited in *Draper v Trist* [1939] 3 All ER 513 at 523, 56 RPC 429 at 439, CA. As to the presumption of damage arising from sales of deceptive goods to a middleman when an inquiry has been ordered as to damages see PARA 443 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/D. NON-PECUNIARY REMEDIES/445. Delivery up of infringing articles or erasure of mark.

#### **D. NON-PECUNIARY REMEDIES**

##### **445. Delivery up of infringing articles or erasure of mark.**

An order may be made for the delivery up of infringing articles or labels or the erasure of an infringing mark<sup>1</sup>. Where the mark can be erased, the order will be for erasure only<sup>2</sup>. Delivery up is an equitable remedy ancillary to an injunction<sup>3</sup>. It is routine for the order to be accompanied by an order for verification upon oath that erasure or delivery up has been effected. Where the court makes an order for delivery up or erasure, the defendant must pay the costs of complying with that order unless the court orders otherwise<sup>4</sup>.

1 *Farina v Silverlock* (1858) 4 K & J 650; *Edelsten v Edelsten* (1863) 1 DeGJ & Sm 185 at 189, 196; *Slazenger & Sons v Feltham & Co* (1889) 6 RPC 531 at 538, CA; cf *Lissen Ltd v Mutton* (1928) 46 RPC 10 (order for delivery up refused in action for passing off). See also *Warwick Tyre Co Ltd v New Motor and General Rubber Co Ltd* [1910] 1 Ch 248, 27 RPC 161.

2 See the cases cited in note 1 supra. See also *County Chemical Co Ltd v Frankenburg* (1904) 21 RPC 722 (no order for delivery up made because the articles could be used legitimately in other ways and because of the plaintiff's delay in beginning the action).

3 As to the statutory power to order the erasure etc of an offending sign see PARA 446 post; and as to the statutory power to order delivery up of infringing goods etc see PARAS 461-463 post.

4 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 29.1.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/D. NON-PECUNIARY REMEDIES/446. Statutory power to make order for erasure etc of offending sign.

**446. Statutory power to make order for erasure etc of offending sign.**

Where a person is found to have infringed<sup>1</sup> a registered trade mark<sup>2</sup>, the court<sup>3</sup> may make an order<sup>4</sup> requiring him:

- 549 (1) to cause the offending sign to be erased, removed or obliterated from any infringing goods<sup>5</sup>, material<sup>6</sup> or articles<sup>7</sup> in his possession, custody or control<sup>8</sup>; or
- 550 (2) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question<sup>9</sup>.

If any such order is not complied with, or it appears to the court likely that such an order would not be complied with, the court may order that the infringing goods, material or articles be delivered to such person as the court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be<sup>10</sup>.

1 For the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see the Trade Marks Act 1994 s 10; and PARA 86 et seq ante.

2 As to the meaning of 'registered trade mark' see PARA 127 ante.

3 For the meaning of 'the court' see PARA 349 ante.

4 Trade Marks Act 1994 s 15(1).

5 For the meaning of 'infringing goods' see PARA 150 ante.

6 For the meaning of 'infringing material' see PARA 150 ante.

7 For the meaning of 'infringing articles' see PARA 150 ante.

8 Trade Marks Act 1994 s 15(1)(a).

9 Ibid s 15(1)(b).

10 Ibid s 15(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/D. NON-PECUNIARY REMEDIES/447. Certificate of validity of contested registration.

#### **447. Certificate of validity of contested registration.**

If in proceedings before the court<sup>1</sup> the validity of the registration<sup>2</sup> of a trade mark<sup>3</sup> is contested and it is found by the court that the trade mark is validly registered<sup>4</sup>, the court may give a certificate to that effect<sup>5</sup>. If the court gives such a certificate, and in subsequent proceedings<sup>6</sup>:

- 551 (1) the validity of the registration is again questioned; and
- 552 (2) the proprietor obtains a final order or judgment in his favour,

he is entitled to his costs as between solicitor and client<sup>7</sup> unless the court directs otherwise; but this provision does not extend to the costs of an appeal in any such proceedings<sup>8</sup>.

1 For the meaning of 'the court' see PARA 349 ante.

2 As to the grounds on which the registration of a trade mark may be declared invalid see PARA 118 et seq ante.

3 For the meaning of 'trade mark' see PARA 57 ante. This provision also applies if the validity of the protection of a protected international trade mark (UK) is contested: Trade Marks (International Registration) Order 1996, SI 1996/714, art 15(1). For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

4 For the meaning of 'registered' see PARA 19 note 2 ante.

5 Trade Marks Act 1994 s 73(1). There is no longer any express procedure whereby the proprietor can ask the registrar to add to the entry in the register a note that the certificate of validity has been granted in the course of the proceedings. It is, however, likely that in practice an entry would be made. A certificate given before 31 October 1994 under the Trade Marks Act 1938 s 47 (repealed) (certificate of validity of contested registration) has effect as if given under the Trade Marks Act 1994 s 73(1): s 105, Sch 3 para 21. As to the registrar see PARA 17 ante.

6 Under earlier legislation it was held that 'subsequent proceedings' meant proceedings started after the certificate had been given: *Automatic Weighing Machine Co v International Hygienic Society* (1889) 6 RPC 475 at 480; *Saccharin Corpn Ltd v Anglo-Continental Chemical Works* [1901] 1 Ch 414, 17 RPC 307. That is, however, unlikely to be so held in respect of a certificate issued under the Trade Marks Act 1994 s 73; cf the corresponding position in relation to patents (see *Mölnlyke AB v Procter & Gamble Ltd (No 5)* [1994] RPC 49 at 139, CA). Under previous legislation it was held that there was no appeal against the grant of such a certificate per se: *Haslam Foundry and Engineering Co Ltd v Hall* (1888) 20 QBD 491, 5 RPC 144, CA. The grant is purely discretionary: *Re Impex Electrical Ltd's Trade Marks, Impex Electrical Ltd v Weinbaum* (1927) 44 RPC 405 at 411. It is unlikely that a certificate will be given where the registration is attacked only on the ground of alleged non-use: *Lever Bros, Port Sunlight Ltd v Sunniewite Products Ltd* (1949) 66 RPC 84 at 102.

7 'Solicitor and own client' costs no longer exist as a basis for assessment of costs (formerly known as taxation of costs). Assessment of costs is now either on the standard basis or on the indemnity basis: see CPR Pt 44; and CIVIL PROCEDURE vol 12 (2009) PARA 1734 et seq. It is possible to argue that the reference in the Trade Marks Act 1994 s 73(2) to 'costs as between solicitor and client' is meant to refer to some higher standard but the better view is probably that it simply re-enacts the old provision and that the reference is to be taken to be the nearest equivalent to what was taxation on solicitor and own client basis (ie on the indemnity basis).

8 Ibid s 73(2).

#### **UPDATE**

#### **447 Certificate of validity of contested registration**

NOTE 3--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/D. NON-PECUNIARY REMEDIES/448. Notification of court order to registrar.

**448. Notification of court order to registrar.**

Where any order of the court affects the validity of an entry in the register, the court and the party in whose favour the order is made must serve a copy on the registrar within 14 days<sup>1</sup>. Where the order is made in favour of more than one party, a copy must be served by such party as the court directs<sup>2</sup>.

1 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 22.1, applying para 15.1.

2 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 22.1, applying para 15.2.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/E. COSTS/449. Costs.

## **E. COSTS**

### **449. Costs.**

Subject to the statutory provision as to the effect of a certificate of validity<sup>1</sup>, the costs of proceedings for infringement or passing off are in the discretion of the court and the same general principles apply in determining by whom costs are to be payable as in the case of other actions<sup>2</sup>.

A successful party will generally be awarded costs<sup>3</sup>; but under the Civil Procedure Rules costs orders should generally reflect the level of success which he has achieved<sup>4</sup>. Thus where a successful claimant has claimed too widely or has made allegations which he has failed to prove, he may be wholly or partly deprived of costs<sup>5</sup>, or may be given the general costs of the action or the costs of claims or issues on which he has succeeded, but ordered to pay the costs of claims or issues on which he has failed<sup>6</sup>. A claimant has been disallowed the costs of unnecessary evidence<sup>7</sup>. Where a claimant has brought an action for infringement and passing off and has succeeded as to one ground of action but failed as to the other, he has been awarded the general costs of the action, but the defendant has been awarded costs on the issue on which the claimant failed and the costs have been set off<sup>8</sup>. Where an offer giving the claimant all to which he is entitled is made by the defendant during proceedings, the costs of continuing proceedings may not be recoverable<sup>9</sup>. The costs of putting innocent third parties on notice are recoverable as damages<sup>10</sup>, as are the costs of a prior legal action for disclosure to find out the name of the defendant<sup>11</sup>.

A successful defendant may be refused his costs where, for example, he has made unfounded charges of fraud<sup>12</sup>, or has by his conduct brought the action on himself<sup>13</sup>.

Misrepresentations by the defendant, even if they are not of such a nature as to give the claimant a cause of action, have in many cases led to the defendant's being deprived of costs<sup>14</sup>, but this is not a proper course where the misrepresentations have reference to a collateral matter and have nothing to do with the claimant's case<sup>15</sup>.

The costs of three counsel have sometimes been allowed<sup>16</sup>.

1 See the Trade Marks Act 1994 s 73; and PARA 447 ante.

2 As to costs generally see CPR Pt 44; and CIVIL PROCEDURE VOL 12 (2009) PARA 1734 et seq. CPR 44.3 gives the court a very broad discretion as to the orders it may make in relation to costs. Costs are normally assessed on the standard basis: see CPR 44.4(1); and CIVIL PROCEDURE VOL 12 (2009) PARA 1747.

3 See CPR 44.3(2)(a); and CIVIL PROCEDURE VOL 12 (2009) PARA 1738. Where a retail trader innocently purchased and dealt with a small quantity of goods which turned out to be an infringement of a trade mark, the court made no order as to costs: *American Tobacco Co v Guest* [1892] 1 Ch 630. As to the costs of the registrar appearing where the relief sought includes revocation, a declaration of invalidity or rectification see PARA 413 ante.

4 *Phonographic Performance Ltd v AEI Rediffusion Music Ltd* [1999] 2 All ER 299, sub nom *AEI Rediffusion Music Ltd v Phonographic Performance Ltd (No 2)* [1999] 1 WLR 1507, CA.

5 See CPR 44.3(4), (5); and CIVIL PROCEDURE VOL 12 (2009) PARA 1739. Cf *Moet v Couston* (1864) 33 Beav 578; *Standish v Whitwell* (1866) 14 WR 512; *Metzler v Wood* (1877) 8 ChD 606; *Findlater, Mackie, Todd & Co Ltd v Henry Newman & Co* (1902) 19 RPC 235; *Montgomerie & Co Ltd v Young Bros* (1903) 20 RPC 781; *OT Ltd v Cumming & Co* (1914) 32 RPC 69, Ct of Sess; *Fram Manufacturing Co Ltd v Eric Morton & Co* (1922) 40 RPC 33,

CA; *Joseph Rodgers & Sons Ltd v WN Rodgers & Co* (1924) 41 RPC 277; *John Jaques & Sons Ltd v Chess* [1939] 3 All ER 227, 56 RPC 415 (on appeal [1940] 2 All ER 285, 57 RPC 77, CA). Cf *Jay v Ladler* (1888) 40 ChD 649, 6 RPC 136; *Rowland v Mitchell* (1896) 13 RPC 457; *Hodgson and Simpson v Kynoch* (1898) 15 RPC 465. See, however, notes 2-3 supra.

6 See CPR 44.3(4); *Pierce v Franks* (1846) 15 LJ Ch 122; *Saxlehner v Apollinaris Co* [1897] 1 Ch 893, 14 RPC 645; *GF Hipkins & Sons v Plant* (1898) 15 RPC 294; *Pneumatic Rubber Stamp Co v Lindler* (1898) 15 RPC 525. See, however, notes 2-3 supra.

7 *Daimler Motor Co (1904) Ltd v London Daimler Co Ltd* (1907) 24 RPC 379, CA (half costs of evidence allowed).

8 *Lever Bros Ltd v Bedingfield* (1898) 15 RPC 453; on appeal (1899) 16 RPC 3, CA (where judgment on the issue on which the plaintiff had succeeded in the court below was given for the defendant with costs of the appeal but not of the action); *Natural Chemicals Ltd and Veno's Drug Co Ltd and Irving's Yeast-Vite Ltd (Consolidated) v Amblins (Chemists) Ltd* (1940) 57 RPC 323. See, however, notes 2-3 supra.

9 See PARA 437 text and notes 11-13 ante. Cf *Colgate-Palmolive Ltd v Markwell Finance Ltd* [1989] RPC 497, CA (where a 'Calderbank' offer was insufficient so the plaintiff recovered its costs).

10 *Dormeuil Frères SA v Feraglow Ltd* [1990] RPC 449.

11 *Morton-Norwich Products Inc v Intercen Ltd (No 2)* [1981] FSR 337.

12 *Baker v Rawson* (1890) 45 ChD 519, 8 RPC 89; *Hargreave v Freeman* [1891] 3 Ch 39, 8 RPC 237. See notes 2-3 supra.

13 *Lambert and Butler Ltd v Goodbody* (1902) 19 RPC 377; and see *Lever Bros Ltd v Bedingfield* (1899) 16 RPC 3, CA; *Claudius Ash Sons & Co v Invicta Manufacturing Co Ltd* (1912) 29 RPC 465, HL. See notes 2-3 supra.

14 *Estcourt v Estcourt Hop Essence Co* (1875) 10 Ch App 276; *Newman v Pinto* (1887) 4 RPC 508, CA; *Thorneloe v Hill* [1894] 1 Ch 569 at 578, 11 RPC 61 at 72; *Lever Bros Ltd v Bedingfield* (1899) 16 RPC 3, CA; *Valentine Meat Juice Co v Valentine Extract Co Ltd* (1899) 17 RPC 1 at 13; *Winser v Armstrong & Co* (1899) 16 RPC 167 at 172; *B Warsop & Sons Ltd v Warsop* (1904) 21 RPC 481; *Cambridge University Press v University Tutorial Press* (1928) 45 RPC 335. See, however, notes 2-3 supra.

15 *F King & Co Ltd v Gillard & Co* [1905] 2 Ch 7, 22 RPC 327, CA. Probably this rule would not apply to such cases as *Estcourt v Estcourt Hop Essence Co* (1875) 10 Ch App 276; *Newman v Pinto* (1887) 4 RPC 508, CA, in each of which the plaintiff had a cause of action, but failed because of fraud of which the defendant was equally guilty. See notes 2-3 supra.

16 Such costs were granted in *Re Burroughs, Wellcome & Co's Trade Mark* (1905) 22 RPC 164; *Re Crosfield & Sons Ltd's Application* (1910) 27 RPC 433; *Adrema Ltd v Adrema-Werke GmbH and BEM Business Efficiency Machines Ltd* [1958] RPC 323. They were, however, refused in *Mercedes Daimler Motor Co Ltd v FIAT Motor Cab Co Ltd* (1913) 31 RPC 8; *Bentley Motors (1931) Ltd v Lagonda Ltd and Bentley, Re Bentley (1931) Ltd's Trade Mark No 528,124* (1947) 64 RPC 33. See also LEGAL PROFESSIONS vol 66 (2009) PARA 1316. See notes 2-3 supra.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/F. INTERIM AND SUMMARY REMEDIES/450. Interim injunction.

## **F. INTERIM AND SUMMARY REMEDIES**

### **450. Interim injunction.**

The general principles as to the grant of interim injunctions are discussed elsewhere in this work<sup>1</sup>. However, in actions for passing off or for infringement of a registered trade mark the prospects of the claimant's success<sup>2</sup> are often bound up with the question of whether damages are an adequate remedy. Thus where the claimant alleges that the defendant's mark is confusingly similar to his own, the question whether damages are an adequate remedy to the claimant will depend largely upon the court's assessment of whether there will be significant confusion pending trial, and this is a key question in assessing liability itself<sup>3</sup>. Further, it seems likely, at least in trade mark and passing off cases, that in the absence of a serious conflict of evidence relating to primary facts the court will pay greater attention to the claimant's prospects of success than it might otherwise pay<sup>4</sup>, as in that type of case the result of the application is likely to be determinative of the action<sup>5</sup>. Where damages are not an adequate remedy to either party, the court must choose the course which appears to involve the least risk of causing injustice<sup>6</sup>. There are cases where it would be inappropriate to grant an interim injunction unless the claimant accepts a similar restraint<sup>7</sup>.

Where the claimant seeks to restrain a competitor from comparative advertising on the ground of trade mark infringement, no interim injunction should be granted unless the court is satisfied that the claimant is more likely than not to succeed on trial<sup>8</sup>.

Delay in seeking an interim injunction normally affects the status quo of the parties but is not always fatal<sup>9</sup>, although it is hard to convince a court that a claimant who has delayed is really suffering serious and irreparable damage<sup>10</sup>. The claimant is required to give a cross-undertaking in damages if he is to be awarded an interim injunction<sup>11</sup>.

The terms of an interim injunction should normally be limited to what is necessary to protect the claimant pending trial<sup>12</sup>; and the injunction should be drafted so as to define what the defendant may not do without a dependence upon the legal right, as otherwise enforcement will require proof of infringement or passing off on a contempt motion<sup>13</sup>.

Applications for interim injunctions are sometimes resolved by the defendant's giving an undertaking to the court<sup>14</sup>. Where this is done, the claimant may not normally seek a wider injunction on a subsequent occasion pending trial<sup>15</sup>, nor may a defendant who has given such an undertaking withdraw it merely because he gave the undertaking on a mistaken view of the law<sup>16</sup>. Applications for interim injunctions often result in orders for a speedy trial<sup>17</sup>.

1 See CIVIL PROCEDURE vol 11 (2009) PARAS 316, 383 et seq. See, in particular, *American Cyanamid Co v Ethicon Ltd* [1975] AC 396, [1975] 1 All ER 504, [1975] RPC 513, HL (a patent infringement case), where the general principles as to the grant of interim injunctions were recast. The principles of *American Cyanamid Co v Ethicon Ltd* supra apply also to actions for passing off: *County Sound plc v Ocean Sound Ltd* [1991] FSR 367, CA.

2 'The court must be satisfied that the claim is not frivolous or vexatious, in other words that there is a serious question to be tried': *American Cyanamid Co v Ethicon Ltd* [1975] AC 396 at 408, [1975] 1 All ER 504 at 510, [1975] RPC 513 at 541, HL, per Lord Diplock. For the meaning of 'frivolous or vexatious' and 'serious question to be tried' in the context of interim injunctions see further *Mothercare Ltd v Robson Books Ltd* [1979] FSR 466 (passing off).

3 See *Sirdar Ltd v Les Fils de Louis Mulliez and Orsay Knitting Wools Ltd* [1975] FSR 309 at 312-313 per Graham J. Once the claimant has established an arguable case, it is likely, however, that damages will not be an

adequate remedy. There will be the substantial difficulty of establishing the extent of confusion and damage, and quantification of that: see eg *Morgan-Grampian plc v Training Personnel Ltd* [1992] FSR 267; *Antec International Ltd v South Western Chicks (Warren) Ltd* [1997] FSR 278. If, however, the risk of deception is not great so that the consequences to the claimant are not likely to be severe, an injunction may be refused: *Management Publications Ltd v Blenheim Exhibitions Group plc* [1991] FSR 348 (affd [1991] FSR 550, CA); *Financial Times Ltd v Evening Standard Co Ltd* [1991] FSR 7; *Stacey v 2020 Communications plc* [1991] FSR 49.

4 See *Newsweek Inc v British Broadcasting Corp*n [1979] RPC 441, CA; *Alfred Dunhill Ltd v Sunoptic SA* [1979] FSR 337, CA; *County Sound plc v Ocean Sound Ltd* [1991] FSR 367, CA; *Tamworth Herald Co Ltd v Thomson Free Newspapers Ltd* [1991] FSR 337; *United Biscuits (UK) Ltd v Burton Biscuits Ltd* [1992] FSR 14; *Advance Magazine Publishing Inc v Redwood Publishing Ltd* [1993] FSR 449.

5 See *British Broadcasting Corp v Talbot Motor Co Ltd* [1981] FSR 228; *Parmass/Pelly Ltd v Hodges* [1982] FSR 329. This is especially so if the injunction is to be granted, for then the defendant will have to change to another name or mark pending trial and is unlikely, having established that name or mark, to change back if he is successful at the trial. Other cases where this factor was taken into account include *Boots Co Ltd v Approved Prescription Services Ltd* [1988] FSR 45, CA; *Post Office v Interlink Express Parcels Ltd* [1989] FSR 369; *Stacey v 2020 Communications plc* [1991] FSR 49; *Gala of London Ltd v Chandler Ltd* [1991] FSR 294; *Management Publications Ltd v Blenheim Exhibitions Group plc* [1991] FSR 348 (affd [1991] FSR 550, CA); *Blazer plc v Yardley & Co Ltd* [1992] FSR 501. In all these cases the claimant, though having an 'arguable' case, did not have a strong one.

6 *NWL Ltd v Woods, The Nawala* [1979] 3 All ER 614, [1979] 1 WLR 1294, HL; *Cayne v Global Natural Resources plc* [1984] 1 All ER 225, CA.

7 See eg *Nationwide Building Society v Nationwide Estate Agents Ltd* [1987] FSR 579 (where both parties were trying to establish the word 'Nationwide' for an estate agency business and the court took the view that the plaintiff might establish an unfair commercial advantage by way of building up a reputation pending trial if the defendant alone were restrained).

8 See the Human Rights Act 1998 s 12(3); and CONFIDENCE AND DATA PROTECTION vol 8(1) (2003 Reissue) PARA 418. See also *Boehringer Ingelheim Ltd v Vetplus Ltd* [2007] EWCA Civ 583, [2007] All ER (D) 221 (Jun). When the urgency of the matter does not permit full consideration of the merits, a lesser probability of success will suffice: *Red Dot Technologies Ltd v Apollo Fire Detectors Ltd* [2007] EWHC 1166 (Ch). The rule against prior restraint established in *Bonnard v Perryman* [1891] 2 Ch 269 (in the interests of freedom of speech, the courts will not restrain the publication of a defamatory statement, whether a trade libel or a personal one, where the defendant says he is going to justify it at the trial of the action, except where the statement is obviously untruthful and libellous) does not apply to trade mark or passing off cases: *Boehringer Ingelheim Ltd v Vetplus Ltd* supra.

9 See eg *CPC (United Kingdom) Ltd v Keenan* [1986] FSR 527 ('Oxbridge' marmalade); *Cavendish House (Cheltenham) Ltd v Cavendish Woodhouse Ltd* [1970] RPC 234, CA.

10 See eg *Gala of London Ltd v Chandler Ltd* [1991] FSR 294.

11 See CIVIL PROCEDURE vol 11 (2009) PARA 419 et seq. It is not fatal to the claimant's case if he cannot show sufficient assets to be good for the cross-undertaking, but that is a factor to be taken into account: *Allen v Jambo Holdings Ltd* [1980] 2 All ER 502, [1980] 1 WLR 1252, CA. Where the claimant is abroad, the undertaking in damages can be given by a solvent party within the jurisdiction: see eg *Hobart Manufacturing Co v Cannon Industries Ltd* [1959] RPC 269.

12 See eg *Biro Swan Ltd v Tallon Ltd* [1961] RPC 326. See also CIVIL PROCEDURE vol 11 (2009) PARAS 395-395.

13 See PARA 440 ante.

14 See *Showerings Ltd v Mecca Ltd* [1957] RPC 217; *Copydex Ltd v Noso Products Ltd* (1952) 69 RPC 38; *Coca Cola Co v AG Barr & Co Ltd* [1961] RPC 387, Ct of Sess. If a perpetual undertaking is offered on the hearing of an interim injunction, this should be recited in the order: *Stillitz v Jones and Higgins Ltd* (1942) 60 RPC 15.

15 *GCT (Management) Ltd v Laurie Marsh Group Ltd* [1973] RPC 432.

16 *Chanel Ltd v FW Woolworth & Co Ltd* [1981] 1 All ER 745, [1981] 1 WLR 485, CA.

17 For this reason interim injunctions are much less common than was formerly the case. In some cases trials have taken place within two or three months of proceedings being commenced. This means that the balance of convenience is quite different to a situation where the trial will not take place for a year or more.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/F. INTERIM AND SUMMARY REMEDIES/451. Without notice interim injunctions.

**451. Without notice interim injunctions.**

Interim injunctions, like other interim remedies, may be granted on application without notice if it appears to the court that there are good reasons for not giving notice<sup>1</sup>. This would be the case if the matter is so urgent that there is not time to give notice, or if the giving of notice would frustrate the purpose of the application. Normally, particularly where the defendant has been given no informal notice, such injunctions are confined to cases of fraud or near fraud. Without notice interim injunctions are often awarded together with search orders and similar relief against counterfeiters and dealers in counterfeit goods<sup>2</sup>.

1 CPR 25.3(1). If an application is made without notice, the evidence in support must state the reasons for not giving notice: CPR 25.3(3).

2 As to search orders see PARA 452 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/F. INTERIM AND SUMMARY REMEDIES/452. Search orders and interim delivery-up orders.

#### **452. Search orders and interim delivery-up orders.**

On the application of the claimant without notice<sup>1</sup>, the court has power to order a defendant to permit the search of the defendant's premises for articles and documents relating to the alleged wrongdoing<sup>2</sup>. This power is exercised only where the claimant shows a strong prima facie case<sup>3</sup>. In relation to actions for passing off or infringement of a registered trade mark, this form of order is normally made only in cases of counterfeiting, as it is only in those cases that the court can be convinced of the need for the exercise of this powerful remedy<sup>4</sup>. Alternatively, a lesser form of order may be made requiring immediate delivery up but stopping short of requiring the defendant to permit a search<sup>5</sup>.

1 As to the making of applications without notice see PARA 451 text and note 1 ante.

2 CPR 25.1(1)(h). Such orders were formerly known as 'Anton Piller' orders, after *Anton Piller KG v Manufacturing Processes Ltd* [1976] Ch 55, [1976] 1 All ER 779, [1976] RPC 719, CA. They are now called search orders and are regulated by the Civil Procedure Act 1997 s 7(1); and *Practice Direction--Interim Injunctions* PD25 paras 7.1-7.11. The practice direction also specifies the normal form of the search order and makes provision for its execution to be supervised by a 'supervising solicitor' of requisite experience who acts as an officer of the court and is independent of the claimants' solicitors. Normally, the application is heard in private, as any kind of advance warning would defeat the purpose of the order.

3 See CIVIL PROCEDURE vol 11 (2009) PARA 403.

4 It is in the public interest to suppress as soon as possible the fraud on the public involved in the public sale of counterfeit product; and although enforcement of the order is a matter of discretion, the principle of the rule of law requires that the court should not be deflected from requiring disclosure by allegations that the person concerned will be subjected to violence if he complies: *Coca Cola Co v Gilbey* [1996] FSR 23, CA.

5 See *Universal City Studios Inc v Mukhtar & Sons* [1976] 2 All ER 330, [1976] 1 WLR 568.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/F. INTERIM AND SUMMARY REMEDIES/453. Disclosure of names of infringers.

#### **453. Disclosure of names of infringers.**

By interim procedures<sup>1</sup>, a claimant can compel a defendant, and also an innocent person who, through no fault of his own and whether voluntarily or not, has become mixed up in wrongful conduct, to give disclosure of the name of the infringer or other wrongdoers<sup>2</sup>; where a defendant is himself the primary alleged wrongdoer, disclosure of his customers' names may be given at the interim stage<sup>3</sup>, but this is unlikely in cases where liability is in doubt<sup>4</sup>. Such disclosure is, however, routinely given in cases of counterfeiting, and may be given without notice<sup>5</sup>. The claimant will normally have to pay the costs of the innocent person, but can recover them from the wrongdoer<sup>6</sup>.

Where the purpose of the application for disclosure is to enable the claimant to discover the name of the infringer, it is not necessary to seek the leave of the court to use the information obtained for that purpose<sup>7</sup>. If, however, the claimant wishes to use the information obtained for some other purpose, for example to take proceedings abroad, then he may need the leave of the court<sup>8</sup>.

1 See *RCA Corpn v Reddingtons Rare Records* [1975] 1 All ER 38, [1974] 1 WLR 1445, [1975] RPC 95.

2 See *Norwich Pharmacal Co v Customs and Excise Comrs* [1974] AC 133, [1973] 2 All ER 943, [1974] RPC 101, HL; *X Ltd v Morgan Grampian (Publishers) Ltd* [1991] 1 AC 1, [1990] 2 All ER 1, HL; *Ashworth Hospital Authority v MGN Ltd* [2002] UKHL 29, [2002] 4 All ER 193, HL; *Interbrew SA v Financial Times Ltd* [2002] EWCA Civ 274, [2002] 2 Lloyd's Rep 229, CA. Disclosure may also be obtained of the identities of persons who are not wrongdoers: *CHC Software Care Ltd v Hopkins & Wood* [1993] FSR 241; *P v T* [1997] 4 All ER 200, [1997] 1 WLR 1309. As to the availability of the remedy of interim disclosure see CPR 25.1(1)(i), (j); and CIVIL PROCEDURE vol 11 (2009) PARA 315. As to the principles of applying for disclosure before proceedings have commenced, or against a person who is not party to proceedings, see CPR 31.16-18; and CIVIL PROCEDURE vol 11 (2009) PARAS 112, 550.

3 See *Intelsec Systems Ltd v Grech-Cini* [1999] 4 All ER 11, [2000] 1 WLR 1190.

4 *Freedman v Hillingdon Shirts Co Ltd* [1975] FSR 449.

5 See *EMI Ltd v Sarwar and Haidar* [1977] FSR 146, CA (where the order for discovery was given in conjunction with an Anton Piller order (as to which see PARA 452 ante)). As to the making of applications without notice see PARA 451 text and note 1 ante.

6 *Totalise plc v The Motley Fool Ltd* [2001] EWCA Civ 1897, [2003] 2 All ER 972, [2002] 1 WLR 1233.

7 *Sony Corpn v Anand* [1981] FSR 398; *Roberts v Jump Knitwear Ltd* [1981] FSR 527.

8 See eg *Crest Homes plc v Marks* [1987] AC 829, [1987] 2 All ER 1074, HL; and CIVIL PROCEDURE vol 11 (2009) PARAS 402, 404.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/F. INTERIM AND SUMMARY REMEDIES/454. Protective injunction against non-infringer.

#### **454. Protective injunction against non-infringer.**

If a person has in his possession or control goods the dissemination of which, whether in the way of trade or, possibly, merely by way of gifts<sup>1</sup>, will infringe another's trade mark<sup>2</sup>, then, as soon as he is aware of this fact, he becomes subject to an equitable duty not to allow those goods to pass out of his possession or control, at any rate in circumstances in which the proprietor of the mark might be injured by an ensuing infringement. The person having the goods in his possession or control must not aid the infringement by letting the goods get into the hands of those who may use them or deal with them in a way which will invade the proprietor's rights, as, even though by doing so he might not himself infringe the trade mark, he would be in dereliction of his duty to the proprietor. This duty is one which will, if necessary, be enforced in equity by way of injunction<sup>3</sup>.

The claimant will normally have to pay the costs of the innocent person, but can recover them from the wrongdoer<sup>4</sup>. This kind of injunction may be especially useful in putting a stop to infringement while the true infringer is located or identified.

1 See *Upmann v Forester* (1883) 24 ChD 231.

2 Or, it would seem, result in passing off, at least where the goods constitute instruments of deception: see PARA 331 ante.

3 See *Norwich Pharmacal Co v Customs and Excise Comrs* [1974] AC 133 at 146, [1972] 3 All ER 813 at 823, [1972] RPC 743 at 771, CA, per Buckley LJ; *revsd* on other grounds [1974] AC 133, [1973] 2 All ER 943, [1974] RPC 101, HL.

4 *Smith Kline and French Laboratories Ltd v RD Harbottle (Mercantile) Ltd* [1980] RPC 363; *Morton-Norwich Products Inc v Intercen Ltd (No 2)* [1981] FSR 337; cf *Miller Brewing Co v Mersey Docks and Harbour Co* [2003] EWHC 1606 (Ch), [2004] IP & T 542, [2004] FSR 81.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/F. INTERIM AND SUMMARY REMEDIES/455. Freezing injunctions.

#### **455. Freezing injunctions.**

In certain circumstances the court may grant an injunction, on application without notice<sup>1</sup>, restraining the defendant from removing his assets from the jurisdiction or otherwise dealing with them in such a way that they would no longer be available to satisfy the claimant's judgment<sup>2</sup>. Such an injunction may be of particular importance in cases of counterfeiting, where defendants seldom voluntarily pay damages. A freezing injunction is often sought together with a search order<sup>3</sup> and a disclosure order<sup>4</sup>.

1 As to the making of applications without notice see PARA 451 text and note 1 ante.

2 CPR 25.1(1)(f). Such injunctions are known as 'freezing injunctions'; they were formerly known as 'Mareva' injunctions, after *Mareva Compania Naviera SA v International Bulkcarriers SA, The Mareva* [1980] 1 All ER 213n, CA, but now fall within the scope of CPR Pt 25. A party may also be directed to provide information about relevant property or assets which are or may be the subject of an application for a freezing injunction: CPR 25.1(1)(g). For forms of the freezing injunction see *Practice Direction--Interim Injunctions* PD25.

3 As to search orders see PARA 452 ante.

4 As to disclosure orders see PARA 453 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(5) ACTIONS FOR INFRINGEMENT AND PASSING OFF/(v) Relief/F. INTERIM AND SUMMARY REMEDIES/456. Summary judgment.

#### **456. Summary judgment.**

Summary judgment is available in cases involving passing off and infringement of a registered trade mark in accordance with general principles<sup>1</sup>. In general it will be easier to show that there is no real prospect of success in a case of infringement than in a case of passing off, as in most infringement cases the claimant's title will be effectively beyond challenge and there may be little dispute about the nature of the defendant's acts<sup>2</sup>.

<sup>1</sup> See CPR Pt 24; and CIVIL PROCEDURE vol 11 (2009) PARA 524 et seq.

<sup>2</sup> See *Sony Corpn v Anand (No 2)* [1982] FSR 200 (where the plaintiff was content to take an inquiry as to damages for infringement, leaving his other monetary claims (for passing off and infringement of copyright) until after the trial of the main action). For an example of summary judgment in a trade mark case see *Origin Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280; but see *Bolton Pharmaceutical Co 100 Ltd v Doncaster Pharmaceuticals Group Ltd* [2006] EWCA Civ 661, [2006] All ER (D) 289 (May), sub nom *Doncaster Pharmaceuticals Group Ltd v Bolton Pharmaceutical Co 100 Ltd* [2007] FSR 63 (summary judgment must be confined to appropriate cases).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(6) OTHER COURT CLAIMS/(i) Claims for a Declaration of Non-infringement and in Respect of Groundless Threats/457. In general.

## **(6) OTHER COURT CLAIMS**

### **(i) Claims for a Declaration of Non-infringement and in Respect of Groundless Threats**

#### **457. In general.**

A claim may be brought for a declaration of non-infringement of a registered trade mark under the court's inherent jurisdiction where the defendant has asserted a contrary right or formulated an adverse claim<sup>1</sup>. There are no special procedural rules applicable to such claims, which are essentially claims for infringement in reverse<sup>2</sup>.

A claim may also be brought in relation to groundless threats of infringement proceedings seeking a declaration that the threats are unjustifiable, an injunction against the continuance of the threats, and damages in respect of any loss sustained as a result of the threats<sup>3</sup>. There are no special procedural rules applicable to such claims<sup>4</sup>.

1 See *L'Oréal (UK) Ltd v Johnson & Johnson* [2000] FSR 686, [2000] All ER (D) 290.

2 Since the burden of proof is on the claimant, however, the claimant may fail for want of proof that his acts do not infringe: see *Point Solutions Ltd v Focus Business Solutions Ltd* [2007] EWCA Civ 14, [2007] All ER (D) 160 (Jan) (a copyright case).

3 I.e. under the Trade Marks Act 1994 s 21: see PARAS 123-125 ante.

4 Note, however, that once the claimant proves a threat, the burden of justifying that threat by showing that the claimant has or would infringe falls on the defendant: see *ibid* s 21(3); and PARA 124 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(6) OTHER COURT CLAIMS/(ii) Claims for Revocation, Declaration of Invalidity and Rectification/458. In general.

## **(ii) Claims for Revocation, Declaration of Invalidity and Rectification**

### **458. In general.**

An application for revocation, for a declaration of invalidity or for rectification of the register<sup>1</sup> in relation to a United Kingdom registered trade mark, or an application for revocation or a declaration of invalidity of the protection of a protected international trade mark (UK)<sup>2</sup>, may be made to the court<sup>3</sup> by any person<sup>4</sup>. A claim form relating to such a claim may be served on the proprietor<sup>5</sup>:

553 (1) at the address for service<sup>6</sup> given in the United Kingdom register, provided that the address is within the jurisdiction<sup>7</sup>; or

554 (2) in accordance with the relevant rules<sup>8</sup> at the address for service given in the United Kingdom register or the register of the Office for Harmonisation in the Internal Market<sup>9</sup>.

Where a claim is made for the rectification<sup>10</sup> of the register, the claimant must at the same time as serving the other parties serve a copy of the claim form and any accompanying documents on the registrar<sup>11</sup>.

The normal rules as to disclosure and evidence apply to claims for revocation, declarations of invalidity and rectification.

Where an order of the court affects the validity of an entry in the register, the court and the party in whose favour the order is made must serve a copy of the order on the registrar within 14 days<sup>12</sup>. Where the order is made in favour of more than one party, a copy must be served on such party as the court directs<sup>13</sup>.

1 As to these applications and the circumstances in which they are appropriate see PARAS 114-121 ante; as to the additional grounds for revocation or of invalidity of a collective mark see PARAS 163-164 ante; and as to the additional grounds for revocation or invalidity of a certification mark see PARAS 174-175 ante.

2 See the Trade Marks (International Registration) Order 1996, SI 1996/714, art 13; and PARAS 114-117, 119, 396 ante. For the meaning of 'protected international trade mark (UK)' see PARA 13 ante.

3 For the meaning of 'the court' see PARA 349 ante.

4 Trade Marks Act 1994 s 46(4) (revocation), s 47(3) (declaration of invalidity), s 64(2) (rectification). Except in certain circumstances, the applicant may also bring the claim before the registrar: see PARA 396 ante. As from 1 October 2007, so much of s 47(3) as provides that any person may make an application for a declaration of invalidity has effect subject to the Trade Marks (Relative Grounds) Order 2007, SI 2007/1976, art 5 (not yet in force (see PARA 119, note 5, 8 ante): art 5(3) (not yet in force). As to the meaning of 'any person' see PARA 396 note 3 ante.

5 For the meaning of 'proprietor' see PARA 22 note 8 ante.

6 As to the provision of an address for service see PARA 357 ante.

7 CPR 63.16(2)(a).

8 I.e. CPR 6.19(1) or CPR 6.19(1A).

9 CPR 63.16(2)(b).

10 Although the rule only refers to 'rectification', it would seem that it should apply to claims for revocation or a declaration of invalidity as well.

11 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 23.1. As to the registrar's appearance in such proceedings see PARA 460 post. As to the registrar see PARA 17 ante.

12 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 22.1, applying para 15.1

13 *Practice Direction--Patents and Other Intellectual Property Claims* PD63 para 22.1, applying para 15.2.

## **UPDATE**

### **458 In general**

NOTE 2--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

NOTE 8--CPR Pt 6 substituted by SI 2008/2178.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(6) OTHER COURT CLAIMS/(ii) Claims for Revocation, Declaration of Invalidity and Rectification/459. Registrar's power to apply for declaration of invalidity.

**459. Registrar's power to apply for declaration of invalidity.**

In the case of bad faith in the registration of a trade mark<sup>1</sup>, the registrar<sup>2</sup> may himself apply to the court<sup>3</sup> for a declaration of invalidity of the registration<sup>4</sup>.

1 As to the requirements for registration see PARA 55 et seq ante; and as to the procedure on the application see PARA 352 et seq ante. As to the meaning of 'trade mark' see PARA 57 ante.

2 As to the registrar see PARA 17 ante.

3 For the meaning of 'the court' see PARA 349 ante.

4 Trade Marks Act 1994 s 47(4). There seems to be no express power of the registrar to apply for rectification in relation to other matters affecting the register. Under the Trade Marks Act 1938 s 32(3) (repealed) the registrar's power to apply in case of fraud extended not only to registration but also to assignment and transmission. For the meaning of 'registration' see PARA 19 note 2 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(6) OTHER COURT CLAIMS/(ii) Claims for Revocation, Declaration of Invalidity and Rectification/460. Registrar's appearance in proceedings involving the register.

**460. Registrar's appearance in proceedings involving the register.**

In proceedings before the court<sup>1</sup> involving an application for:

- 555 (1) the revocation of the registration of a trade mark<sup>2</sup>;
- 556 (2) a declaration of the invalidity of the registration of a trade mark<sup>3</sup>; or
- 557 (3) the rectification of the register<sup>4</sup>,

the registrar<sup>5</sup> is entitled to appear and be heard, and must appear if so directed by the court<sup>6</sup>.

Unless otherwise directed by the court, the registrar may instead of appearing submit to the court a statement in writing signed by him, giving particulars of:

- 558 (a) any proceedings before him in relation to the matter in issue;
- 559 (b) the grounds of any decision given by him affecting it;
- 560 (c) the practice of the Patent Office<sup>7</sup> in like cases; or
- 561 (d) such matters relevant to the issues and within his knowledge as registrar as he thinks fit,

and the statement is deemed to form part of the evidence in the proceedings<sup>8</sup>.

Anything which the registrar is or may be authorised or required to do under the above provisions may be done on his behalf by a duly authorised officer<sup>9</sup>.

1 For the meaning of 'the court' see PARA 349 ante.

2 As to the revocation of the registration of a trade mark see PARAS 114 et seq, 396 et seq ante; as to the additional grounds for revocation of a collective mark see PARA 163 ante; and as to the additional grounds for revocation of a certification mark see PARA 174 ante.

3 As to the invalidity of the registration of a trade mark see PARAS 118 et seq, 396 et seq ante; as to the additional ground of invalidity of a collective mark see PARA 164 ante; and as to the additional ground of invalidity of a certification mark see PARA 175 ante.

4 As to rectification of the register see PARAS 121, 396 et seq ante.

5 As to the registrar see PARA 17 ante.

6 Trade Marks Act 1994 s 74(1).

7 As to the Patent Office, its organisation and seal see PARA 14 note 2 ante; and PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARAS 579-580. Note that the Patent Office is now operating under the name 'the UK Intellectual Property Office' ('UK-IPO'): see the UK Intellectual Property Office Name Change Fact Sheet.

8 Trade Marks Act 1994 s 74(2).

9 Ibid s 74(3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(6) OTHER COURT CLAIMS/(iii) Claims for Delivery Up and Disposal/461. Statutory power to order delivery up of infringing goods etc.

### **(iii) Claims for Delivery Up and Disposal**

#### **461. Statutory power to order delivery up of infringing goods etc.**

The proprietor of a registered trade mark<sup>1</sup> may apply to the court<sup>2</sup> for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods<sup>3</sup>, material<sup>4</sup> or articles<sup>5</sup> which a person has in his possession, custody or control in the course of a business<sup>6</sup>. An application may not, however, be made after the end of the period after which the remedy of delivery up is not available<sup>7</sup>; and no order may be made unless the court also makes, or it appears to the court that there are grounds for making, an order<sup>8</sup> as to the disposal of infringing goods etc<sup>9</sup>.

A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under these provisions<sup>10</sup> must, if an order as to the disposal of infringing goods etc<sup>11</sup> is not made, retain them pending the making of such an order, or the decision not to make such an order<sup>12</sup>.

Nothing in the above provisions affects any other power of the court<sup>13</sup>.

1 For the meaning of references to the proprietor of a registered trade mark in the provisions relating to infringement see the Trade Marks Act 1994 s 31(1), (2); and PARA 419 text and note 5 ante. As to the meaning of 'registered trade mark' see PARA 127 ante. These provisions equally apply to protected international trade marks (UK): see the Trade Marks (International Registration) Order 1996, SI 1996/714, art 17; and PARA 140 ante.

2 For the meaning of 'the court' see PARA 349 ante.

3 For the meaning of 'infringing goods' see PARA 150 ante.

4 For the meaning of 'infringing material' see PARA 150 ante.

5 For the meaning of 'infringing articles' see PARA 150 ante.

6 Trade Marks Act 1994 s 16(1). For the meaning of 'business' see PARA 32 note 3 ante. As to the period after which the remedy of delivery up is not available see PARA 462 post; and as to disposal of infringing goods etc see PARA 463 post. The proprietor of a registered trade mark must notify any exclusive licensee before applying for an order under s 16: see s 31(7); and PARA 419 ante.

Section 16 applies to infringing goods, material or articles whether made before, on or after 31 October 1994: s 105, Sch 3 para 5.

There is no specific requirement in s 16(1) that the person against whom an application is made is an infringer. It is possession, custody or control of infringing goods in the course of a business which suffices. Thus a carrier or warehouseman, for example, could be made the subject of an application under s 16. An application under s 16 may be made at the same time as an application under s 19 (as amended) (see PARA 463 post): *Miller Brewing Co v Mersey Docks and Harbour Co* [2003] EWHC 1606 (Ch), [2004] IP & T 542, [2004] FSR 81.

7 Ie the end of the period specified in the Trade Marks Act 1994 s 18: see PARA 462 post.

8 Ie an order under *ibid* s 19 (as amended): see PARA 463 post.

9 *Ibid* s 16(2). See also note 6 *supra*.

10 Ie an order under *ibid* s 16.



- 11 See note 8 supra.
- 12 Trade Marks Act 1994 s 16(3). See also note 6 supra.
- 13 Ibid s 16(4). See also note 6 supra.

## **UPDATE**

### **461 Statutory power to order delivery up of infringing goods etc**

NOTE 1--SI 1996/714 replaced: Trade Marks (International Registration) Order 2008, SI 2008/2206.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(6) OTHER COURT CLAIMS/(iii) Claims for Delivery Up and Disposal/462. Period after which statutory remedy of delivery up not available.

**462. Period after which statutory remedy of delivery up not available.**

An application for an order for delivery up of infringing goods, material or articles<sup>1</sup> may not be made after the end of the period of six years from:

- 562 (1) in the case of infringing goods<sup>2</sup>, the date on which the trade mark<sup>3</sup> was applied to the goods or their packaging<sup>4</sup>;
- 563 (2) in the case of infringing material<sup>5</sup>, the date on which the trade mark was applied to the material<sup>6</sup>; or
- 564 (3) in the case of infringing articles<sup>7</sup>, the date on which they were made<sup>8</sup>,

except as mentioned in the provisions described below<sup>9</sup>.

If during the whole or part of that period the proprietor of the registered trade mark<sup>10</sup> is under a disability<sup>11</sup> or is prevented by fraud or concealment from discovering the facts entitling him to apply for an order, an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts<sup>12</sup>.

1    le an order under the Trade Marks Act 1994 s 16: see PARA 461 ante.

2    For the meaning of 'infringing goods' see PARA 150 ante.

3    As to the meaning of 'trade mark' see PARA 57 ante.

4    Trade Marks Act 1994 s 18(1)(a).

5    For the meaning of 'infringing material' see PARA 150 ante.

6    Trade Marks Act 1994 s 18(1)(b).

7    For the meaning of 'infringing articles' see PARA 150 ante.

8    Trade Marks Act 1994 s 18(1)(c).

9    Ibid s 18(1). See the text to notes 10-12 infra. As to disposal of infringing goods etc see PARA 463 post.

10   For the meaning of references to the proprietor of a registered trade mark in the provisions relating to infringement see ibid s 31(1), (2); and PARA 419 note 5 ante. As to the meaning of 'registered trade mark' see PARA 127 ante.

11   For these purposes, 'disability' has the same meaning as in the Limitation Act 1980 (see s 38(2)-(4) (as amended)); and LIMITATION PERIODS vol 68 (2008) PARA 1170; Trade Marks Act 1994 s 18(3).

12   Ibid s 18(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/5. PROCEDURE RELATING TO TRADE MARKS AND PASSING OFF/(6) OTHER COURT CLAIMS/(iii) Claims for Delivery Up and Disposal/463. Order as to disposal of infringing goods etc.

#### **463. Order as to disposal of infringing goods etc.**

Where infringing goods<sup>1</sup>, material<sup>2</sup> or articles<sup>3</sup> have been delivered up in pursuance of an order for delivery up<sup>4</sup>, an application may be made to the court<sup>5</sup>:

565 (1) for an order that they be destroyed or forfeited to such person as the court may think fit<sup>6</sup>; or

566 (2) for a decision that no such order should be made<sup>7</sup>.

In considering what order, if any, should be made, the court must consider whether other remedies available in an action for infringement<sup>8</sup> of the registered trade mark<sup>9</sup> would be adequate to compensate the proprietor<sup>10</sup> and any licensee<sup>11</sup> and protect their interests<sup>12</sup>.

Provision must be made by rules of court as to the service of notice on persons having an interest in the goods, material or articles<sup>13</sup>, and any such person is entitled:

567 (a) to appear in proceedings for a disposal order, whether or not he was served with notice; and

568 (b) to appeal against any order made, whether or not he appeared,

and an order does not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal<sup>14</sup>.

Where there is more than one person interested in the goods, material or articles, the court must make such order as it thinks just<sup>15</sup>.

If the court decides that no disposal order should be made, the person in whose possession, custody or control the goods, material or articles were before being delivered up is entitled to their return<sup>16</sup>.

1 For the meaning of 'infringing goods' see PARA 150 ante.

2 For the meaning of 'infringing material' see PARA 150 ante.

3 For the meaning of 'infringing articles' see PARA 150 ante.

4 I.e. an order under the Trade Marks Act 1994 s 16: see PARA 461 ante.

5 Ibid s 19(1). For the meaning of 'the court' see PARA 349 ante.

6 Ibid s 19(1)(a).

7 Ibid s 19(1)(b).

8 For the meaning of 'infringement' see PARA 84 note 4 ante. As to the acts which amount to infringement, if done without the consent of the proprietor, see ibid s 10; and PARA 86 et seq ante.

9 As to the meaning of 'registered trade mark' see PARA 127 ante.

10 For the meaning of references to the proprietor of a registered trade mark in the provisions relating to infringement see the Trade Marks Act 1994 s 31(1), (2); and PARA 419 text and note 5 ante.

11 For the meaning of 'licensee' see PARA 136 note 7 ante. As to licences see PARAS 136-137 ante.

12 Trade Marks Act 1994 s 19(2). Section 19(2) applies in relation to an authorised user of a registered collective mark or a registered certification mark as in relation to a licensee of a trade mark: see ss 49(2), 50(2), Sch 1 para 11(b), Sch 2 para 13(b); and PARAS 162, 173 ante.

13 For these purposes, references to a person having an interest in goods, material or articles include any person in whose favour an order could be made under *ibid* s 19; the Registered Designs Act 1949 s 24D (as added) (see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 767); the Copyright, Designs and Patents Act 1988 s 114, s 204 or s 231 (all as amended) (see COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARAS 422, 535, 713); or the Community Designs Regulations 2005, SI 2005/2339, reg 1C (as added) (see PATENTS AND REGISTERED DESIGNS vol 79 (2008) PARA 779); Trade Marks Act 1994 s 19(6) (amended by the Intellectual Property (Enforcement etc) Regulations 2006, SI 2006/1028, art 2(2), Sch 2 para 16).

14 Trade Marks Act 1994 s 19(3). At the date at which this volume states the law neither CPR Pt 63 nor *Practice Direction--Patents and Other Intellectual Property Claims* PD63 contains any such rules, although para 26.1 contains rules relating to the corresponding provisions under the Copyright, Designs and Patents Act 1988. It appears that this is an oversight.

15 Trade Marks Act 1994 s 19(4).

16 *Ibid* s 19(5).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(i) The Legislation/464. History.

## 6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES

### (1) HALLMARKING

#### (i) The Legislation

##### 464. History.

From a very early date the standard and marking of gold and silver plate have been enforced by statute<sup>1</sup>. In 1300 it was ordained that no goldsmith of England or in the King's dominion should make any vessel, jewel or anything of gold or silver except of a certain alloy<sup>2</sup> and should not part with possession until it was assayed and marked by the wardens of the goldsmith craft in London<sup>3</sup>. The marks commonly known as hallmarks consist of the maker's or sponsor's mark and the assay marks denoting the standard, place and year of assay<sup>4</sup>.

1 The earliest statute is an ordinance of 22 Hen 3 ('De auro fabricando in Civitate Londoniarum') (1238): see the *Report of the Departmental Committee on Hallmarking* (Cmnd 663) (1959) PARA 22.

2 The ordinance 28 Edw 1 c 20 (Vessels of gold, assaying etc) (1300) (repealed) laid down 'the touch of Paris' (ie 19½ carats) as the standard for gold, and the sterling standard (ie 925 parts per 1,000) as the standard for silver. For a summary of the history of the legislation of hallmarking see the *Report of the Departmental Committee on Hallmarking* (Cmnd 663) (1959) PARA 20 et seq. See also *Westwood v Cann*[1952] 2 QB 887, [1952] 2 All ER 349, CA.

3 See 28 Edw 1 c 20 (Vessels of gold, assaying etc) (1300) (repealed).

4 See the *Report of the Departmental Committee on Hallmarking* (Cmnd 663) (1959) PARAS 104-110. As to sponsor's marks see PARA 478 post; and as to assay marks see PARA 468 note 11 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(i) The Legislation/465. Current legislation.

#### 465. Current legislation.

Following the *Report of the Departmental Committee on Hallmarking*<sup>1</sup> the substantial body of old statutes concerned with hallmarking were repealed and replaced by a new code contained in the Hallmarking Act 1973. That Act and the orders made under it form the current legislation<sup>2</sup>. That Act expressly relates only to the hallmarking of articles of gold, silver or platinum<sup>3</sup>; but the Secretary of State<sup>4</sup> may at any time by order, either on the application of the British Hallmarking Council or, if the Secretary of State thinks fit, of his own volition after consultation with the Council, apply the provisions of that Act (or such of them as may be specified in any such order) to any other metal than gold, silver and platinum and subject to such amendments and adaptations as may be specified in the order<sup>5</sup>.

A number of the enforcement provisions of the Trade Descriptions Act 1968<sup>6</sup> are applied in relation to the enforcement of the Hallmarking Act 1973<sup>7</sup>. In addition the Hallmarking Act 1973 may be enforced under the Enterprise Act 2002<sup>8</sup> in certain circumstances<sup>8</sup>.

Any local statutory provision<sup>9</sup> which was inconsistent with any provision of the Hallmarking Act 1973 ceased to have effect<sup>10</sup>.

1    le the *Report of the Departmental Committee on Hallmarking* (Cmd 663) (1959).

2    The Hallmarking Act 1973 came into operation on 1 January 1975 except for s 13, Sch 4 (as amended) (see PARA 483 post) which came into operation on 1 January 1974: s 24(2).

3    For the definition of 'precious metal' see *ibid* s 22(1); and PARA 468 note 8 post.

4    As to the Secretary of State see PARA 14 ante.

The Secretary of State may cause a local inquiry to be held in connection with the discharge of any of his functions under the Hallmarking Act 1973 or in any case where it appears to him to be expedient to do so in connection with any matter arising under that Act or any of the functions of assay offices or the British Hallmarking Council: ss 20(1), 22(1). In relation to any inquiry so held the provisions of the Local Government Act 1972 s 250(2)-(5) (as amended) (evidence and costs at local inquiries: see LOCAL GOVERNMENT vol 69 (2009) PARA 105) apply as if the inquiry were held in pursuance of s 250(1) save that s 250(4) (as amended) (costs of department) applies only in a case where the Secretary of State so directs: Hallmarking Act 1973 s 20(1)(a). The person appointed to hold such an inquiry must report the results thereof in writing to the Secretary of State, who must publish the report together with such observations, if any, as he thinks fit to make thereon: s 20(2). For these purposes, 'functions' includes powers and duties: s 22(1). For the meaning of 'assay office' see PARA 469 post; and as to the British Hallmarking Council see PARAS 482-484 post.

A local inquiry held under s 20(1) is designated for the purposes of the Tribunals and Inquiries Act 1992 s 16(2) (see ADMINISTRATIVE LAW vol 1(1) (2001 Reissue) PARA 15): see the Tribunals and Inquiries (Discretionary Inquiries) Order 1975, SI 1975/1379, art 3, Schedule Pt II para 104.

5    Hallmarking Act 1973 s 17(1). Any such order may contain such incidental, consequential and supplementary provisions as the Secretary of State thinks necessary or expedient for the purposes of the order, including provisions applying, extending, excluding or amending, or repealing or revoking, with or without savings, any provisions of the Hallmarking Act 1973 or an instrument thereunder: s 17(2). As to the making of orders generally see PARA 466 post. At the date at which this volume states the law no such order had been made.

6    As to the Trade Descriptions Act 1968 generally see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 471 et seq.

7    See the Hallmarking Act 1973 s 9; and PARA 485 post.

8     le the Enterprise Act 2002 Pt 8 (ss 210-236): see COMPETITION vol 18 (2009) PARA 339 et seq.

9     See PARA 485 post.

10    For these purposes, 'local statutory provision' means a provision of a local Act, including an Act confirming a provisional order, or a provision of a public general Act passed with respect only to any particular locality, or a provision of an instrument made under any such local or public general Act or of an instrument in the nature of a local enactment made under any other Act, or a provision of a charter or franchise: Hallmarking Act 1973 s 22(1).

11    Ibid s 18(1). The Secretary of State may on the application of an assay office or, if he thinks fit, of his own volition, but in either case subject to the provisions of s 18, by order repeal or amend any local statutory provision where it appears to him that that provision is inconsistent with, or has become unnecessary in consequence of, any provision of the Hallmarking Act 1973: s 18(2). Before making such an order the Secretary of State must consult with any person or body representative of persons who appear to him to be concerned: s 18(3). Such an order may contain such transitional, supplemental or incidental provisions as appear to the Secretary of State to be expedient: s 18(4). At the date at which this volume states the law no such order had been made.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(i) The Legislation/466. Making of regulations and orders.

#### **466. Making of regulations and orders.**

The Secretary of State<sup>1</sup> may make regulations under the Hallmarking Act 1973 for any purpose for which regulations are authorised or required to be made by him under that Act<sup>2</sup>. Any such power to make regulations is exercisable by statutory instrument, and any instrument containing any such regulations is subject to annulment in pursuance of a resolution of either House of Parliament<sup>3</sup>.

Any power conferred by the Hallmarking Act 1973 to make an order includes a power to vary or revoke the order by a subsequent order<sup>4</sup>. Any such power to make orders is exercisable by statutory instrument<sup>5</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 Hallmarking Act 1973 s 21(1).

3 Ibid s 21(2).

4 Ibid s 21(3).

5 Ibid s 21(4). An order may not be made under s 16 (see PARA 470 post) unless a draft of the order has been approved by a resolution of each House of Parliament (s 21(5)); and any statutory instrument containing an order under s 14 (see PARA 483 post) is subject to annulment in pursuance of a resolution of either House of Parliament (s 21(6)).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/467. Prohibited descriptions of unhallmarked articles.

## (ii) Hallmarks and Assay Offices

### 467. Prohibited descriptions of unhallmarked articles.

Any person who, in the course of a trade or business<sup>1</sup>:

- 569 (1) applies<sup>2</sup> to an unhallmarked article<sup>3</sup> a description<sup>4</sup> indicating that it is wholly or partly made of gold, silver or platinum<sup>5</sup>; or
- 570 (2) supplies, or offers to supply<sup>6</sup>, an unhallmarked article to which such a description is applied<sup>7</sup>,

is guilty of an offence<sup>8</sup> unless, in the case of a description, it is a permitted description<sup>9</sup> or, in the case of an article, it is exempt<sup>10</sup>.

In any proceedings for such an offence it is a defence for the person charged to prove that, in reliance on information supplied by another person, he believed that the article concerned was one which was exempt from hallmarking<sup>11</sup> and that he could not with reasonable diligence have ascertained that it was not such an article<sup>12</sup>.

1 'In the course of trade or business' is defined neither in the Hallmarking Act 1973 nor in the Trade Descriptions Act 1968 to which many of the provisions of the Hallmarking Act 1973 refer. Cf the Fair Trading Act 1973 s 137(2) ('business' includes a professional practice and includes any other undertaking which is carried on for gain or reward or which is an undertaking in the course of which goods or services are supplied otherwise than free of charge: COMPETITION vol 18 (2009) PARA 314). Clearly the trade or business need not be retail, nor need the offender's trade or business be that of conducting the particular transaction concerned: *Haverling London Borough Council v Stevenson*[1970] 3 All ER 609, [1970] 1 WLR 1375, DC (car hire firm selling its used cars held to be doing so in the course of its trade or business as a car hire firm); cf *Davies v Sumner*[1984] 1 WLR 405, DC (affd [1984] 3 All ER 831, [1984] 1 WLR 1301, HL) (false representation by a self-employed courier as to the mileage of a car sold by him held not to be a false trade description). The trade or business need not be full-time: cf *Stevenson v Beverley Bentinck Ltd*[1976] 2 All ER 606, [1976] 1 WLR 483, CA (meaning of 'private purchaser' in the Hire-Purchase Act 1964); *Re Griffin, ex p Board of Trade* (1890) 60 LJQB 235 at 237, CA, per Lord Esher MR; *Abernethie v AM and J Kleiman Ltd*[1970] 1 QB 10, [1969] 2 All ER 790, CA (meaning of 'business' in the Landlord and Tenant Act 1954 Pt II (ss 23-46) (as amended): see LANDLORD AND TENANT vol 27(2) (2006 Reissue) PARA 707). On the other hand some degree of regularity is required (*Davies v Sumner* supra); cf *R & B Customs Brokers Co Ltd v United Dominions Trust Ltd* [1988] 1 All ER 847, [1988] 1 WLR 321, CA (meaning of 'in the course of a business' in the Unfair Contract Terms Act 1977 s 12: see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 450); *Pensher Security Door Co Ltd v Sunderland City Council* [2000] RPC 249, CA (meaning of 'in the course of business' in the Copyright, Patents and Designs Act 1988 s 23: see COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 330); but see *Stevenson v Rogers* [1999] QB 1028, [1999] 1 All ER 613, CA ('in the course of business' in the Sale of Goods Act 1979 s 14(2) (see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 80) covered any sale by a business). The words cover the business of buying as well as that of selling (*Fletcher v Budgen*[1974] 2 All ER 1243, [1974] 1 WLR 1056, DC) and are to be treated as wide in scope (*Fletcher v Budgen* supra; and see *Fletcher v Sledmore* [1973] RTR 371, DC). They do not, however, cover cases where false trade descriptions are applied to goods otherwise than in association with a contract for the sale or supply of goods (*Wickens Motors (Gloucester) Ltd v Hall*[1972] 3 All ER 759, sub nom *Hall v Wickens Motors (Gloucester) Ltd* [1972] 1 WLR 1418, DC (false trade description applied well after sale held not to be applied in the course of a trade or business)), but it is not necessary that the description is applied by a directly contracting party (*Fletcher v Sledmore* supra).

2 The Trade Descriptions Act 1968 s 4 (meaning of 'applies' in relation to the applying of a trade description: see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 478) applies for the purposes of the Hallmarking Act 1973 s 1: s 1(7)(b). A trade description or statement published in any newspaper, book or periodical or in any film or sound or television broadcast or in any programme included in any programme service within the meaning of the Broadcasting Act 1990 (see TELECOMMUNICATIONS AND BROADCASTING vol 45(1)



(2005 Reissue) PARA 328), other than a sound or television broadcasting service is not deemed to be a description applied in the course of a trade or business unless it is or forms part of an advertisement: Trade Descriptions Act 1968 s 39(2) (amended by the Broadcasting Act 1990 s 203(1), Sch 20 para 11); applied by the Hallmarking Act 1973 s 1(9). 'Advertisement' includes a catalogue, a circular and a price list: s 1(7)(a). As to advertisements see also note 8 infra.

3 For the meaning of 'unhallmarked article' see PARA 474 post.

4 Where a description relates to the fineness of gold or silver, the Hallmarking Act 1973 s 1(6), Sch 1 Pt III (use of the words 'carats', 'sterling' and 'Britannia': see PARA 477 post) applies for construing that description: s 1(5). For the meaning of 'fineness' see PARA 468 note 9 post.

5 Ibid s 1(1)(a).

6 For these purposes, a person exposing articles for supply, or having articles in his possession for supply, 'offers to supply' them: ibid s 1(7)(c).

7 Ibid s 1(1)(b).

8 Ibid s 1(1). The offence under s 1(1)(b) (see head (2) in the text) does not require proof of mens rea: see *Chilvers v Rayner*[1984] 1 All ER 843, [1984] 1 WLR 328, DC. As to offences generally see PARA 486 post. The Secretary of State may by order: (1) prescribe any cases or circumstances in which the Hallmarking Act 1973 s 1(1) is, or is not, to apply; and (2) add to, amend or repeal all or any of the provisions of Sch 1 Pt I (paras 1, 2) (see PARA 475 post), Sch 1 Pt II (paras 1-18) (as amended) (see PARA 476 post) or Sch 1 Pt III (paras 1-3) (see PARA 477 post); and (3) make any consequential amendments in s 1: Sch 1 Pt IV para 1(1). Such an order may contain such supplemental or incidental provisions as appear to the Secretary of State to be expedient or necessary and is subject to annulment in pursuance of a resolution of either House of Parliament: Sch 1 Pt IV para 1(2). As to the orders made, and as to the articles thus exempted, see PARA 476 post; and as to the making of orders generally see PARA 466 ante. As to the Secretary of State see PARA 14 ante.

Where in an advertisement a description is used in relation to any class of articles, the description is to be taken as referring to all articles of the class, whether or not in existence at the time the advertisement is published: (1) for the purpose of determining whether an offence has been committed under s 1(1)(a) (see head (1) in the text); and (2) where articles of the class are supplied or offered to be supplied by a person publishing or displaying the advertisement, also for the purpose of determining whether an offence has been committed under s 1(1)(b) (see head (2) in the text): s 1(8)(a), (b). In determining whether any goods are of a class to which a trade description used in an advertisement relates, regard is to be had not only to the form and content of the advertisement but also to the time, place, manner and frequency of its publication and all other matters making it likely or unlikely that a person to whom the goods are supplied would think of the goods as belonging to the class in relation to which the trade description is used in the advertisement: Trade Descriptions Act 1968 s 5(3); applied by the Hallmarking Act 1973 s 1(8).

In proceedings for an offence under the Hallmarking Act 1973 committed by the publication of an advertisement, it is a defence for the person charged to prove that he is a person whose business it is to publish or arrange for the publication of advertisements and that he received the advertisement for publication in the ordinary course of business and did not know and had no reason to suspect that its publication would amount to an offence under that Act: s 8, Sch 3 para 5.

9 Ibid s 1(2). See Sch 1 Pt I; and PARA 475 post.

10 Ibid s 1(3). See Sch 1 Pt II (as amended); and PARA 476 post.

11 Ie by virtue of ibid Sch 1 Pt II (as amended): see PARA 476 post.

12 Ibid Sch 3 para 6.

## UPDATE

### 467 Prohibited descriptions of unhallmarked articles

NOTE 5--After 'platinum' read 'or palladium': Hallmarking Act 1973 s 1(1)(a) (amended by SI 2009/2040).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/468. Approved hallmarks.

#### **468. Approved hallmarks.**

'Approved hallmarks' means:

- 571 (1) marks struck by an assay office<sup>1</sup> in the United Kingdom<sup>2</sup>, whether before, on or after 1 January 1975, under the law for the time being in force<sup>3</sup>;
- 572 (2) marks struck by the Wardens and Commonalty of Goldsmiths of the City of Dublin before 1 April 1923<sup>4</sup>;
- 573 (3) convention hallmarks<sup>5</sup>; or
- 574 (4) EEA hallmarks<sup>6</sup>.

Subject to the relevant statutory provisions<sup>7</sup>, any article of precious metal<sup>8</sup> which is submitted to an assay office for hallmarking and which upon assay is found in all its parts to be of a standard of fineness<sup>9</sup> not less than the minimum fineness<sup>10</sup> for that precious metal must be struck by that assay office with the approved hallmarks<sup>11</sup>. Hallmarking is not permitted, however, unless the assay office is of opinion that the use of any solder or adhesive in the article is not excessive and that solder complies with the specified requirements<sup>12</sup>. An article comprised of more than one precious metal part must be struck with the approved hallmarks only if the assay office is of the opinion that a person will be able to determine, when the article is hallmarked, which part is made of which precious metal<sup>13</sup>.

If an assay office has refused to hallmark an article submitted to it for hallmarking and the person submitting the article has referred the matter to the British Hallmarking Council in writing, the Council must consider the case, and, if it is of the opinion that the assay office was acting unreasonably in refusing to hallmark the article, it must direct the assay office to strike the article with the approved hallmarks<sup>14</sup>.

After consulting the Council and such other persons as he thinks fit<sup>15</sup>, the Secretary of State may make regulations wholly or partly varying, supplementing or replacing the statutory provisions as to approved hallmarks and the procedures relating to them<sup>16</sup>.

Any dealer<sup>17</sup> must keep exhibited at all times, in a conspicuous position in a part of his premises to which those with whom he deals are commonly admitted, a notice in terms approved and in a form supplied by the Council describing such approved hallmarks and including such explanatory matter as the Council thinks fit<sup>18</sup>. It is an offence for any dealer to fail to exhibit or keep exhibited a notice required to be so exhibited<sup>19</sup>.

1 For the meaning of 'assay office' see PARA 469 post.

2 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

3 Hallmarking Act 1973 s 2(1)(a).

4 Ibid s 2(1)(b).

5 Ibid s 2(1)(c), (2). For the meaning of 'convention hallmarks' see PARA 472 post.

6 Ibid s 2(1)(d), (2) (s 2(1)(d) added, and s 2(2) amended, by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(2), (3)). For the meaning of 'EEA hallmarks' see PARA 473 post.

7 ie subject to the Hallmarking Act 1973 s 4, Sch 2 (as amended): see note 11 infra.

8 For these purposes, 'precious metal', in relation to any article, means gold, silver or platinum, or any other metal to which the provisions of the Hallmarking Act 1973 are applied by an order under s 17 (see PARA 465 ante): s 22(1).

9 For these purposes, 'fineness', in relation to any precious metal, means the number of parts by weight of that fine metal in 1,000 parts by weight of alloy: *ibid* s 22(1). 'Standard of fineness' means any one of the standards of fineness specified in Sch 2 Pt I para 2 col 2 (see note 11 *infra*); and reference to an article as being of one of those standards means that the article is of a fineness in all its parts of not less than that standard: s 22(1).

10 For these purposes, 'minimum fineness', in relation to any precious metal, means the lowest standard of fineness specified for a precious metal, namely for gold the standard of 375, for silver the standard of 800, and for platinum the standard of 850: *ibid* s 22(1) (definition amended by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(13)). See also PARA 477 post.

11 Hallmarking Act 1973 s 4(1). As respects articles comprised of a single precious metal, the marks to be struck are the assay office mark, the standard mark, the pictorial mark, the date letter and any additional mark directed under Sch 2 (as amended): see s 4(1)(a) (amended by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(7)).

The pictorial mark, the date letter and the optional additional mark may be struck only if a request to that effect is made by the person who submits the article to the assay office, but the absence of such mark does not in itself render the article unhallmarked: Hallmarking Act 1973 s 4(2) (substituted by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(8)). See also Case C-293/93 *Straffesag v Houtwipper* [1994] ECR I-4249, [1995] All ER (EC) 163, ECJ; and PARAS 473-474 post.

The details of these marks are set out in the Hallmarking Act 1973 Sch 2 Pt I (paras 1-5) (substituted by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(15)), and are as follows:

- 7 1 The assay office mark. This is a leopard's head for the London assay office; a castle for the Edinburgh assay office; an anchor for the Birmingham assay office; and a rose for the Sheffield assay office (see the Hallmarking Act 1973 Sch 2 Pt I para 1 (as so substituted)).
- 8 2 The standard mark. This depends on the standard of fineness and is: (a) in relation to gold: (i) 375 for a standard of fineness of 375; (ii) 585 for a standard of fineness of 585; (iii) 750 for a standard of fineness of 750; (iv) 916 for a standard of fineness of 916.6; (v) 990 for a standard of fineness of 990; and (vi) 999 for a standard of fineness of 999; (b) in relation to silver: (i) 800 for a standard of fineness of 800; (ii) 925 for a standard of fineness of 925; (iii) 958 for a standard of fineness of 958.4; and (iv) 999 for a standard of fineness of 999; and (c) in relation to platinum: (i) 925 for a standard of fineness of 925; (ii) 950 for a standard of fineness of 950; and (iii) 999 for a standard of fineness of 999 (see Sch 2 Pt I para 2 (as so substituted)).
- 9 3 The optional pictorial mark. This is: (a) a crown for gold with a standard of fineness of 375, 585, 750, 916.6, 990, or 999; (b) a lion passant or, in relation to the Edinburgh assay office, a lion rampant for silver with a standard of fineness of 925, 958.4 or 999; and (c) an orb surmounted by a cross for platinum with a standard of fineness of 950 or 999 (see Sch 2 Pt I para 3 (as so substituted)).
- 10 4 Optional date letter. Such distinct variable letter of the alphabet to denote the year in which the article is marked as may be for the time being directed in writing by the Council (Sch 2 Pt I para 4 (as so substituted)).
- 11 5 Optional additional mark. Such mark (if any) as may be for the time being directed in writing by the Council (Sch 2 Pt I para 5 (as so substituted)).

As respects articles comprised of two or more precious metals, marks are struck in accordance with Sch 2 Pt II (paras 6-15) (substituted by the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872, reg 2(1), (6), Schedule) (Hallmarking Act 1973 s 4(1)(b)); and as respects articles comprised of precious metal and other materials marks are struck in accordance with Sch 2 Pt III (paras 16-19) (substituted by the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872, reg 2(1), (6), Schedule) (Hallmarking Act 1973 s 4(1)(c)). As respects all such articles, marks must be struck in compliance with any directions given by the British Hallmarking Council pursuant to Sch 2 Pt IV para 20 (renumbered by the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872, reg 2(1), (7)) with respect to any shield or other border by which any approved hallmark is to be enclosed: Hallmarking Act 1973 s 4(1). As to the British Hallmarking Council see PARAS 482-484 post. For the meaning of 'assay office' see PARA 469 post.

12 Ibid s 4(3)(a), (b) (amended by the Hallmarking (Approved Hallmarks) Regulations 1986, SI 1986/1757, reg 2(b)). No article may be struck with the approved hallmarks unless: (1) except in a case where the assay office otherwise permits, any solder used in an article of: (a) gold, is gold of a fineness not less than the standard of fineness of the article, save that solder used in any article (i) of a standard of fineness of 916.6 or above may be of a fineness not less than 750; and (ii) of filigree work or being a watch case and in either case of a standard of fineness of 750 may be of a fineness not less than 740; and (iii) of white gold of a standard of fineness of not less than 585 and not more than 750 may be of a fineness not less than 500; (b) silver, is silver of a fineness not less than 650; (c) platinum, is gold, silver, platinum or palladium or a combination of two or more thereof and is of a fineness or, as the case may be, of a combined fineness not less than the standard of fineness of the article; and (2) solder of a fineness less than the standard of fineness of the article or adhesive is used in a quantity not more than is necessary for joining parts of the article and is not used for strengthening, weighting, filling or otherwise: Hallmarking Act 1973 s 4(3)(b) (amended by the Hallmarking (Approved Hallmarks) Regulations 1986, SI 1986/1757, reg 2(c), (d); and the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(9), (10)).

13 Hallmarking Act 1973 s 4(3A) (added by the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872, reg 2(1), (3)).

14 Hallmarking Act 1973 s 4(5). It is the duty of an assay office to which such a direction has been given to comply with the direction: s 4(6).

15 As to the holding of a local inquiry see PARA 465 note 4 ante.

16 Hallmarking Act 1973 s 4(7)(a). Upon the coming into operation of regulations so made the provisions of Sch 2 (as amended) (see note 11 supra), or such of them as may be specified in such regulations together with any regulations or directions made or given under those provisions, have effect as so varied or supplemented or, as the case may be, cease to have effect: s 4(7)(a).

Such regulations may contain such transitional, incidental, supplementary or consequential provision as the Secretary of State considers necessary or expedient for the purpose of the regulations, including provision applying, extending, excluding or amending, or repealing or revoking with or without savings, any provision of the Hallmarking Act 1973 or an instrument thereunder: s 4(7)(b). As to the making of regulations generally see PARA 466 ante. At the date at which this volume states the law the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, and the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872 (see the text and notes 1-13 supra) had been made. As to the Secretary of State see PARA 14 ante.

17 For these purposes, 'dealer' means a person engaged in the business of making, supplying, selling (including selling by auction) or exchanging articles of precious metal or in other dealings in such articles: Hallmarking Act 1973 s 22(1).

18 Ibid s 11(1). The Council may make a reasonable charge for the supply of any copy of a notice required to be exhibited: s 11(2).

19 Ibid s 11(1). As to offences see PARA 486 post.

## UPDATE

### 468 Approved hallmarks

NOTE 10--The minimum fineness for Palladium is of a standard of 500: Hallmarking Act 1973 s 22(1) (definition of 'minimum fineness') amended: SI 2009/2040.

NOTE 11--Heads (2), (3), as to palladium see the Hallmarking Act 1973 Sch 2 Pt I paras 2, 3, 13-15 (amended by SI 2009/2040).

NOTE 12--Hallmarking Act 1973 s 4(3)(b) further amended: SI 2009/2040.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/469. The assay offices.

#### **469. The assay offices.**

'Assay office' means each of the following bodies<sup>1</sup>:

- 575 (1) the Wardens and Commonalty of the Mystery of Goldsmiths of the City of London ('the London Assay Office');
- 576 (2) the Incorporation of Goldsmiths of the City of Edinburgh ('the Edinburgh Assay Office');
- 577 (3) the Guardians of the Standard of Wrought Plate in Birmingham ('the Birmingham Assay Office');
- 578 (4) the Guardians of the Standard of Wrought Plate within the town of Sheffield ('the Sheffield Assay Office'),

and any other body duly authorised under any enactment, order, charter or franchise<sup>2</sup> for the assaying and hallmarking of precious metals<sup>3</sup>.

The powers and duties of assay offices are prescribed by statute<sup>4</sup>.

Nothing contained in the Hallmarking Act 1973 renders any assay office liable as respects any damage caused by it to any article in the reasonable exercise or, as the case may be, discharge of any of the powers and duties conferred or imposed upon it by that Act<sup>5</sup>.

Her Majesty's Mint<sup>6</sup> may at any time and from time to time as thought fit in normal office hours visit any assay office for the purpose of inspecting the assay department of that office and of ascertaining and assessing the accuracy and efficiency of its methods and procedures of assay; and a report on the assay department of each assay office must be prepared once in every period of 14 months by the Queen's Assay Master and presented to the Deputy Master of Her Majesty's Mint, copies of such reports having first been sent to the British Hallmarking Council and the assay office concerned<sup>7</sup>.

Every assay office has power to make charges for assaying and hallmarking articles of precious metals not exceeding, in the case of articles manufactured in, or intended for sale or supply in, the United Kingdom<sup>8</sup>, such charges as are for the time being directed in writing by the British Hallmarking Council<sup>9</sup>.

It is the duty of an assay office to comply with directions and regulations issued by the British Hallmarking Council<sup>10</sup>.

1 Hallmarking Act 1973 s 22(1). References in the Hallmarking Act 1973 to an assay office include, as respects an assay office which is engaged in the business of an assay office and which carries on any other activity, reference to so much only of the undertaking of that assay office as relates wholly to its business as such an assay office and as may be certified in that behalf by that assay office: s 22(2).

2 This includes a body for the time being established under *ibid* s 16(1)(a) (see PARA 470 head (1) post) and also, where the context so admits, a body which, whilst it has been so authorised at any time before or after the passing of the Hallmarking Act 1973, has since being so authorised been dissolved or has ceased business in such assaying and hallmarking: s 22(1). For the meaning of 'precious metal' see PARA 468 note 8 ante.

3 *Ibid* s 22(1).

4 See the text and notes 5-10 *infra*; and PARAS 470-471 post.

5 Hallmarking Act 1973 s 15(2).

6 As to Her Majesty's Mint see FINANCIAL SERVICES AND INSTITUTIONS vol 49 (2008) PARA 1281.

7 Hallmarking Act 1973 s 15(1), Sch 5 para 3(1). If such assay methods, in the opinion of Her Majesty's Mint, are not of such a standard as will enable that assay office to report accurately on the fineness of any article, or articles, of precious metal, then Her Majesty's Mint must notify the British Hallmarking Council and the assay office forthwith and make to each of them such recommendations as appear requisite in relation to such assay methods; and the Council must consult with the assay office as to the action to be taken upon each such recommendation: Sch 5 para 3(2). Her Majesty's Mint is entitled to make a reasonable charge to each assay office in respect of the performance of its functions under Sch 5 para 3: Sch 5 para 3(3). For the meaning of 'fineness' see PARA 468 note 9 ante; and for the meaning of 'functions' see PARA 465 note 4 ante. As to the British Hallmarking Council see PARAS 482-484 post.

8 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

9 Hallmarking Act 1973 s 12(1). The Secretary of State may, however, from time to time give to the Council and to assay offices such directions as he considers expedient in relation to charges made under s 12(1): s 12(1) proviso. Subject to s 12(1), every assay office has power to make for services and facilities provided by it such charges as it from time to time thinks fit: s 12(2). As to the power of the Council to set maximum charges which may be made by assay offices see PARA 482 post. As to the Secretary of State see PARA 14 ante.

10 See *ibid* s 13(3); and PARA 482 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/470. Orders constituting, dissolving etc or conferring powers on assay offices.

**470. Orders constituting, dissolving etc or conferring powers on assay offices.**

The Secretary of State<sup>1</sup> may at any time by order<sup>2</sup>:

- 579 (1) on the application of the British Hallmarking Council<sup>3</sup>, provide for the constitution of an assay office<sup>4</sup> at such place as may be specified in the order<sup>5</sup>; or
- 580 (2) on the application of the Council, provide for the closure and dissolution of any assay office or its amalgamation with another assay office<sup>6</sup>; or
- 581 (3) on the application of the London Assay Office, confer, vary or abolish duties or powers imposed or conferred on the assay office under any local statutory provision affecting its undertaking, and for that purpose repeal or amend any such provision<sup>7</sup>;
- 582 (4) on the application of any of the Edinburgh, Birmingham or Sheffield Assay Offices vary or abolish duties or powers imposed or conferred on the assay office by any local statutory provision affecting its undertaking, and for that purpose repeal or amend any such provision or, on such an application, impose new duties on or confer new powers on, or make alterations or additions to or omissions from the constitution of, the assay office<sup>8</sup>.

Before making an application for an order under head (2) above, the applicants must consult the assay office on the subject of the proposed order and, if so requested by the assay office, must submit to the Secretary of State a draft of the proposed order and such written observations as the assay office may make to the applicants within the period of 42 days after being so consulted; and, following the submission of such a draft and observations, the applicants must take no further steps in connection with the proposed application pending a decision of the Secretary of State, who must give written notice to the applicants and the assay office either that he refuses to consider such an application or that it is (without prejudice, however, to subsequent refusal thereof) to be allowed to proceed<sup>9</sup>.

On application for any order under heads (1) to (4) above the applicants must submit to the Secretary of State a draft of the order which they desire him to make and must publish once at least in each of two successive weeks in one or more newspapers circulating in the locality wherein the assay office the subject of the order carries on or is intended to carry on business, as the case may be<sup>10</sup>, a notice:

- 583 (a) stating the general effect of the order<sup>11</sup>;
- 584 (b) specifying a place in that area where a copy of the draft order may be inspected by any person free of charge at all reasonable hours during a period of 28 days from the date of the first publication of the notice<sup>12</sup>; and
- 585 (c) stating that, within that period, any person may object to the application by notice to the Secretary of State<sup>13</sup>.

Not later than the date on which the notice is first published the applicants must, if the Secretary of State so requires, serve a copy of the notice and of the draft order on any person specified by the Secretary of State<sup>14</sup>.

The applicants must also publish in the Gazette<sup>15</sup> a notice stating that they are about to apply for an order<sup>16</sup>, naming the county and district in the locality wherein the assay office the subject

of the order carries on or is intended to carry on business, as the case may be, specifying a place where a copy of the draft order may be inspected, and giving the name and date of issue of a local newspaper in which the notice explaining the effect of the order applied for will be found<sup>17</sup>.

At the request of any person interested the applicants must furnish to him a copy of the draft order upon payment of such charge as they think reasonable not exceeding 50 pence or such higher sum as the Secretary of State may from time to time authorise in writing<sup>18</sup>.

The Secretary of State may make an order in the terms of the draft submitted to him or in those terms as modified in such manner as he thinks fit, but, where he proposes to make any modification which appears to him substantially to affect the character of the order as applied for, he must take such steps as appear to him to be sufficient and reasonably practicable for informing the applicants and other persons likely to be concerned and must not make the order until such period for consideration of, and comment upon, the proposed modifications as he thinks reasonable has elapsed<sup>19</sup>.

If, before the expiration of the specified period<sup>20</sup>, an objection is received by the Secretary of State from any person appearing to him to be affected by the application or, as the case may be, by the proposed modification, and the objection is not withdrawn, the Secretary of State, before making an order on the application, must (unless he is of opinion that the objection is frivolous or too trivial to warrant the holding of an inquiry or hearing with respect to it) either cause a local inquiry to be held or afford to the objector and to the applicants, as well as to any other persons to whom it appears to the Secretary of State expedient to afford it, an opportunity of appearing before, and being heard by, a person appointed by the Secretary of State for the purpose<sup>21</sup>.

On the making of an order<sup>22</sup> the Secretary of State must give notice of the making of the order and the effect thereof to any person who has objected thereto<sup>23</sup> and has not withdrawn that objection and in that case the order does not have effect until the expiration of 28 days from the date of the notice; and if within that period any person gives notice to the Secretary of State that he objects to the order and the objection is not withdrawn, the order is subject to special parliamentary procedure<sup>24</sup>.

The costs<sup>25</sup> incurred by the Secretary of State in connection with the making and notification of an order<sup>26</sup> must be paid by the applicants<sup>27</sup>.

If he thinks fit and after consultation with the Council and any assay office appearing to him to be concerned, the Secretary of State may, without application to him by the Council or an assay office, make an order for any of the purposes mentioned in heads (1) to (4) above<sup>28</sup>.

1 As to the Secretary of State see PARA 14 ante.

2 Such an order may not, however, be made unless a draft of the order has been approved by a resolution of each House of Parliament: Hallmarking Act 1973 s 21(5). Any order so made may contain such incidental, consequential and supplementary provisions as the Secretary of State thinks necessary or expedient for the purposes of the order, including provisions for the amendment, adaptation or repeal of any local statutory provision: s 16(3). For the meaning of 'local statutory provision' see PARA 465 note 10 ante. As to the making of orders generally see PARA 466 ante.

3 As to the British Hallmarking Council see PARAS 482-484 post.

4 For the meaning of 'assay office' see PARA 469 ante.

5 Hallmarking Act 1973 s 16(1)(a).

6 Ibid s 16(1)(b).

7 Ibid s 16(1)(c).



8 Ibid s 16(1)(c) (retrospectively amended in its application to the Birmingham, Edinburgh and Sheffield Assay Offices by the Birmingham Assay Office Act 1995; the Edinburgh Assay Office Order Confirmation Act 1995; and the Sheffield Assay Office Act 1995). In exercise of the power so conferred the Secretary of State has made the Sheffield Assay Office Order 1978, SI 1978/639 (amended by SI 1991/1997); the Edinburgh Assay Office Order 1979, SI 1979/1587 (amended by SI 1989/992; SI 1991/1997; SI 1993/2135); and the Birmingham Assay Office Order 1989, SI 1989/900 (amended by SI 1991/1997).

9 Hallmarking Act 1973 s 16(4), Sch 6 Pt I para 1. Where the Secretary of State exercises his power to make such an order himself under s 16(2) (see the text and note 28 *infra*) he must consult, in relation to head (1) and head (2) in the text, the Council, and in relation to head (3) in the text, the assay office: Sch 6 Pt I paras 1, 2 (modified by Sch 6 Pt II para 11(a)).

10 Ibid Sch 6 Pt I para 2. This provision is modified so as to omit mention of the application, the applicants etc where the Secretary of State makes an order himself under s 16(2): see note 9 *supra*.

11 Ibid Sch 6 Pt I para 2(a).

12 Ibid Sch 6 Pt I para 2(b).

13 Ibid Sch 6 Pt I para 2(c).

14 Ibid Sch 6 Pt I para 3. This provision does not apply where the Secretary of State exercises his power to make such an order himself under s 16(2) (see the text and note 28 *infra*): Sch 6 Pt II para 11(b).

15 For these purposes, 'the Gazette' means in relation to publication of a notice as respects an order concerning an assay office carrying on or intended to carry on business: (1) in England and Wales, the London Gazette; (2) in Scotland, the Edinburgh Gazette; and (3) in Northern Ireland, the Belfast Gazette: *ibid* Sch 6 Pt I para 10.

16 *Ie* under *ibid* s 16: see the text and notes 1-8 *supra*.

17 Ibid Sch 6 Pt I para 4. Where the Secretary of State exercises his power to make such an order himself under s 16(2) (see the text and note 28 *infra*), the duty of publication under Sch 6 Pt I para 4 falls upon him: Sch 6 Pt II para 11(c).

18 Ibid Sch 6 Pt I para 5. Where the Secretary of State exercises his power to make such an order himself under s 16(2) (see the text and note 28 *infra*), the duty of furnishing information under Sch 6 Pt I para 5 falls upon him: Sch 6 Pt II para 11(c).

19 Ibid Sch 6 Pt I para 6. This provision is modified, *mutatis mutandis*, where the Secretary of State exercises his power to make such an order himself under s 16(2) (see the text and note 28 *infra*): Sch 6 Pt II para 11(d).

20 *Ie* the period of 28 days referred to in *ibid* Sch 6 Pt I para 2 (see the text and notes 10-13 *supra*) or the period of 25 days from the publication of the notice in the Gazette or any period specified in the notices given under Sch 6 Pt I para 6 (see the text and note 19 *supra*).

21 Ibid Sch 6 Pt I para 7. This provision is modified, *mutatis mutandis*, where the Secretary of State exercises his power to make such an order himself under s 16(2) (see the text and note 28 *infra*): Sch 6 Pt II para 11(e). As to the holding of a local inquiry see *PARA* 465 note 4 *ante*.

22 *Ie* an order to which *ibid* Sch 6 Pt I applies.

23 *Ie* under *ibid* Sch 6 Pt I paras 1-7: see the text and notes 9-21 *supra*.

24 Ibid Sch 6 Pt I para 8. Special parliamentary procedure is regulated by the Statutory Orders (Special Procedure) Act 1945: see *PARLIAMENT* vol 34 (Reissue) *PARA* 912 *et seq*.

25 *Ie* including any costs incurred in relation to any such order under the Statutory Orders (Special Procedure) Act 1945.

26 *Ie* an order under the Hallmarking Act 1973 Sch 6 Pt I.

27 Ibid Sch 6 Pt I para 9. This provision does not apply where the Secretary of State exercises his power to make such an order himself under s 16(2) (see the text and note 28 *infra*): Sch 6 Pt II para 11(b).

28 Ibid s 16(2). In relation to any order under s 16(2) various provisions of Sch 6 Pt I have effect subject to modifications: see Sch 6 Pt II para 11; and notes 9-10, 14, 17-19, 21, 27 *supra*.

**UPDATE**

**470 Orders constituting, dissolving etc or conferring powers on assay offices**

NOTE 8--SI 1978/639, SI 1979/1587, SI 1989/900 all further amended: SI 2008/948.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/471. Powers and duties of assay offices.

#### **471. Powers and duties of assay offices.**

An assay office<sup>1</sup> may refuse to assay or mark any new ware<sup>2</sup> if it is submitted at a stage of its manufacture which is unreasonable for assaying of and striking of marks on the new ware<sup>3</sup>.

Upon receipt of any article submitted to an assay office for assay and hallmarking, the assay office must examine the same to ascertain whether it is in its opinion sufficiently advanced in workmanship and, if composed of one or more parts, whether all the parts are present, and also whether the article complies with the conditions of the Hallmarking Act 1973 so as to permit it to be struck with the approved hallmarks<sup>4</sup>; and, if the assay office is dissatisfied as respects any of such matters, it must return the article without making an assay thereof<sup>5</sup>.

If, upon receipt and view of any article submitted to an assay office for assay and hallmarking, the assay office suspects that other materials than precious metal<sup>6</sup> of not less than the minimum fineness<sup>7</sup> therefor have been introduced or concealed in any such article, the assay office may cause the same to be cut<sup>8</sup>; and, if upon cutting:

586 (1) any such other materials are found therein, the article must be broken and defaced and it, or the value thereof, is forfeited to the assay office and applied towards its general expenses<sup>9</sup>;

587 (2) no such other materials are found therein, the assay office, but not any other person, is liable in damages to any person interested in the article<sup>10</sup>.

An assay office may<sup>11</sup> cause to be drawn, scraped, cut or otherwise removed from an article submitted to it such quantity of precious metal or take such other sample or do such other thing as may be necessary to enable an accurate assay to be made of the article and may retain the quantity so removed and apply it, or the value thereof, towards its general expenses<sup>12</sup>.

In the event of any part of any article or any sample from any article being found to be of a fineness:

588 (a) less than the minimum fineness for the precious metal of that article, the article the subject of the assay must be returned to the person submitting the same after payment of the prescribed charge; and, if the article is a new ware, the assay office has power, before so returning the article, to break it and any other articles which were submitted with it in the same parcel of work<sup>13</sup>;

589 (b) not less than such minimum fineness, the article must be struck with the approved hallmarks and delivered to the person submitting the same after payment of the prescribed charge<sup>14</sup>.

If an assay office is satisfied where two or more articles being new wares are submitted to it in one parcel of work for assay and hallmarking that all the articles so submitted are intended to assay to a single standard of fineness, the assay office may<sup>15</sup> carry out a single assay in respect of some or all of the articles contained in such parcel<sup>16</sup>.

Each assay office is responsible both for the safe custody of the dies to be used by that assay office for the purpose of striking articles with the approved hallmarks and other marks and for the disposal of such dies as and when the same are no longer required<sup>17</sup>.

1 For the meaning of 'assay office' see PARA 469 ante.

2 For these purposes, 'new ware' means: (1) any article which is a substantially complete manufacture and which has not as such been supplied on a sale by retail; and (2) any article which has been the subject of an improper alteration: Hallmarking Act 1973 s 22(1). 'Improper alteration' means an addition, alteration or repair which has been made to an article bearing approved hallmarks and which: (a) contravened s 5 (see PARA 479 post); or (b) was made before 1 January 1975 and would have required the consent of an assay office if s 5 had been in force; or (c) in the case of an article which bears a convention hallmark or an EEA hallmark, would have required that consent if the addition, alteration or repair had been made in the United Kingdom: ss 2(5), 22(1) (s 2(5)(c) amended by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(6)). Heads (b), (c) supra do not apply, however, if, after the making of the addition, alteration or repair, the article has been re-assayed and struck with any further approved hallmark: Hallmarking Act 1973 s 2(5) proviso. For the meaning of 'convention hallmark' see PARA 472 post; for the meaning of 'EEA hallmark' see PARA 473 post; and for the meaning of 'United Kingdom' see PARA 3 note 2 ante.

3 Ibid s 15(1), Sch 5 para 1.

4 For the meaning of 'approved hallmarks' see PARA 468 ante.

5 Hallmarking Act 1973 Sch 5 para 2(1).

6 For the meaning of 'precious metal' see PARA 468 note 8 ante.

7 For the meaning of 'minimum fineness' see PARA 468 note 10 ante; and for the meaning of 'fineness' see PARA 468 note 9 ante.

8 Hallmarking Act 1973 Sch 5 para 2(2).

9 Ibid Sch 5 para 2(2)(a).

10 Ibid Sch 5 para 2(2)(b).

11 Ie subject to ibid Sch 5 para 2(1), (2) (see the text and notes 5-10 supra) and Sch 5 para 2(5) (see the text and note 16 infra).

12 Ibid Sch 5 para 2(3).

13 Ibid Sch 5 para 2(4)(a).

14 Ibid Sch 5 para 2(4)(b).

15 Ie notwithstanding anything in ibid Sch 5 para 2(3): see the text and note 12 supra.

16 Ibid Sch 5 para 2(5).

17 Ibid Sch 5 para 4(1). After consultation with all the assay offices the British Hallmarking Council may make regulations in or in connection with the discharge by assay offices of the duty imposed upon them by Sch 5 para 4(1) and as to the manner in which any such die is to be made or used and generally in relation thereto: Sch 5 para 4(2). As to the British Hallmarking Council see PARAS 482-484 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/472. Convention hallmarks.

#### **472. Convention hallmarks.**

'Convention hallmarks' means marks struck by an assay office<sup>1</sup> under the law of a country outside the United Kingdom<sup>2</sup>, being marks designated for this purpose by order of the Secretary of State<sup>3</sup> as marks recognised pursuant to any international convention or treaty to which Her Majesty's government in the United Kingdom is a party<sup>4</sup>. The Secretary of State may make such provision by order as appears to him appropriate for enabling articles submitted to an assay office in the United Kingdom to be struck with marks which, pursuant to any such convention or treaty, will, or will with other marks, be accorded recognition under the law of any other country<sup>5</sup>.

1 For the meaning of 'assay office' see PARA 469 ante.

2 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

3 As the Secretary of State see PARA 465 note 4 ante.

4 Hallmarking Act 1973 ss 2(1)(c), (2), 22(1). The effect of these provisions is to enable the United Kingdom government to comply with the Convention on the Control and Marking of Articles of Precious Metals 1972 (Vienna, 15 November 1972; TS 53 (1978); Cmnd 7219). As to the relevant orders see note 5 infra.

5 Hallmarking Act 1973 s 2(3) (amended by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(5)). Such an order may contain consequential or incidental provisions, including provision for excluding or modifying any of the provisions of the Hallmarking Act 1973: s 2(3). In exercise of the power so conferred the Secretary of State has made the Hallmarking (International Convention) Order 2002, SI 2002/506, which: (1) recognises certain foreign hallmarks and sponsors' marks, with the result that articles bearing such marks are to be treated as hallmarked for the purposes of the Hallmarking Act 1973 and may therefore be described in the United Kingdom as being of the precious metal of which they are made; and (2) provides for the application in the United Kingdom of similar marks which are to be recognised in other Convention countries. As to the making of orders generally see PARA 466 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/473. EEA hallmarks and free movement of goods under EC law.

#### **473. EEA hallmarks and free movement of goods under EC law.**

'EEA hallmarks' means marks struck in an EEA state<sup>1</sup> other than the United Kingdom<sup>2</sup>, being marks which have been struck by an independent body in accordance with the law of that state, and provide information which is equivalent to the information provided by the assay office marks and standard marks<sup>3</sup>, and which is intelligible to consumers in the United Kingdom<sup>4</sup>. The provisions relating to EEA hallmarks were inserted<sup>5</sup> in the Hallmarking Act 1973 in consequence of a decision of the European Court of Justice interpreting and applying the rules on free movement of goods under the EC Treaty<sup>6</sup>. In accordance with that decision, the rules on free movement of goods require member states to permit the marketing of articles of precious metal hallmarked by an independent body in the member state of exportation<sup>7</sup>, so long as that hallmark contains information which is equivalent to that provided by the hallmarks required by the member state of importation and which is intelligible to consumers in that state<sup>8</sup>. Thus member states may not require the application of hallmarks denoting a particular standard of fineness in parts per thousand or the application of a sponsor's mark registered in the country of importation or an approved national or convention hallmark where those articles have been lawfully marketed in another member state bearing hallmarks which convey equivalent information such as hallmarks indicating the standard of fineness in parts per thousand<sup>9</sup>. National rules which prohibit the marketing of articles of precious metal which do not indicate their date of manufacture cannot be enforced, where those articles have been lawfully marketed in another member state from which they have been imported<sup>10</sup>.

In accordance with general principles of EC law, the domestic provisions relating to EEA hallmarks are to be interpreted as far as possible in conformity with the provisions of EC law<sup>11</sup> to which they give effect<sup>12</sup>. Further, the EC rules on free movement of goods have direct effect and national provisions relating inter alia to hallmarking requirements cannot be enforced to the extent that they conflict with those rules. Accordingly, it is possible if the statutory provisions relating to EEA hallmarks do not go far enough that the EC rules on free movement of goods could directly provide a defence to a person marketing hallmarked articles from other member states.

1 'EEA state', in relation to any time, means a state which at that time is a member state, or any other state which at that time is a party to the EEA agreement: Hallmarking Act 1973 s 2(2A) (added by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(4); and substituted by the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872, reg 2(1), (2)); Interpretation Act 1978 s 5, Sch 1 (definition added by the Legislative and Regulatory Reform Act 2006 s 26(1)). As to the EEA and the EEA agreement see PARA 102 note 6 ante.

2 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

3 Ie the information provided by marks under the Hallmarking Act 1973 s 4(1)(a)(i), (ii): see PARA 468 note 11 ante.

4 Ibid ss 2(1)(d), (2), 22(1) (s 2(1)(d) and the definition in s 22(1) added, and s 2(2) amended, by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(2), (3), (12)).

5 Ie by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978. The parts of these Regulations making provision for EEA hallmarks were made under the powers conferred by the European Communities Act 1972 s 2(2), to amend domestic laws in order to give effect to Community obligations of the United Kingdom.

6 Case C-293/93 *Straffesag v Houtwipper* [1994] ECR I-4249, [1995] All ER (EC) 163, ECJ. The rules on free movement of goods are contained in the Treaty Establishing the European Community (Rome, 25 March 1957; TS 1 (1973); Cmnd 5179) (the 'EC Treaty') arts 28-30 (formerly arts 30-36; renumbered by virtue of the Treaty of Amsterdam: see *Treaty Citation (No 2) (Note)* [1999] All ER (EC) 646, ECJ). As to these rules as developed by the European Court of Justice see CUSTOMS AND EXCISE.

7 Case C-293/93 *Straffesag v Houtwipper* [1994] ECR I-4249, [1995] All ER (EC) 163, ECJ (Answer 2 to the questions of the national court). See also Case C-30/99 *Commission of the European Communities v Ireland (United Kingdom intervening)* [2001] ECR I-4619, sub nom *EC Commission v Ireland (United Kingdom intervening)* [2001] 3 CMLR 573, ECJ. It is for the national court to examine whether the articles of precious metal have been hallmarked by an independent body in the member state of exportation: *Straffesag v Houtwipper* supra (Answer 3).

8 Case C-293/93 *Straffesag v Houtwipper* [1994] ECR I-4249, [1995] All ER (EC) 163, ECJ (Answer 1 to the questions of the national court). See also Case C-30/99 *Commission of the European Communities v Ireland (United Kingdom intervening)* [2001] ECR I-4619, sub nom *EC Commission v Ireland (United Kingdom intervening)* [2001] 3 CMLR 573, ECJ. It is a matter for the national court to determine as a question of fact the equivalence of information provided by the hallmark: *Straffesag v Houtwipper* supra (Answer 3).

9 Case C-30/99 *Commission of the European Communities v Ireland (United Kingdom intervening)* [2001] ECR I-4619, sub nom *EC Commission v Ireland (United Kingdom intervening)* [2001] 3 CMLR 573, ECJ.

10 Case C-293/93 *Straffesag v Houtwipper* [1994] ECR I-4249, [1995] All ER (EC) 163, ECJ (Answer 4).

11 I.e. the EC Treaty arts 28-30 (as renumbered: see note 6 supra), as interpreted by the decision of the European Court of Justice in Case C-293/93 *Straffesag v Houtwipper* [1994] ECR I-4249, [1995] All ER (EC) 163, ECJ and in Case C-30/99 *Commission of the European Communities v Ireland (United Kingdom intervening)* [2001] ECR I-4619, sub nom *EC Commission v Ireland (United Kingdom intervening)* [2001] 3 CMLR 573, ECJ.

12 See PARA 5 note 3 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/474. Meaning of 'unhallmarked article'.

**474. Meaning of 'unhallmarked article'.**

An article is unhallmarked if it does not bear the approved hallmarks<sup>1</sup> and the sponsor's mark<sup>2</sup>, or if the article has been the subject of any improper alteration<sup>3</sup>.

1 For the meaning of 'approved hallmarks' see PARA 468 ante. As to the approved hallmarks whose absence does not render an article unhallmarked see the Hallmarking Act 1973 s 4(2) (as substituted); and PARA 468 note 11 ante.

2 For the meaning of 'sponsor's mark' see PARA 478 post.

3 Hallmarking Act 1973 ss 2(4), 22(1). For the meaning of 'improper alteration' see PARA 471 note 2 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/475. Permissible descriptions.

#### **475. Permissible descriptions.**

Certain descriptions of unhallmarked articles<sup>1</sup> are permitted notwithstanding the general prohibition<sup>2</sup>. The description 'gold' is permissible if qualified by the word 'plated' or 'rolled'; 'silver' is permissible if qualified by the word 'plated'; and 'platinum' is permissible if qualified by the word 'plated'<sup>3</sup>. If the description is in writing, the lettering of 'plated' or 'rolled' is to be at least as large as any other lettering in the description<sup>4</sup>.

A description is also permissible if it is implicitly or in express terms confined to the colour of the article<sup>5</sup>.

1 For the meaning of 'unhallmarked article' see PARA 474 ante.

2 See the Hallmarking Act 1973 s 1(2), Sch 1 Pt I. As to the general prohibition see s 1(1); and PARA 467 ante.

3 Ibid Sch 1 Pt I para 1(1). Schedule 1 Pt I para 1 does not apply, however, if the description is false or is applied to an article for which the description is inappropriate: Sch 1 Pt I para 1(3).

4 Ibid Sch 1 Pt I para 1(2).

5 Ibid Sch 1 Pt I para 2.

#### **UPDATE**

#### **475 Permissible descriptions**

NOTE 3--Also, 'palladium' is permissible if qualified by the word 'plated': Hallmarking Act 1973 Sch 1 Pt I para 1(1) (amended by SI 2009/2040).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/476. Exempted articles.

#### 476. Exempted articles.

Certain unhallmarked articles<sup>1</sup> are exempted from the general prohibition<sup>2</sup> on the application of 'gold', 'silver' or 'platinum' descriptions to such articles<sup>3</sup>. The exemptions fall into three classes:

- 590 (1) articles exempted generally<sup>4</sup>;
- 591 (2) articles exempt if of minimum fineness<sup>5</sup>; and
- 592 (3) articles manufactured or exempted before 1 January 1975<sup>6</sup>.

1 For the meaning of 'unhallmarked article' see PARA 474 ante.

2 ie under the Hallmarking Act 1973 s 1(1): see PARA 467 ante.

3 See *ibid* Sch 1 Pt II (paras 1-14AA) (amended by the Hallmarking (Exempted Articles) (Amendment) Order 1975, SI 1975/1883, art 3, Schedule; the Hallmarking (Exempted Articles) Order 1982, SI 1982/256, art 2; the Hallmarking (Exempted Articles) Order 1986, SI 1986/1758, art 2; and the Hallmarking Act 1973 (Exemption) (Amendment) Order 2007, SI 2007/880, art 2). The Hallmarking (Exempted Articles) Order 1982, SI 1982/256, was made to overcome the criticism in *Barge v Graham Brown (Oasis Trading) Ltd* [1981] 3 All ER 360, DC.

4 The articles so exempted are:

- 12 (1) an article which is intended for dispatch to a destination outside the United Kingdom (Hallmarking Act 1973 Sch 1 Pt II para 1);
- 13 (2) an article which is outside the United Kingdom, or which is in course of consignment from outside the United Kingdom to an assay office in the United Kingdom (Sch 1 Pt II para 2);
- 14 (3) any coin which is, or was formerly at any time, a current coin of the United Kingdom or of any other territory (Sch 1 Pt II para 3);
- 15 (4) any article which has been used, or is intended to be used, for medical, dental, veterinary, scientific or industrial purposes (Sch 1 Pt II para 4);
- 16 (5) any battered article fit only to be re-manufactured (Sch 1 Pt II para 5 (substituted by the Hallmarking (Exempted Articles) (Amendment) Order 1975, SI 1975/1883, art 3, Schedule));
- 17 (6) any article of gold or silver thread (Hallmarking Act 1973 Sch 1 Pt II para 6);
- 18 (7) any raw material (including any bar, plate, sheet, foil, rod, wire, strip or tube) or bullion (Sch 1 Pt II para 7);
- 19 (8) any manufactured article which is not substantially complete, and which is intended for further manufacture (Sch 1 Pt II para 8);
- 20 (9) any article which is wholly or mainly of platinum and which was manufactured before 1 January 1975 (Sch 1 Pt II para 9).

For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

5 For the meaning of 'minimum fineness' see PARA 468 note 10 ante. The articles so exempt if of minimum fineness are:

- 21 (1) any article which: (a) is wholly or mainly of gold or of silver or of gold and silver assaying in all its gold parts not less than 375 parts per 1,000 and in all its silver parts not less than 800 parts per 1,000; and (b) was manufactured before the year 1950 and has not since the beginning

of that year been the subject of any alteration which would be an improper alteration if the article had previously borne approved hallmarks (ibid Sch 1 Pt II para 10 (substituted by the Hallmarking (Exempted Articles) (Amendment) Order 1975, SI 1975/1883, art 3, Schedule; and amended by the Hallmarking Act 1973 (Exemption) (Amendment) Order 2007, SI 2007/880, reg 2));

- 22 (2) any musical instrument, where the description is applied to the mouthpiece, and the mouthpiece is of minimum fineness (Hallmarking Act 1973 Sch 1 Pt II para 11 (amended by the Hallmarking (Exempted Articles) Order 1986, SI 1986/1758, art 2(a)));
- 23 (3) any article containing only one precious metal, being a metal of minimum fineness and of a weight less than the specified weight (ie for gold 1 gram, for silver 7.78 grams and for platinum 0.5 gram), but not including any article containing materials other than precious metal unless the article satisfies the conditions for hallmarking of the Hallmarking Act 1973 Sch 2 Pt III (see PARA 468 note 11 ante) (Sch 1 Pt II para 12(1), (2) (substituted by the Hallmarking (Exempted Articles) Order 1982, SI 1982/256, art 2; and amended by the Hallmarking (Exempted Articles) Order 1986, SI 1986/1758, art 2(b)));
- 24 (4) any article, except an article made of chainwork, which is wholly of one or more precious metals of minimum fineness and which is so small or thin that it cannot be hallmarked (Hallmarking Act 1973 Sch 1 Pt II para 13 (substituted by the Hallmarking (Exempted Articles) (Amendment) Order 1975, SI 1975/1883, art 3, Schedule; and amended by the Hallmarking (Exempted Articles) Order 1986, SI 1986/1758, art 2(a), (c)));
- 25 (5) any article which is of minimum fineness and which is imported temporarily (whether as a trade sample, or as intended for exhibition or otherwise) and for the time being remains under the control of the Commissioners for Her Majesty's Revenue and Customs (Hallmarking Act 1973 Sch 1 Pt II para 14 (amended by the Hallmarking (Exempted Articles) Order 1986, SI 1986/1758, art 2(a); and by virtue of the Commissioners for Revenue and Customs Act 2005 s 50(1), (7)));
- 26 (6) any article, any precious metal in which is of minimum fineness, and which either: (a) contains gold and platinum but not silver, and the weight of the gold parts of which exceeds 50% of the total weight of the precious metals in the article, that total weight being less than 1 gram; or (b) contains silver and either gold or platinum or both gold and platinum, and the weight of the silver parts of which exceeds 50% of the total weight of the precious metals in the article, that total weight being less than 7.78 grams, but not including any article containing materials other than precious metal unless the article satisfies the conditions for hallmarking of the Hallmarking Act 1973 Sch 2 Pt III (see PARA 468 note 11 ante) (Sch 1 Pt II para 14A(1), (2) (s 14A added by the Hallmarking (Exempted Articles) Order 1982, SI 1982/256, art 2; and amended by the Hallmarking (Exempted Articles) Order 1986, SI 1986/1758, art 2(b))).

Heads (2)-(6) supra do not apply to any article in which solder containing precious metal is used unless the solder is of a standard of fineness equivalent to that which would be required under the Hallmarking Act 1973 s 4(3) (as amended) (see PARA 468 ante) if the article were submitted to an assay office for hallmarking: Sch 1 Pt II para 14AA (added by the Hallmarking (Exempted Articles) Order 1986, SI 1986/1758, art 2(d)). In relation to an article manufactured before 1 January 2008 the reference to the Hallmarking Act 1973 Sch 2 Pt III in heads (3) and (6) supra is to that Part as it had effect immediately before 6 April 2007: Sch 1 Pt II para 12(3) (added by the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872, reg 2(1), (4)); Hallmarking Act 1973 Sch 1 Pt II para 14A(3) (added by the Hallmarking Act 1973 (Amendment) Regulations 2007, SI 2007/872, reg 2(1), (5)). For the meaning of 'precious metal' see PARA 468 note 8 ante; for the meaning of 'improper alteration' see PARA 471 note 2 ante; and for the meaning of 'assay office' see PARA 469 ante. As to the Commissioners of Customs and Excise see CUSTOMS AND EXCISE vol 12(3) (2007 Reissue) PARA 900 et seq.

6 The following articles of gold are exempt, if manufactured before 1 January 1975, and (except in the case of articles mentioned in head (4) infra) of minimum fineness:

- 27 (1) rings, except wedding rings, pencil cases, lockets, watch chains and thimbles (Hallmarking Act 1973 Sch 1 Pt II para 15(a));
- 28 (2) articles consisting entirely of filigree work (Sch 1 Pt II para 15(b));
- 29 (3) articles so heavily engraved or set with stones that it is impossible to mark them without damage (Sch 1 Pt II para 15(c));
- 30 (4) jewellers works, ie the actual setting only in which stones or other jewels are set, and jointed sleeper earrings (Sch 1 Pt II para 15(d)).

The following articles of silver are exempt, if manufactured before 1 January 1975, and (except in the case of articles mentioned in head (e) infra) of minimum fineness:

- 31 (a) lockets, watch chains and stamped medals (Sch 1 Pt II para 16(1)(a));
- 32 (b) mounts the weight of which is less than 15.55 grams (Sch 1 Pt II para 16(1)(b));
- 33 (c) articles consisting entirely of filigree work (Sch 1 Pt II para 16(1)(c));
- 34 (d) silver articles the weight of which is less than 7.78 grams (Sch 1 Pt II para 16(1)(d));
- 35 (e) jewellers works, ie the actual setting only in which stones or other jewels are set (Sch 1 Pt II para 16(1)(e)).

The following articles are not, however, so exempt: necks and collars for bottles on cruet stands; buttons and studs, seals, wine labels, shoe clasps, buckles or patch boxes; salt spoons, shovels or ladles, teaspoons, tea strainers, caddy ladles or spoons; ornaments for cabinets, knife cases, tea caddies, bridles, stands or frames: Sch 1 Pt II para 16(2).

Articles of gold or silver manufactured before 1 January 1975, other than articles mentioned in Sch 1 Pt II para 15 or Sch 1 Pt II para 16, and being of such descriptions as, under any enactment in force immediately before 25 July 1973, to be specifically exempt from hallmarking, are exempt: Sch 1 Pt II para 17.

Where an exemption depends on the date of manufacture, or the date of any alteration, the manufacture or alteration is presumed to be after that date until the contrary is proved: Sch 1 Pt II para 18.

## UPDATE

### 476 Exempted articles

NOTE 3--1973 Act Sch 1 Pt II (paras 1-14AA) further amended: Hallmarking Act 1973 (Exemption) (Amendment No 2) Order 2007, SI 2007/2493.

NOTE 4--Head (6) also includes palladium: Hallmarking Act 1973 Sch 1 Pt II para 6 (amended by SI 2009/2040). For head (10), 'any article which is wholly or partly of palladium, and which was manufactured before 1 January 2010': Hallmarking Act 1973 Sch 1 Pt II para 9A (added by SI 2009/2040).

NOTE 5--Head (3), palladium specifying less than 1 gram in weight is also exempt if of minimum fineness: Hallmarking Act 1973 Sch 1 Pt II para 12(1) (amended by SI 2009/2040).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/477. Descriptions relating to fineness.

#### **477. Descriptions relating to fineness.**

A description indicating that an article, or the metal in an article, is of so many carats, is to be presumed to be an indication that the article or metal is of gold, and that its fineness<sup>1</sup> is that specified<sup>2</sup> for that number of carats<sup>3</sup>.

A description of an article, or of the metal in an article, as 'sterling' or (except in the phrase 'Britannia metal') 'Britannia' is to be presumed to be an indication that the article, or the metal, is of silver<sup>4</sup>.

These provisions also apply for the purposes of the Trade Descriptions Act 1968<sup>5</sup>.

1 For the meaning of 'fineness' see PARA 468 note 9 ante.

2 I.e. 9 carats indicates gold of a standard of fineness of 375 parts per thousand; 12 carats indicates gold of a standard of fineness of 500 parts per thousand; 14 carats indicates gold of a standard of fineness of 585 parts per thousand; 15 carats indicates gold of a standard of fineness of 625 parts per thousand; 18 carats indicates gold of a standard of fineness of 750 parts per thousand; 22 carats indicates gold of a standard of fineness of 916.6 parts per thousand; and so in proportion for any other number of carats: Hallmarking Act 1973 s 1(5), Sch 1 Pt III para 2.

3 Ibid Sch 1 Pt III paras 1, 2(1). Schedule 1 Pt III para 2 does not apply, however, if (as in a case where the article is a precious stone) the word 'carat' is used as a measure of weight for precious stones and not as a measure of fineness: Sch 1 Pt III para 2(2).

4 Ibid Sch 1 Pt III paras 1, 3(1). If 'sterling' is the word used, the description is to be presumed to be an indication that the silver is of a standard of fineness of 925: Sch 1 Pt III para 3(2). If the word used is 'Britannia', the description is to be presumed to be an indication that the silver is of a standard of fineness of 958.4: Sch 1 Pt III para 3(3).

5 Ibid Sch 1 Pt III para 1. As to the Trade Descriptions Act 1968 see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 471 et seq. Notwithstanding s 3(1) (definition of 'false trade description' as one which is false to a material degree: see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 479) a trade description which indicates the fineness, whether in parts per 1,000 or otherwise, of any precious metal is a false trade description if that indication is false to any extent or degree (except by understating the fineness): Hallmarking Act 1973 s 1(4). For the meaning of 'precious metal' see PARA 468 note 8 ante.

### **UPDATE**

#### **477 Descriptions relating to fineness**

TEXT AND NOTE 5--Hallmarking Act 1973 s 1(4) repealed, s 1(4A)-(4D) added, Sch 1 Pt III para 1 amended: SI 2008/1277. Hallmarking Act 1973 s 1 now applies for the purposes of the Business Protection from Misleading Marketing Regulations 2008, SI 2008/1276, and the Consumer Protection from Unfair Trading Regulations 2008, SI 2008/1277.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/478. Sponsors' marks.

#### **478. Sponsors' marks.**

'Sponsor's mark' means:

- 593 (1) a mark struck on an article and indicative of the manufacturer or sponsor<sup>1</sup>; or
- 594 (2) a mark designated as a sponsor's mark by order of the Secretary of State<sup>2</sup> as a mark recognised pursuant to any international convention or treaty to which Her Majesty's government in the United Kingdom<sup>3</sup> is a party and as a sponsor's mark for the purposes of the Hallmarking Act 1973<sup>4</sup>; or
- 595 (3) a mark struck on an article in an EEA state<sup>5</sup> which indicates the manufacturer or sponsor of the article<sup>6</sup>.

Before an article is submitted to an assay office<sup>7</sup> to be struck with the approved hallmarks<sup>8</sup>, there must be struck on the article a sponsor's mark<sup>9</sup>. A sponsor's mark must be authorised by registration with an assay office by which the article is intended to be so struck<sup>10</sup>.

Any person who without authority strikes an article with a mark purporting to be an authorised sponsor's mark is guilty of an offence<sup>11</sup>.

1 Hallmarking Act 1973 ss 3(1), 22(1). 'Sponsor's mark' includes a mark applied under the corresponding provisions of earlier legislation: see s 22(1).

2 As to the Secretary of State see PARA 14 ante.

3 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

4 Hallmarking Act 1973 s 22(1). For the orders made for this purpose see PARA 472 note 5 ante.

5 For the meaning of 'EEA state' see PARA 473 note 1 ante.

6 Hallmarking Act 1973 s 22(1) (amended by the Hallmarking (Hallmarking Act Amendment) Regulations 1998, SI 1998/2978, reg 2(14)).

7 For the meaning of 'assay office' see PARA 469 ante.

8 For the meaning of 'approved hallmark' see PARA 468 ante.

9 Hallmarking Act 1973 s 3(1). The assay office and the manufacturer or sponsor of an article may, however, make arrangements for the sponsor's mark to be struck by that assay office upon submission of the article to be struck with the approved hallmarks: s 3(1) proviso.

10 See *ibid* s 3(2). An assay office must maintain a register of sponsor's marks for the time being registered and approved by it: s 3(3)(b). A registered sponsor's mark, other than one registered on or before 31 December 1975, must include the initial letters of the name or names of the manufacturer or sponsor and must be of such design as may be approved by an assay office: see s 3(3)(a). Registration fees are to be paid, and punches and other equipment approved, in accordance with regulations made by the British Hallmarking Council: see s 3(4), (5). Any assay office may register its own sponsor's mark, of such design as may be approved by the Council, and strike it on an article submitted to it where it would not be justified in requiring the applicant to register his own sponsor's mark: see s 3(6). The registration of a sponsor's mark ceases to have effect after the expiration of the period of ten years following registration, but without prejudice to the making of any application for renewal of such registration: s 3(7). As to the British Hallmarking Council see PARAS 482-484 post.

11 *Ibid* s 3(8). As to offences see PARA 486 post.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/479. Alterations to hallmarked articles.

#### **479. Alterations to hallmarked articles.**

It is an offence for any person to make an addition, alteration or repair to an article bearing approved hallmarks<sup>1</sup>, except in accordance with the written consent of an assay office<sup>2</sup>. It is also an offence for any person to remove, alter or deface any mark<sup>3</sup> struck on an article, except in accordance with the written consent of an assay office<sup>4</sup>. In giving any consent for these purposes an assay office may make it a condition of the consent that the article concerned, or any addition made to it, be further assayed and struck with the appropriate marks<sup>5</sup>.

It is not an offence<sup>6</sup>, however, to batter an article so as to render it fit only for re-manufacture<sup>7</sup>; nor is it an offence<sup>8</sup> to make an addition to an article which is not a new ware<sup>9</sup> if the character of the article, and the purposes for which it can be used, remain unaltered and the metal added satisfies the specified conditions<sup>10</sup>. In certain circumstances it is not an offence to add a coating of silver, gold or rhodium to an article<sup>11</sup>.

1 For the meaning of 'approved hallmarks' see PARA 468 ante.

2 Hallmarking Act 1973 s 5(1). For the meaning of 'assay office' see PARA 469 ante. As to offences see PARA 486 post.

3 For these purposes, 'mark' means a sponsor's mark, any approved hallmark, the word 'filled', the word 'metal' or any other word for the time being prescribed by or under *ibid* s 4 or Sch 2 (as amended) (see PARA 468 ante): s 5(2). For the meaning of 'sponsor's mark' see PARA 478 ante.

4 *Ibid* s 5(2).

5 *Ibid* s 5(6). For these purposes, the appropriate marks are the sponsor's mark and such of the approved hallmarks as may be specified in directions issued by the British Hallmarking Council or, in the absence of any such directions, such of the approved hallmarks as may be determined by the assay office: s 5(6)(a), (b). As to the British Hallmarking Council see PARAS 482-484 post.

If an application for consent under s 5(1) or s 5(2) has been refused and the applicant has referred the matter in writing to the Council, the Council must consider the case and, if of the opinion that the assay office was acting unreasonably in withholding the consent applied for, it must direct the assay office to grant the consent (s 5(7)), and, without prejudice to s 5(6), it is the duty of an assay office to which a direction has been given under s 5(7) to comply with the direction (s 5(8)).

6 *Ie* under *ibid* s 5(1) or (2): see the text and notes 1-4 *supra*.

7 *Ibid* s 5(3).

8 *Ie* under *ibid* s 5(1): see the text and notes 1-2 *supra*.

9 For the meaning of 'new ware' see PARA 471 note 2 ante.

10 Hallmarking Act 1973 s 5(4). The conditions so specified are that: (1) the addition must be of the same precious metal as that of the article; (2) the metal added to the article must be of a fineness not less than the standard of fineness of the article; and (3) the amount of metal added must not exceed the lesser of: (a) 1 gram of gold, 5 grams of silver or 0.5 gram of platinum, as the case may be; and (b) 50% of the weight of the article immediately before the addition was made: s 5(4). For the meaning of 'precious metal' see PARA 468 note 8 ante; and for the meanings of 'fineness' and 'standard of fineness' see PARA 468 note 9 ante.

11 *Ibid* s 5(5). It is not an offence to add a coating of a thickness not exceeding two micrometres at any point to the whole or any part of: (1) an article of gold, if the coating is of gold of a fineness not less than the standard of fineness of the article; or (2) an article of silver, if the coating is of silver of a fineness not less than the standard of fineness of the article; or (3) an article of silver, if the coating is of gold of not less than the



minimum fineness; or (4) an article of gold, silver or platinum, if the coating is of rhodium: s 5(5). For the meaning of 'minimum fineness' see PARA 468 note 10 ante.

## **UPDATE**

### **479 Alterations to hallmarked articles**

NOTES 10, 11--Hallmarking Act 1973 s 5(4), (5) amended: SI 2009/2040.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/480. Treatment of unauthorised marks.

#### **480. Treatment of unauthorised marks.**

At its discretion an assay office<sup>1</sup> may cancel or obliterate any mark of the character of a hallmark, whether the mark appears to be an approved hallmark<sup>2</sup> or to be a mark which in the opinion of the assay office is likely to be confused with such a hallmark, which an article coming into its custody or possession bears, and which it is satisfied has not been struck on the article by an assay office according to law or is not a true description because the article appears to have been the subject of an improper alteration<sup>3</sup>. If it is proved that an assay office has:

- 596 (1) cancelled or obliterated any such mark<sup>4</sup> which has been struck by an assay office according to law on an article which has not been the subject of an improper alteration; or
- 597 (2) obliterated any ancient mark upon an article,

the assay office (but not any other person) is liable in damages to any person interested in the article<sup>5</sup>.

It is an offence for any person knowingly or for any dealer<sup>6</sup> to supply or offer to supply any article bearing any mark of the character of a hallmark and which may, if the article is in the possession of an assay office, be cancelled, obliterated or defaced<sup>7</sup>, unless the article has been first submitted to an assay office to enable it at its discretion to cancel, obliterate or deface that mark<sup>8</sup>.

1 For the meaning of 'assay office' see PARA 469 ante.

2 For the meaning of 'approved hallmarks' see PARA 468 ante.

3 Hallmarking Act 1973 s 7(1). For the meaning of 'improper alteration' see PARA 471 note 2 ante.

Notwithstanding anything in any enactment, an assay office may not, otherwise than by leave of the owner or other person appearing to have the control of any article, obliterate any ancient mark but must cancel it in a manner authorised by the British Hallmarking Council: s 7(2). The Council may issue directions to assay offices as to the manner in which an ancient mark may be so cancelled: s 7(3). For these purposes, 'ancient mark' means a mark of the character of a hallmark appearing to an assay office to have been struck or incorporated before 22 December 1854, whether or not by an assay office according to law at the time of its marking or incorporation, upon or into an article which has not since been the subject of an improper alteration: s 7(7). As to the British Hallmarking Council see PARAS 482-484 post.

4 I.e any mark as described in *ibid* s 7(1): see the text to notes 1-3 *supra*.

5 *Ibid* s 7(4). In any action brought against an assay office in pursuance of s 7(4) it is a defence for it to prove that it had reasonable cause to believe that the circumstances specified respectively in s 7(4)(a) or s 7(4)(b) (see heads (1) and (2) in the text) did not exist: s 7(5).

6 For the meaning of 'dealer' see PARA 468 note 17 ante.

7 I.e under the Hallmarking Act 1973 s 7(1): see the text to notes 1-3 *supra*.

8 *Ibid* s 7(6). As to offences see PARA 486 post.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(ii) Hallmarks and Assay Offices/481. Counterfeiting.

#### **481. Counterfeiting.**

Any person who:

- 598 (1) with intent to defraud or deceive<sup>1</sup>, makes a counterfeit of any die<sup>2</sup> or mark<sup>3</sup>; or
- 599 (2) removes any mark from an article of precious metal<sup>4</sup> with intent to transpose it to any other article, whether of precious metal or not, or affixes to any article whether of precious metal or not, any mark which has been removed from an article of precious metal<sup>5</sup>; or
- 600 (3) utters<sup>6</sup> any counterfeit of a die or any article bearing a counterfeit of a mark<sup>7</sup>; or
- 601 (4) without lawful authority or excuse has in his custody or under his control anything which is, and which he knows or believes to be, a counterfeit of a die or an article, whether of precious metal or not, which bears a counterfeit of any mark<sup>8</sup>,

is guilty of an offence<sup>9</sup>.

Facts giving rise to an offence of counterfeiting under these provisions may also give rise to offences under other Acts<sup>10</sup>.

1 Cf *R v Heron* [1982] 1 All ER 993, [1982] 1 WLR, 451, HL.

2 For these purposes, 'die' means the whole or part of any plate, tool or instrument by means of which any mark of the nature of a sponsor's mark or a hallmark is struck on any metal: Hallmarking Act 1973 s 6(2). For the meaning of 'sponsor's mark' see PARA 478 ante.

3 Ibid s 6(1)(a). For these purposes, 'mark' means any mark of the nature of a sponsor's mark or hallmark: s 6(2).

4 For the meaning of 'precious metal' see PARA 468 note 8 ante.

5 Hallmarking Act 1973 s 6(1)(b).

6 For these purposes, a person utters any counterfeit die or article bearing a counterfeit mark if, knowing or believing the die or mark, as the case may be, to be a counterfeit, he supplies, offers to supply or delivers the die or article: ibid s 6(3). See *Selby v DPP* [1972] AC 515, [1971] 3 All ER 810, HL; *R v Walmsley, De Reya and Jackson* (1977) 67 Cr App Rep 30, CA.

7 Hallmarking Act 1973 s 6(1)(c).

8 Ibid s 6(1)(d).

9 Ibid s 6(1) (amended by the Magistrates' Courts Act 1980 s 32(2)). Such a person is liable on conviction on indictment to imprisonment for a term not exceeding ten years or a fine, or on summary conviction to a fine not exceeding the prescribed sum: see the Hallmarking Act 1973 s 6(1) (as so amended). As to the prescribed sum see PARA 141 note 8 ante. As to offences under the Hallmarking Act 1973 generally see PARA 486 post.

10 Eg under the Theft Act 1968 (see CRIMINAL LAW, EVIDENCE AND PROCEDURE vol 11(1) (2006 Reissue) PARAS 309-312), the Forgery and Counterfeiting Act 1981 (see CRIMINAL LAW, EVIDENCE AND PROCEDURE vol 11(1) (2006 Reissue) PARA 346 et seq) or the Trade Descriptions Act 1968 (see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 471 et seq).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(iii) The British Hallmarking Council/482. In general.

### (iii) The British Hallmarking Council

#### 482. In general.

The British Hallmarking Council<sup>1</sup> is charged with the duty of ensuring that adequate facilities for the assaying and hallmarking of articles of precious metal<sup>2</sup> are available as from time to time required in the United Kingdom<sup>3</sup>, of supervising the activities of assay offices<sup>4</sup> in that behalf, of taking all steps appearing to be open to it for ensuring the enforcement of the law with respect to hallmarking and of advising the Secretary of State<sup>5</sup> with respect to all matters concerning the due execution of the Hallmarking Act 1973 including any matter which may be referred to the Council by the Secretary of State<sup>6</sup>.

In addition to the functions<sup>7</sup> specifically conferred on it by or under any other provisions of the Hallmarking Act 1973, the Council has the following functions<sup>8</sup>:

- 602 (1) to advise the Secretary of State as it thinks fit with respect to the making of orders and regulations under the Hallmarking Act 1973 and with respect to the amendment of the law as it affects, whether directly or indirectly, the hallmarking of articles of precious metal, including advice as to the application of some or all of the provisions of the Act to any metal other than gold, silver and platinum<sup>9</sup>;
- 603 (2) subject to any directions in that behalf given by the Secretary of State, to fix the maximum charges for the time being to be charged by assay offices for assaying and hallmarking articles of precious metal manufactured in or intended for sale in the United Kingdom<sup>10</sup>;
- 604 (3) to advise the Secretary of State upon any need appearing to the Council from time to time for the establishment of any further assay office or for the closure of any assay office or for its amalgamation with another assay office<sup>11</sup>;
- 605 (4) to assist, by the provision of such technical and other services of the Council as may be available, all authorities and persons concerned in the enforcement of the Hallmarking Act 1973, to appoint such officers as the Council considers appropriate to act as inspectors and otherwise for the detecting of offences and enforcing the Hallmarking Act 1973 by or on behalf of the Council and to institute proceedings in that behalf<sup>12</sup>;
- 606 (5) to authorise any assay office to carry on its business in whole or in part, subject to any conditions which may be specified by the Council in so authorising, in such place as may be specified by the Council additional to the place at which the assay office is otherwise authorised<sup>13</sup>;
- 607 (6) to make temporary or permanent arrangements by directions, or to authorise the making of such arrangements between assay offices, whereby, notwithstanding anything in any enactment, facilities specified in any case by the Council need not be afforded at an assay office but are afforded at another or others<sup>14</sup>;
- 608 (7) to issue directions or regulations to all assay offices or, as the case may require, to an assay office in particular, as to the equipment and procedures to be provided and adopted by them or it in the assaying and hallmarking of precious metals and as to all other matters upon which such directions or regulations may be issued by the Council under the provisions of the Hallmarking Act 1973<sup>15</sup>; and

609 (8) subject to such provisions of the Hallmarking Act 1973 as confer powers in particular on the Council, to do anything which in its opinion is calculated to facilitate the proper discharge of any or all of its functions<sup>16</sup>.

It is the duty of an assay office to comply with directions and regulations issued by the Council pursuant to head (6) or head (7) above<sup>17</sup>. Any assay office which is aggrieved by any such direction or regulation may, however, make written representation in that behalf to the Secretary of State who may determine all issues which may be raised upon any such representation; and it is the duty of the Council to comply with any determination so made by the Secretary of State<sup>18</sup>.

All directions, regulations, authorities, notices or other instruments given or made by the Council under or in pursuance of any provision of the Hallmarking Act 1973 must be in writing and may be given or made under the hand of the secretary or other officer of the Council authorised in that behalf<sup>19</sup>.

1 The British Hallmarking Council came into existence on 1 January 1974; and it has performed the functions assigned to it by or under the Hallmarking Act 1973 since 1 January 1975: see s 13(1)(b). The Council is a body corporate with perpetual succession and a common seal and with power to hold and dispose of land: s 13(1)(c), Sch 4 para 17(1). Every instrument to which the common seal is affixed must be signed by a member and counter-signed by the secretary of the Council or by a second such member: Sch 4 para 17(2). As to bodies corporate see generally COMPANIES vol 14 (2009) PARA 1; CORPORATIONS.

2 For the meaning of 'precious metal' see PARA 468 note 8 ante.

3 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

4 For the meaning of 'assay office' see PARA 469 ante.

5 As to the Secretary of State see PARA 14 ante.

6 Hallmarking Act 1973 s 13(1)(a).

7 For the meaning of 'functions' see PARA 465 note 4 ante.

8 Hallmarking Act 1973 s 13(2), which is expressed to be without prejudice to s 13(1): see the text and notes 1-6 supra.

9 Ibid s 13(2)(a). As to the making of orders and regulations generally see PARA 466 ante.

10 Ibid s 13(2)(b). As to the power of assay offices to make charges see PARA 469 ante.

11 Ibid s 13(2)(c). As to the establishment and closure of assay offices see PARA 470 ante.

12 Ibid s 13(2)(d).

13 Ibid s 13(2)(e).

14 Ibid s 13(2)(f).

15 Ibid s 13(2)(g).

16 Ibid s 13(2)(h).

17 Ibid s 13(3). As to powers and duties of assay offices generally see PARA 469 ante.

18 Ibid s 13(3) proviso.

19 Ibid s 13(4).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(iii) The British Hallmarking Council/483. Constitution of the Council.

### **483. Constitution of the Council.**

The British Hallmarking Council<sup>1</sup> consists of not less than 16 nor more than 19 members<sup>2</sup>, ten of whom must be appointed by the Secretary of State<sup>3</sup> and six by the assay offices<sup>4</sup>. Members hold office for a term of three years<sup>5</sup>. A member of the Council may, however, at any time by notice in writing to the secretary of the Council resign his office<sup>6</sup>. Not more than two members of the Council may be persons appointed by the Council as co-opted members<sup>7</sup>.

The Council must elect a person to serve as chairman from among its members<sup>8</sup>; and the chairman holds office as such until the expiration of the period of his office as a member current at his election as chairman or until he resigns office as chairman or until he ceases to be a member of the Council, whichever first occurs<sup>9</sup>. A person retiring from or resigning office as chairman or as a member of the Council is eligible to hold that office again<sup>10</sup>.

The Council must appoint a secretary and such other officers and staff on such terms as to remuneration, pensions or otherwise as it may determine<sup>11</sup>.

The Council may appoint a technical committee and one or more other committees to carry out on the Council's behalf such of the functions<sup>12</sup> of the Council as it may determine; and any such committee is comprised of such persons appointed on such terms as the Council may determine<sup>13</sup>.

The Council may make standing orders for regulating the proceedings, including quorum, of the Council or any committee thereof, as the Council from time to time thinks fit<sup>14</sup>.

The powers of the Council or of any committee thereof may be exercised notwithstanding any vacancy in its membership; and no proceedings of such a body are invalidated by any defect in the selection of a person to be a member of that body<sup>15</sup>. Questions arising at any meeting of the Council or of any committee thereof must be determined by a majority of votes of the members present in person or by proxy<sup>16</sup>; but in the event of an equality of votes the chairman, or in his absence the person acting as chairman, has a second or casting vote<sup>17</sup>.

The chief executive of an assay office and any other employee authorised by it in that behalf may attend and speak at meetings of the Council<sup>18</sup>.

If the Council considers<sup>19</sup>, after consulting all the assay offices, that any or all of the statutory provisions relating to the Council's constitution<sup>20</sup> are no longer appropriate and that alterations, additions or omissions thereto or therefrom should be made, the Council may make representation in that behalf to the Secretary of State, specifying the alterations, additions or omissions which the Council considers should be made<sup>21</sup>. If the Secretary of State agrees with any representation so made to him or if<sup>22</sup> he considers it expedient to do so after consultation with the Council and despite the absence of any such representation, he may by order provide that there be made such alterations, additions or omissions to those statutory provisions, whether or not the same as those specified in a representation where one has been made to him, as may be specified in the order<sup>23</sup>.

1 As to the establishment and functions of the British Hallmarking Council see PARA 482 ante.

2 Hallmarking Act 1973 s 13(1)(c), Sch 4 para 1. A person wholly or mainly employed by an assay office, other than the clerk to an assay office, is not eligible for membership of the Council: Sch 4 para 6.

3 Ibid Sch 4 para 2(1). Three of the members so appointed by the Secretary of State must be persons appearing to him to be suitably qualified by virtue of their knowledge of, and experience in, organisations established, or activities carried on, for the protection of the consumer: Sch 4 para 2(2). Four, but not more than four, of the members appointed by the Secretary of State, must be persons appearing to him to be suitably qualified by virtue of their engagement wholly or mainly in trading in, or manufacture of, articles of precious metal: Sch 4 para 2(3). Before making an appointment under Sch 4 para 2(3), the Secretary of State must consult the assay offices and such bodies representing persons engaged wholly or mainly in trading in, or manufacture of, articles of precious metal as he thinks appropriate: Sch 4 para 2(4). For the meaning of 'assay office' see PARA 469 ante; and for the meaning of 'precious metal' see PARA 468 note 8 ante. As to the Secretary of State see PARA 14 ante.

4 Ibid Sch 4 para 3(1). The London and Birmingham assay offices must appoint two members each, and the Edinburgh and Sheffield assay offices one each: Sch 4 para 3(1). Any person so appointed must be a person appearing to the assay office appointing him to be suitably qualified by virtue of his knowledge and experience of hallmarking: Sch 4 para 3(2). A person engaged wholly or mainly in trading in, or in articles manufactured of, precious metal may not be so appointed: Sch 4 para 3(3).

5 See ibid Sch 4 para 4.

6 Ibid Sch 4 para 8(1). When a member of the Council other than a co-opted member ceases to hold office otherwise than upon expiration of his period of office, his place must be taken by a person appointed in the same manner as the member in question: Sch 4 para 8(2). A person so taking office by virtue of Sch 4 para 8(2) must retire when the person whose place he takes would normally have retired: Sch 4 para 8(3).

7 Ibid Sch 4 para 5(1). A co-opted member holds office in accordance with the terms of his appointment: Sch 4 para 5(2).

8 Ibid Sch 4 para 9(1). Notice of his election must as soon as is reasonably practicable be given in writing to the Secretary of State by the secretary or other person for the time being authorised by the Council in that behalf: Sch 4 para 9(1).

9 Ibid Sch 4 para 9(2). If any member appointed by an assay office is elected as chairman of the Council, Sch 4 para 8(2) (see note 6 supra) has effect as if that member had ceased to hold office otherwise than upon the expiration of his period of office: Sch 4 para 9(3).

10 Ibid Sch 4 para 10.

11 Ibid Sch 4 para 21.

12 For the meaning of 'functions' see PARA 465 note 4 ante.

13 Hallmarking Act 1973 Sch 4 para 15.

14 Ibid Sch 4 para 16. The Council may in any such standing orders make such provision as it thinks fit as to the giving of votes by proxy at meetings of the Council, including provision as to the form of appointment of any proxy, the submission of any completed proxy in due time before any meeting and as to all matters related to voting by proxy: Sch 4 para 14(1). A proxy for a member of the Council or of any committee of the Council need not be a member of the Council or that committee, as the case may be: Sch 4 para 14(2).

15 Ibid Sch 4 para 11.

16 Ibid Sch 4 para 12.

17 Ibid Sch 4 para 12 proviso.

18 Ibid Sch 4 para 13.

19 Ie having regard to: (1) the establishment of a new assay office, the dissolution of any assay office or its amalgamation with another assay office; or (2) other substantial changes which have taken place or are to take place in the functions, administration or activities of any assay office; or (3) any other considerations, whether or not of a like character to those mentioned above, appearing to the Council sufficient: ibid s 14(1).

20 Ie the provisions of ibid Sch 4: see the text and notes 1-18 supra.

21 Ibid s 14(1).

22 Ie having regard to the matters mentioned in ibid s 14(1): see note 19 supra.

23 Ibid s 14(2). Any such order is, however, subject to annulment in pursuance of a resolution of either House of Parliament: s 21(6). An order made under s 14 may contain such transitional, incidental and supplementary provisions, including in a case falling within s 14(1)(a) or s 14(1)(b) (see note 19 heads (1), (2) supra) provision for the winding up of any existing assay office and for the repeal of any local statutory provision relating to that assay office, as the Secretary of State considers appropriate: s 14(3). At the date at which this volume states the law no such order had been made. For the meaning of 'local statutory provision' see PARA 465 note 10 ante. As to the making of orders generally see PARA 466 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(iii) The British Hallmarking Council/484. Reports and accounts.

#### **484. Reports and accounts.**

The British Hallmarking Council<sup>1</sup> must, as soon as practicable after 31 December in each year, make to the Secretary of State<sup>2</sup> a report on the performance by it of its functions<sup>3</sup> during the period of 12 months ending with that date<sup>4</sup>. The report must include a record of all questions with which the Council has been concerned during that period and which appear to the Council to be of general interest<sup>5</sup>.

The Council must keep proper accounts of all sums received or paid by it<sup>6</sup>. The Council must send its accounts for each year to the Comptroller and Auditor General as soon as reasonably practicable after the end of the year to which the accounts relate<sup>7</sup>. The Comptroller and Auditor General must examine, certify and report on any accounts so sent to him<sup>8</sup> and lay before each House of Parliament a copy of any accounts so sent to him together with his report on them<sup>9</sup>. As soon as the accounts of the Council have been audited, the Council must send a copy of the accounts to the Secretary of State; a copy of the accounts must be kept at the office of the Council, and any person interested is entitled free of charge to inspect and to take copies of, or extracts from, the copy of the accounts<sup>10</sup>.

Any person, on application to the Council, is entitled to be furnished with copies of reports of the Council under the above provisions and of statements summarising the accounts of the Council, on payment of such reasonable sums as the Council may determine<sup>11</sup>.

1 As to the establishment, functions and constitution of the British Hallmarking Council see PARAS 482-483 ante.

2 As to the Secretary of State see PARA 14 ante.

3 For the meaning of 'functions' see PARA 465 note 4 ante.

4 Hallmarking Act 1973 s 19(1).

5 Ibid s 19(2).

6 Ibid Sch 4 para 19(1). As to the Council's expenses, which are met out of contributions made by the assay offices, see Sch 4 para 18. The Council may pay remuneration and other expenses to its chairman, and travel, subsistence and other allowances to its members and committee members: see Sch 4 para 20. As to the assay offices see PARA 469 ante.

7 Ibid Sch 4 para 19(1B) (Sch 4 para 19(1B)-(1D) added by the Government Resources and Accounts Act 2000 (Audit of Public Bodies) Order 2003, SI 2003/1326, art 8).

8 Hallmarking Act 1973 Sch 4 para 19(1C) (as added: see note 7 supra).

9 Ibid Sch 4 para 19(1D) (as added: see note 7 supra).

10 Ibid s 19(3).

11 Ibid s 19(4).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(iv) Enforcement of the Statutory Provisions/485. Enforcing authorities.

#### **(iv) Enforcement of the Statutory Provisions**

##### **485. Enforcing authorities.**

It is the duty of every local weights and measures authority<sup>1</sup> to enforce the provisions of the Hallmarking Act 1973 within its area<sup>2</sup>. The British Hallmarking Council<sup>3</sup> and the assay offices<sup>4</sup> may also enforce the provisions of that Act<sup>5</sup>. Certain provisions of the Trade Descriptions Act 1968<sup>6</sup> apply in relation to the enforcement of the Hallmarking Act 1973<sup>7</sup>. In addition the Hallmarking Act 1973 may be enforced under Part 8 of the Enterprise Act 2002<sup>8</sup> in certain circumstances<sup>9</sup>.

1 For the meaning of 'local weights and measures authority' see PARA 146 note 1 ante.

2 Hallmarking Act 1973 s 9(1). The Trade Descriptions Act 1968 s 26 (as amended) (enforcing authorities: see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 507) applies in relation to the enforcement of the Hallmarking Act 1973 by a local weights and measures authority as it applies in relation to the enforcement of the Trade Descriptions Act 1968: Hallmarking Act 1973 s 9(1).

3 As to the British Hallmarking Council see PARAS 482-484 ante.

4 For the meaning of 'assay office' see PARA 469 ante.

5 Hallmarking Act 1973 s 9(2).

6 Ie the Trade Descriptions Act 1968 s 27 (power to make test purchases), s 28 (as amended) (power to enter premises and inspect and seize goods and documents), s 29 (as amended) (obstruction of authorised officers), s 30 (as amended) (notice of test and intended prosecution), s 31 (evidence by certificate) and s 33 (compensation for loss etc of goods seized): see SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 508 et seq. Any reference in those provisions to a local weights and measures authority and a duly authorised officer of such an authority is to be construed, in relation to the enforcement of the Hallmarking Act 1973, as including respectively a reference to the Council and an assay office and a duly authorised officer of the Council and of an assay office: s 9(4). Section 9(4) excludes from its operation the Trade Descriptions Act 1968 s 30(2), (4), but those provisions are, however, repealed.

7 Hallmarking Act 1973 s 9(3).

8 Ie the Enterprise Act 2002 Pt 8 (ss 210-236) (as amended): see COMPETITION vol 18 (2009) PARA 339 et seq.

9 See the Enterprise Act 2002 (Part 8 Domestic Infringements) Order 2003, SI 2003/1593; and the Enterprise Act 2002 (Part 8 Notice to OFT of Intended Prosecution Specified Enactments, Revocation and Transition Provision) Order 2003, SI 2003/1376. A public authority holding information to which the Enterprise Act 2002 s 237 applies may disclose that information to any person for the purpose of facilitating the exercise of any function that person has by virtue of the Hallmarking Act 1973: see the Enterprise Act 2002 s 241, Sch 15; and COMPETITION vol 18 (2009) PARA 330.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(1) HALLMARKING/(iv) Enforcement of the Statutory Provisions/486. Offences.

#### **486. Offences.**

The Hallmarking Act 1973 makes provision as to the penalty that may be imposed for an offence under the Act where no other penalty is specified<sup>1</sup>. No prosecution for an offence under the Act may be commenced after the expiration of three years from the commission of the offence or one year from its discovery by the prosecutor, whichever is the earlier<sup>2</sup>.

Where the commission by any person of such an offence is due to the act or default of some other person, that other person is guilty of the offence; and a person may be charged with and convicted of the offence by virtue of this provision whether or not proceedings are taken against the first-mentioned person<sup>3</sup>.

Where an offence which has been committed by a body corporate is proved to have been committed with the consent and connivance of, or to be attributable to any neglect on the part of, any director<sup>4</sup>, manager, secretary or other similar officer of the body corporate, or any person who was purporting to act in any such capacity, he as well as the body corporate is guilty of that offence and is liable to be proceeded against and punished accordingly<sup>5</sup>.

Upon the conviction of any person of such an offence, the court may order any article that is the subject of the proceedings to be delivered to an assay office<sup>6</sup> which, subject to the order, may exercise the like powers in relation to the article as if it had been submitted to it for hallmarking<sup>7</sup>.

1 A person guilty of such an offence is liable on conviction on indictment to imprisonment for a term not exceeding two years or a fine or both, or on summary conviction to a fine not exceeding the prescribed sum: see the Hallmarking Act 1973 s 8, Sch 3 para 1 (amended by the Magistrates' Courts Act 1980 s 32(2)). As to the prescribed sum see PARA 141 note 8 ante.

2 Hallmarking Act 1973 Sch 3 para 2(1).

3 Ibid Sch 3 para 4. As to the defences available in proceedings for an offence under s 1 see Sch 3 para 6; and PARA 467 ante. As to the defence of innocent publication of an advertisement see Sch 3 para 5; and PARA 467 note 8 ante.

4 In relation to any body corporate established by or under any enactment for the purpose of carrying on under national ownership any industry or part of an industry or undertaking, being a body corporate whose affairs are managed by its members, 'director' means a member of that body corporate: ibid Sch 3 para 3(2). As to bodies corporate see generally COMPANIES vol 14 (2009) PARA 1; CORPORATIONS.

5 Ibid Sch 3 para 3(1).

6 For the meaning of 'assay office' see PARA 469 ante.

7 Hallmarking Act 1973 s 10(1). Any article delivered to an assay office pursuant to such an order must be returned to the person entitled to it: s 10(2). As to the powers of an assay office in relation to goods delivered to it for hallmarking see PARAS 469-471 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(2) PROOF AND MARKING OF GUN BARRELS/487. Summary of the legislation.

## **(2) PROOF AND MARKING OF GUN BARRELS**

### **487. Summary of the legislation.**

Under the Gun Barrel Proof Acts 1868 to 1978<sup>1</sup>, the Worshipful Company of the Gunmakers of the City of London Proof House and the Guardians of the Birmingham Proof House are required to maintain proof houses in or near London and Birmingham respectively and may provide branch proof houses in any convenient place<sup>2</sup>. All commercially produced gun barrels<sup>3</sup> are required to be proved by one or other of those two companies, which also maintain a register of foreign proof marks<sup>4</sup>. Penalties are imposed for offences in relation to the stamping and marking of barrels and for dealing with small arms not duly proved<sup>5</sup>. The Secretary of State<sup>6</sup> exercises certain supervisory functions<sup>7</sup>.

1 The Gun Barrel Proof Act 1868, the Gun Barrel Proof Act 1950 (both of which are private Acts) and the Gun Barrel Proof Act 1978 may be cited together as the Gun Barrel Proof Acts 1868 to 1978: Gun Barrel Proof Act 1978 s 9(2). The Gun Barrel Proof Act 1978 amends earlier legislation to enable the United Kingdom to accede to the Convention for the Reciprocal Recognition of Proof Marks of Small-arms (Brussels, 1 July 1969; TS 84 (1980); Cmnd 8063). Nearly all countries which manufacture and export sporting weapons and other small arms are signatories to this Convention. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

2 See the Gun Barrel Proof Act 1868 s 4 (amended by the Gun Barrel Proof Act 1978 s 8(1), Sch 3; and the Statute Law (Repeals) Act 1993); and the Gun Barrel Proof Act 1978 s 3.

3 The Gun Barrel Proof Acts 1868 to 1978 do not apply to government firearms: see the Gun Barrel Proof Act 1868 s 119 (amended by the Gun Barrel Proof Act 1978 Sch 3 para 9).

4 As to the register of foreign proof marks held by the Permanent International Commission for the Proof of Small Arms ('convention proof marks') see the Gun Barrel Proof Act 1868 s 129 (substituted by the Gun Barrel Proof Act 1978 s 1(1), Sch 1). As to charges for proving and marking barrels see the Gun Barrel Proof Act 1868 s 118 (amended by the Deregulation (Gun Barrel Proving) Order 1996, SI 1996/1576, so as to remove restrictions on maxima which may be charged). As to exemption of firearms which bear convention proof marks see the Gun Barrel Proof Act 1868 s 130 (substituted by the Gun Barrel Proof Act 1978 Sch 1).

5 See the Gun Barrel Proof Act 1868 s 122 (as amended), s 143 (as amended); the Gun Barrel Proof Act 1978 s 2; and CRIMINAL LAW, EVIDENCE AND PROCEDURE vol 11(1) (2006 Reissue) PARA 355. As to offences in relation to convention proof marks see the Gun Barrel Proof Act 1868 s 131 (substituted by the Gun Barrel Proof Act 1978 Sch 1).

6 Administrative functions under the Gun Barrel Proof Acts 1868 to 1950 had by 1966 devolved on to the Board of Trade and are therefore now exercisable by the Secretary of State. As to the Secretary of State see PARA 14 ante.

7 See the Gun Barrel Proof Act 1868 s 117 (amended by the Gun Barrel Proof Act 1978 ss 5, 8, Sch 3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(3) USE OF ROYAL ARMS/488. Restrictions on use of royal arms.

### (3) USE OF ROYAL ARMS

#### 488. Restrictions on use of royal arms.

A person may not without the authority of Her Majesty use in connection with any business the royal arms (or arms so closely resembling the royal arms as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the royal arms<sup>1</sup>. Nor may a person without the authority of Her Majesty or of a member of the royal family use in connection with any business any device, emblem or title in such a manner as to be calculated to lead to the belief that he is employed by, or supplies goods or services to, Her Majesty or that member of the royal family<sup>2</sup>.

A person who contravenes the above provisions commits an offence and is liable on summary conviction to a fine<sup>3</sup>.

Contravention of the above provisions may be restrained by injunction in proceedings brought by any person who is authorised to use the arms, device, emblem or title in question or any person authorised by the Lord Chamberlain to take such proceedings<sup>4</sup>.

Nothing in the above provisions affects any right of the proprietor of a trade mark containing any such arms, device, emblem or title to use that trade mark<sup>5</sup>.

If any person, in the course of any trade or business, gives, by whatever means, any false indication, direct or indirect, that any goods or services supplied by him or any methods adopted by him are or are of a kind supplied to or approved by Her Majesty or any member of the royal family, he is guilty of an offence<sup>6</sup>.

If any person, in the course of any trade or business, uses, without the authority of Her Majesty, any device or emblem signifying the Queen's Award to Industry or anything so nearly resembling such a device or emblem as to be likely to deceive, he is guilty of an offence<sup>7</sup>.

1 Trade Marks Act 1994 s 99(1). A royal warrant is an intimation from the proper authority representing the Crown that a particular trader has had dealings with the Crown, and is not an exercise of the royal prerogative: *Re Imperial Tobacco Co of Great Britain and Ireland's Trade Marks*[1915] 2 Ch 27, 32 RPC 40; affd [1915] 2 Ch 27 at 41, 32 RPC 361, CA.

2 Trade Marks Act 1994 s 99(2).

3 Ibid s 99(3). The fine must not exceed level 2 on the standard scale: see s 99(3). As to the standard scale see PARA 32 note 13 ante.

4 Ibid s 99(4).

5 Ibid s 99(5). Some trade marks may be lawful, even though they contain the royal arms or devices, emblems or titles within s 99: *Re Imperial Tobacco Co of Great Britain and Ireland's Trade Marks*[1915] 2 Ch 27 at 45, 32 RPC 361 at 369, CA. See also *Royal McBee Corp'n's Applications*[1961] RPC 84.

6 See the Trade Descriptions Act 1968 s 12(1); and SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 493.

7 See ibid s 12(2); and SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARA 493.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(4) USE OF ARMORIAL BEARINGS/489. The Court of Chivalry.

#### **(4) USE OF ARMORIAL BEARINGS**

##### **489. The Court of Chivalry.**

Complaints relating to the usurpation of armorial bearings<sup>1</sup> are dealt with by the Court of Chivalry, which has jurisdiction in matters of dignity and arms as far as they are not cognisable by the ordinary courts<sup>2</sup>.

<sup>1</sup> As to armorial bearings generally see PEERAGES AND DIGNITIES vol 79 (2008) PARA 870 et seq. See also the Trade Marks Act 1994 s 99(5); and PARA 488 ante.

<sup>2</sup> See *Manchester Corp'n v Manchester Palace of Varieties Ltd* [1955] P 133 at 149, [1955] 1 All ER 387 at 393, Court of Chivalry, per Lord Goddard, Surrogate; and PEERAGES AND DIGNITIES vol 79 (2008) PARA 874.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(5) USE OF NATIONAL EMBLEMS AND EMBLEMS OF INTERNATIONAL ORGANISATIONS/490. National emblems etc of Convention countries.

## **(5) USE OF NATIONAL EMBLEMS AND EMBLEMS OF INTERNATIONAL ORGANISATIONS**

### **490. National emblems etc of Convention countries.**

Where the authorisation of the competent authorities of a Convention country<sup>1</sup> is or would be required for the registration of a trade mark<sup>2</sup>, those authorities are entitled to restrain by injunction any use of the mark in the United Kingdom<sup>3</sup> without their authorisation<sup>4</sup>.

1 For the meaning of 'Convention country' see PARA 6 note 2 ante.

2 I.e. by virtue of the Trade Marks Act 1994 s 57 (as amended): see PARA 67 ante. For the meaning of 'trade mark' see PARA 57 ante.

3 For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

4 Trade Marks Act 1994 s 57(6). Nothing in s 57 prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country: see s 57(5); and PARA 67 ante.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(5) USE OF NATIONAL EMBLEMS AND EMBLEMS OF INTERNATIONAL ORGANISATIONS/491. Emblems etc of certain international organisations.

**491. Emblems etc of certain international organisations.**

Where the authorisation of an international organisation is or would be required for the registration of a trade mark<sup>1</sup>, that organisation is entitled to restrain by injunction any use of the mark in the United Kingdom<sup>2</sup> without its authorisation<sup>3</sup>.

1     I.e. by virtue of the Trade Marks Act 1994 s 58 (as amended): see PARA 68 ante. For the meaning of 'trade mark' see PARA 57 ante.

2     For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

3     Trade Marks Act 1994 s 58(4). Nothing in s 58 affects the rights of a person whose bona fide use of the trade mark in question began before 4 January 1962 (when the relevant provisions of the Paris Convention entered into force in relation to the United Kingdom): see the Trade Marks Act 1994 s 58(5); and PARA 68 ante. As to the Paris Convention see PARA 6 ante.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(i) The Olympics Association Right/492. Introduction.

## **(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT**

### **(i) The Olympics Association Right**

#### **492. Introduction.**

The Olympic Symbol etc (Protection) Act 1995 honoured a commitment made to the International Olympic Committee<sup>1</sup> to provide for the protection of the Olympic symbol<sup>2</sup>, the Olympic motto<sup>3</sup> and the protected words<sup>4</sup>. The Act created a right, known as the Olympic association right<sup>5</sup>, which is vested in one or more persons appointed by the Secretary of State<sup>6</sup>, who are thus the proprietors of the right<sup>7</sup>. The right might best be considered as a trade mark created by special Act of Parliament.

1 See 253 HC Official Report (6th series), 3 February 1995, col 1380. The United Kingdom is not party to the Treaty on the Protection of the Olympic Symbol (Nairobi, 26 September 1981).

2 As to the meaning of 'the Olympic symbol' see PARA 493 note 2 post.

3 As to the meaning of 'the Olympic motto' see PARA 493 note 3 post.

4 As to the meaning of 'the protected words' see PARA 493 note 4 post.

5 Olympic Symbol etc (Protection) Act 1995 s 1(1).

6 Ibid s 1(2), (2A)(a) (s 1(2A) added by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 paras 1, 2). An order may make different appointments for different purposes, may make provision for joint or concurrent exercise of rights and may apply (with or without modifications) or make provision similar to a provision of the Trade Marks Act 1994 s 23 (see PARA 128 ante): Olympic Symbol etc (Protection) Act 1995 s 1(2A)(b)-(d) (as so added). An order which revokes a previous order under s 1(2) may contain such supplementary and transitional provision as the Secretary of State thinks fit: s 1(3). A statutory instrument containing such an order is subject to annulment in pursuance of a resolution of either House of Parliament: s 1(4). The persons that have been appointed are the British Olympic Association and the London Organising Committee: see the Olympics and Paralympics Association Rights (Appointment of Proprietors) Order 2006, SI 2006/1119, art 4. As to the London Organising Committee see PARA 500 note 5 post.

7 See the Olympic Symbol etc (Protection) Act 1995 s 2(2). Subject to certain exceptions the Olympic Association right is exercisable by the proprietors jointly or concurrently: see the Olympics and Paralympics Association Rights (Appointment of Proprietors) Order 2006, SI 2006/1119, art 5. In respect of an act which is done, or to be done, in the United Kingdom on or before 31 December 2012 (a 'pre-2013 act'), the right to consent to an act under the Olympic Symbol etc Protection Act 1995 s 2(2)(b) (see PARA 493 post) is exercisable by either proprietor without the consent of the other: Olympics and Paralympics Association Rights (Appointment of Proprietors) Order 2006, SI 2006/1119, arts 2, 6(1). In respect of an act which is done, or to be done, in the United Kingdom on or after 1 January 2013 (a 'post-2012 act'), the right to consent to such an act is exercisable on or before 30 September 2012 by the proprietors jointly not concurrently and after 30 September 2012 by the British Olympic Association not by the London Organising Committee: arts 2, 6(2).

### **UPDATE**

#### **492 Introduction**

TEXT AND NOTE 6--After 'Secretary of State' read 'or the Paymaster General' (in both places): 1995 Act s 1 (amended by the Transfer of Functions (Olympics and Paralympics) Order 2007, SI 2007/2129).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(i) The Olympics Association Right/493. Scope of the Olympics association right.

#### **493. Scope of the Olympics association right.**

The Olympics association right<sup>1</sup> confers exclusive rights in relation to the use of the Olympic symbol<sup>2</sup>, the Olympic motto<sup>3</sup> and the protected words<sup>4</sup>. The rights so conferred are infringed by any act done in the United Kingdom which constitutes infringement<sup>5</sup> and is done without the consent of the proprietor<sup>6</sup>. The proprietor may exploit the rights conferred for gain, but may not make any disposition of, or of any interest in or over, them<sup>7</sup>.

A person infringes the Olympics association right if in the course of trade he uses a representation of the Olympic symbol, the Olympic motto or a protected word, or a representation of something so similar to the Olympic symbol or the Olympic motto as to be likely to create in the public mind an association with it or a word so similar to a protected word as to be likely to create in the public an association with the Olympic Games or the Olympic movement ('a controlled representation')<sup>8</sup>.

A person uses a controlled representation if, in particular, he:

- 610 (1) affixes it to goods or the packaging thereof<sup>9</sup>;
- 611 (2) incorporates it in a flag or banner<sup>10</sup>;
- 612 (3) offers or exposes for sale, puts on the market or stocks for those purposes goods which bear it or whose packaging bears it<sup>11</sup>;
- 613 (4) imports or exports goods which bear it or whose packaging bears it<sup>12</sup>;
- 614 (5) offers or supplies services under a sign which consists of or contains it<sup>13</sup>; or
- 615 (6) uses it on business papers or in advertising<sup>14</sup>.

1    Ie the right created by the Olympic Symbol etc (Protection) Act 1995 s 1(1): see PARA 492 ante. The right carries with it the rights and remedies provided by the Olympic Symbol etc (Protection) Act 1995, which are exercisable by the proprietor: s 1(2). There are two proprietors (see PARA 492 ante); nevertheless, the Act continues to refer to 'the proprietor' in the singular.

2    Ie the symbol of the International Olympic Committee, consisting of five interlocking rings: *ibid* s 18(1).

3    Ie the motto of the International Olympic Committee 'citius, altius, fortius': *ibid* s 18(1). References to the Olympic motto or a protected word include the motto or word in translation into any language: s 18(3).

4    *Ibid* s 2(1). See note 7 *infra*. The protected words are 'Olympiad', 'Olympiads', 'Olympian', 'Olympians', 'Olympic', and 'Olympics': s 18(2)(a) (s 18(2) substituted by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 paras 1, 8). The Secretary of State may by order amend the Olympic Symbol etc (Protection) Act 1995 s 18 (as amended) to reflect a change of motto or symbol of the International Olympic Committee: s 18(5) (s 18(5), (6) added by the London Olympic Games and Paralympic Games Act 2006 Sch 3 paras 1, 9). Such an order may include incidental, consequential or transition provision: Olympic Symbol etc (Protection) Act 1995 s 18(6)(a) (as so added). Such an order must be made by statutory instrument and is subject to annulment pursuant to a resolution of either House of Parliament: s 18(6)(b), (c) (as so added). As to the Secretary of State see PARA 14 ante.

5    Ie under *ibid* s 3: see note 8 *infra*. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

6    *Ibid* s 2(2). Consent given by the proprietor is, subject to its terms, binding on any person subsequently appointed as proprietor: s 2(5). See note 7 *infra*. The proprietor must comply with any directions given by the Secretary of State with respect to the exercise of the rights conferred by the Olympics association right under s 2(1): s 15(1). Such directions may be of a general or particular character, and may be varied or revoked by subsequent directions: s 15(2). A transaction between any person and the proprietor in his capacity as such is not void by reason only that the transaction was carried out in contravention of a direction, and a person

dealing with the proprietor is not concerned to see or inquire whether a direction has been given or complied with: s 15(3).

7 Ibid s 2(3). Section 2 does not have effect to permit the doing of anything which would otherwise be liable to be prevented by virtue of a right subsisting immediately before 20 September 1995 (ie the day on which the Act came into force: Olympic Symbol etc (Protection) Act 1995 (Commencement) Order 1995, SI 1995/2472), or created by the registration of a design under the Registered Designs Act 1949 (see PATENTS AND REGISTERED DESIGNS) on or after 20 September 1995, or the registration of a trade mark under the Trade Marks Act 1994 (see PARA 352 et seq post) on or after that day: Olympic Symbol etc (Protection) Act 1995 s 2(4).

8 Ibid s 3(1) (amended by the London Olympic Games and Paralympic Games Act 2006 Sch 3 paras 1, 3(1)). 'Trade' includes a business or profession: Olympic Symbol etc (Protection) Act 1995 s 18(1).

9 Ibid s 3(2)(a).

10 Ibid s 3(2)(b).

11 Ibid s 3(2)(c).

12 Ibid s 3(2)(d).

13 Ibid s 3(2)(e).

14 Ibid s 3(2)(f).

## **UPDATE**

### **493 Scope of the Olympics association right**

NOTES 4, 6--After 'Secretary of State' read 'or the Paymaster General' (in both places): 1995 Act ss 15, 18 (amended by the Transfer of Functions (Olympics and Paralympics) Order 2007, SI 2007/2129).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(i) The Olympics Association Right/494. Limits on the Olympics association right.

#### **494. Limits on the Olympics association right.**

The Olympics association right<sup>1</sup> is not infringed by the use of a controlled representation<sup>2</sup> in publishing or broadcasting a report of a sporting or other event forming part of the Olympic Games or information about the Olympic Games<sup>3</sup>, nor is it infringed by the use of a controlled representation in an advertisement for a publication or broadcast of such a kind<sup>4</sup>. These exceptions do not apply to advertising material which is published or broadcast at the same time as, or in connection with, a report or information<sup>5</sup>.

The London Olympics association right is also not infringed by the use of a controlled representation as an incidental inclusion in a literary work<sup>6</sup>, dramatic work<sup>7</sup>, artistic work<sup>8</sup>, sound recording<sup>9</sup>, film<sup>10</sup> or broadcast<sup>11</sup>.

The Olympics association right is not infringed by use of a controlled representation in a context which is not likely to suggest an association between a person, product or service and the Olympic Games or the Olympic movement<sup>12</sup>. For this purpose, the concept of an association between a person, product or service and the Olympic Games or the Olympic movement includes, in particular: (1) any kind of contractual relationship<sup>13</sup>; (2) any kind of commercial relationship<sup>14</sup>; (3) any kind of corporate or structural connection<sup>15</sup>; and (4) the provision by a person of financial or other support for or in connection with the Olympic Games or the Olympic movement<sup>16</sup>. A person does not suggest an association between a person, product or service and the Olympic Games or the Olympic movement only by making a statement which accords with honest practices in industrial or commercial matters and does not make promotional or other commercial use of a protected word by incorporating it in a context to which the Olympics Games and the Olympic movement are substantively irrelevant<sup>17</sup>.

The Olympics association right is also not infringed by use of a controlled representation in relation to goods if:

- 616 (a) the goods have been put on the market in the European Economic Area by the proprietor or with his consent<sup>18</sup>;
- 617 (b) the representation was used in relation to the goods when they were put on the market<sup>19</sup>; and
- 618 (c) the proprietor does not oppose further dealings in the goods for legitimate reasons (including, in particular, that the condition of the goods has been changed or impaired after they were put on the market)<sup>20</sup>.

The Olympics association right is not infringed by use of a controlled representation where the use is for the purposes of an undertaking, and the way in which the representation is used for the purposes of the undertaking is a way in which it has been continuously used for those purposes since a date prior to 20 September 1995<sup>21</sup>.

In the case of a representation of a protected word, the Olympics association right is not infringed by use as part of the name of a company, being a name which was the company's corporate name immediately before 20 September 1995, or the name under which a business is carried on, being a business which was carried on under that name immediately before 20 September 1995<sup>22</sup>.

The Olympics association right is not infringed by use of a controlled representation where the use takes place under a right subsisting immediately before 20 September 1995, or is liable to be prevented by virtue of such a right<sup>23</sup>.

The Olympics association right is not infringed by use of a controlled representation where the use takes place under a right created by the registration of a design<sup>24</sup> on or after 20 September 1995, or the registration of a trade mark<sup>25</sup> on or after that day, or is liable to be prevented by virtue of such a right<sup>26</sup>.

The Olympics association right is not infringed by use of a controlled representation for the purposes of judicial or parliamentary proceedings, or a Royal Commission or statutory inquiry<sup>27</sup>.

The Secretary of State<sup>28</sup> may by order made by statutory instrument specify additional cases in which the Olympics association right is not infringed<sup>29</sup>. The matters by reference to which a case may be specified include the description of controlled representation used, and the description of persons by whom a controlled representation is used<sup>30</sup>.

1    le the right created by the Olympic Symbol etc (Protection) Act 1995 s 1(1): see PARAS 492-493 ante.

2    As to the meaning of 'controlled representation' see PARA 493 ante.

3    Olympic Symbol etc (Protection) Act 1995 s 4(1)(a), (b) (s 4(1)-(5) substituted by the London Olympic Games and Paralympic Games Act 2006 s 32(1), Sch 3 paras 1, 4).

4    Olympic Symbol etc (Protection) Act 1995 s 4(1)(d) (as substituted: see note 3 supra).

5    Ibid s 4(2) (as substituted: see note 3 supra).

6    For the meaning of 'literary work' see the Copyright, Designs and Patents Act 1988 s 3(1); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 67.

7    For the meaning of 'dramatic work' see ibid s 3(1); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 73.

8    For the meaning of 'artistic work' see ibid 4(1); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 75.

9    For the meaning of 'sound recording' see ibid ss 5A, 135A (as added); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARAS 84, 195.

10   For the meaning of 'film' see ibid s 5B (as added); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 86.

11   Olympic Symbol etc (Protection) Act 1995 s 4(1)(c) (as substituted: see note 3 supra). For the meaning of 'broadcast' see the Copyright, Designs and Patents Act 1988 s 6; and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 89.

12   Olympic Symbol etc (Protection) Act 1995 s 4(3) (as substituted: see note 3 supra). The Secretary of State may by order specify what is to be or not to be treated for this purpose as an association between a person, product or service and the Olympic Games or the Olympic movement: s 4(4) (as so substituted). Such an order may include incidental, consequential or transitional provision (which may include provision amending s 4(3) (as substituted) (see notes 13-16 infra)): s 4(4)(a) (as so substituted). Such an order must be made by statutory instrument and may not be made unless a draft has been laid before and approved by resolution of each House of Parliament: s 4(4)(b), (c) (as so substituted).

13   Ibid s 4(3)(a)(i) (as substituted: see note 3 supra).

14   Ibid s 4(3)(a)(ii) (as substituted: see note 3 supra).

15   Ibid s 4(3)(a)(iii) (as substituted: see note 3 supra).

16   Ibid s 4(3)(a)(iv) (as substituted: see note 3 supra).

17   Ibid s 4(3)(b) (as substituted: see note 3 supra).

18 Ibid s 4(5)(a) (as substituted: see note 3 supra). As to the European Economic Area see PARA 102 ante.

19 Ibid s 4(5)(b) (as substituted: see note 3 supra).

20 Ibid s 4(5)(c) (as substituted: see note 3 supra).

21 Ibid s 4(11). In the application of s 4(11)-(14) to the Olympic Association right as it has effect by virtue of the amendment to the Olympic Symbol etc (Protection) Act 1995 s 3(1)(b) made by the London Olympic Games and Paralympic Games Act 2006 Sch 3 para 3(1), a reference to the commencement of the Act is to be treated as a reference to the commencement of that sub-paragraph (ie 30 March 2006): London Olympic Games and Paralympic Games Act 2006 Sch 3 para 3(2).

22 Olympic Symbol etc (Protection) Act 1995 s 4(12). See note 21 supra. 'Business' includes a trade or profession: s 18(1).

23 Ibid s 4(13). See note 21 supra.

24 Ie under the Registered Designs Act 1949.

25 Ie under the Trade Marks Act 1994.

26 Olympic Symbol etc (Protection) Act 1995 s 4(14). See note 21 supra.

27 Ibid s 4(15). 'Judicial proceedings' includes proceedings before any court, tribunal or person having authority to decide any matter affecting a person's legal rights or liabilities; 'Parliamentary proceedings' includes proceedings of the European Parliament; and 'statutory inquiry' means an inquiry held or investigation conducted in pursuance of a duty imposed or power conferred by or under an enactment: s 4(16).

28 As to the Secretary of State see PARA 14 ante.

29 Olympic Symbol etc (Protection) Act 1995 s 5(1). Such an order may contain such supplementary and transitional provision and savings as the Secretary of State thinks fit: s 5(3). Such an order is subject to annulment pursuant to a resolution of either House of Parliament: s 5(4) (added by the London Olympic Games and Paralympic Games Act 2006 Sch 3 paras 1, 5). At the date at which this volume states the law, no such order had been made.

30 Olympic Symbol etc (Protection) Act 1995 s 5(2).

## **UPDATE**

### **494 Limits on the Olympics association right**

TEXT AND NOTES 12, 29--After 'Secretary of State' read 'or the Paymaster General' (in both places): 1995 Act ss 4, 5 (amended by the Transfer of Functions (Olympics and Paralympics) Order 2007, SI 2007/2129).

NOTE 27--1995 Act s 4(16) amended: SI 2007/1388.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(i) The Olympics Association Right/495. Infringement of the Olympics association right; proceedings and remedies.

#### **495. Infringement of the Olympics association right; proceedings and remedies.**

An infringement of the Olympics association right<sup>1</sup> is actionable by the proprietor<sup>2</sup>. In an action for infringement, all such relief by way of damages, injunctions, accounts or otherwise is available to the proprietor as is available in respect of the infringement of a property right<sup>3</sup>.

If in any civil proceedings a question arises as to the use to which a controlled representation has been put, it is for the proprietor to show what use was made of it<sup>4</sup>. If in any civil proceedings a question arises as to the application of any of the provisions relating to the circumstances in which the Olympic association right is not infringed<sup>5</sup>, it is for the person who alleges that the provision applies to show that it does<sup>6</sup>.

1 As to the Olympics association right see PARAS 492-493 ante.

2 Olympic Symbol etc (Protection) Act 1995 s 6(1). As to the proprietor see PARA 492 ante. Where the action is only in respect of a pre-2013 act, the right of the proprietor to bring an action for infringement is exercisable by either the British Olympic Association or the London Organising Committee: Olympics and Paralympics Association Rights (Appointment of Proprietors) Order 2006, SI 2006/1119, art 7(1)(a). In such a case the proprietor that brings the action may not, without the leave of the court, proceed with the action unless the other proprietor is either joined as a claimant or added as a defendant: art 7(2). A proprietor who is added as a defendant will not be made liable for any costs in the action unless it takes part in the proceedings: art 7(3). Article 7(2) does not affect the granting of interim relief on the application of a single proprietor: art 7(4). Where the action is in respect of a post-2012 act, the right of the proprietor to bring an action for infringement is exercisable by the British Olympic Association and not by the London Organising Committee: art 7(1)(b). For the meanings of 'pre-2013 act' and 'post-2012 act' see PARA 492 note 7 ante.

3 Olympic Symbol etc (Protection) Act 1995 s 6(2). The Secretary of State has made, in relation to infringing goods, material and articles, provision corresponding to that made by the Trade Marks Act 1994 ss 15, 16, 18-20 (remedies for infringement: see PARAS 446, 461-463 ante) in relation to goods, material and articles which are infringing goods, material and articles for the purposes of that Act: Olympic Symbol etc (Protection) Act 1995 s 7(1), (5); Olympics Association Right (Infringement Proceedings) Regulations 1995, SI 1995/3325. As to the Secretary of State see PARA 14 ante. Goods are 'infringing goods' if they or their packaging bear a controlled representation, and: (1) the application of the representation to the goods or their packaging was an infringement of the Olympics association right; (2) the goods are proposed to be imported into the United Kingdom and the application of the representation in the United Kingdom to them or their packaging would be an infringement of that right; or (3) the representation has otherwise been used in relation to the goods in such a way as to infringe that right: Olympic Symbol etc (Protection) Act 1995 s 7(2). Nothing in s 7(2) is to be construed as affecting the importation of goods which may lawfully be imported into the United Kingdom by virtue of an enforceable Community right: s 7(6). Material is 'infringing material' if it bears a controlled representation, and either it is used for labelling or packaging goods, as a business paper, or for advertising goods or services or by being displayed, in such a way as to infringe the Olympics association right, or it is intended to be so used and such use would infringe that right: s 7(3) (amended by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 paras 1, 10). Articles are 'infringing articles' if they are articles which are specifically designed or adapted for making copies of a controlled representation, and which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material: Olympic Symbol etc (Protection) Act 1995 s 7(4).

4 Ibid s 17(1).

5 Ie under ibid s 4(1), (3), (5), (11)-(15) or s 5 (as amended): see PARA 494 ante.

6 Ibid s 17(2).

#### **UPDATE**



**495 Infringement of the Olympics association right; proceedings and remedies**

NOTE 3--After 'Secretary of State' read 'or the Paymaster General': 1995 Act s 7 (amended by the Transfer of Functions (Olympics and Paralympics) Order 2007, SI 2007/2129).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(i) The Olympics Association Right/496. Detention by Her Majesty's Revenue and Customs.

#### **496. Detention by Her Majesty's Revenue and Customs.**

The proprietor<sup>1</sup> may give notice<sup>2</sup> in writing to the Commissioners for Her Majesty's Revenue and Customs stating that at a time and place specified in the notice, goods which are infringing goods, material or articles<sup>3</sup> are expected to arrive in the United Kingdom from outside the European Economic Area ('EEA') or from within the EEA but not having been entered for free circulation<sup>4</sup>; specifying the nature of the controlled representation<sup>5</sup> by reference to which the goods are infringing goods, material or articles<sup>6</sup>; and requesting the Commissioners to detain the goods<sup>7</sup>.

The Commissioners may detain goods where they have received such a notice<sup>8</sup> but may not detain goods imported by a person for his private and domestic use or to which provisions of the Trade Marks Act 1994<sup>9</sup> apply<sup>10</sup>.

If the Commissioners do detain goods where they have received such a notice<sup>11</sup> they must, as soon as is reasonably practicable, give written notice of the detention and the grounds for it to the person in whose name the goods were presented or declared to customs<sup>12</sup>. The Commissioners must also, as soon as is reasonable practicable, give the proprietor notice that the goods have been detained, specifying in respect of the goods such information as is available to the Commissioners about the nature of the goods, their number, the place where they were manufactured, the place from which they were sent, the name and address of the person by whom they were sent, the name and address of the person who was given the written notice<sup>13</sup>, the name and address of the person to whom they were to be delivered, and the name and address of the person who holds them during detention<sup>14</sup>.

The Commissioners must release goods so detained<sup>15</sup> if:

- 619 (1) they think that initiating process in proceedings<sup>16</sup> in respect of the goods has not been served during the period of ten working days<sup>17</sup>, in the case of non-perishable goods, or three working days, in the case of perishable goods, beginning with the date on which the notice that the goods had been detained<sup>18</sup> was received<sup>19</sup>;
- 620 (2) they think that proceedings in respect of the goods<sup>20</sup> have been withdrawn, have lapsed or have terminated without an order being made<sup>21</sup> in respect of the goods<sup>22</sup>; or
- 621 (3) they are informed by the proprietor that the goods are not infringing goods, material or articles<sup>23</sup>.

The Commissioners may also detain goods which they think, having regard to the nature of the goods and to information provided by the proprietor, may be infringing goods, material or articles<sup>24</sup>. If the Commissioners do detain such goods they must, as soon as is reasonably practicable, invite the proprietor to give them a notice that the goods are infringing goods, material or articles<sup>25</sup>. When giving such an invitation<sup>26</sup>, the Commissioners must give in respect of the goods such information as is available to them about the nature of the goods, their number, the place where they were manufactured, the place from which they were sent, the name and address of the person by whom they were sent, the name and address of the person in whose name the goods were presented or declared to customs, the name and address of the person to whom they were to be delivered, and the name and address of the person who holds

them during detention<sup>27</sup>. If no such notice is given<sup>28</sup> within the period of three working days beginning with the date on which the invitation is received, the Commissioners must release the goods<sup>29</sup>.

The Commissioners may provide samples of detained goods to the proprietor on request, in which case he: (a) may use the samples only for the purpose of determining whether they are infringing goods, material or articles; (b) must return the samples to the Commissioners as soon as is reasonably practicable; and (c) must inform the Commissioners as soon as reasonably practicable whether the goods are infringing goods, material or articles<sup>30</sup>.

The Commissioners may permit the proprietor on request to inspect detained goods<sup>31</sup>, in which case the proprietor must inform the Commissioners as soon as is reasonably practicable whether the goods are infringing goods, material or articles<sup>32</sup>.

1 As to the proprietor see PARA 492 ante.

2 The Commissioners may make regulations prescribing the form in which the notice is to be given and requiring a person giving notice: (1) to furnish the Commissioners with such evidence as may be specified in the regulations, either on giving notice or when the goods are imported, or at both those times; and (2) to comply with such other conditions as may be specified in the regulations: Trade Marks Act 1994 s 90(1); Olympic Symbol etc (Protection) Act 1995 s 12B(1) (s 12B added by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 paras 1, 14). The regulations may, in particular, require a person giving such a notice: (a) to pay such fees in respect of the notice as may be specified by the regulations; (b) to give such security as may be so specified in respect of any liability or expense which the Commissioners may incur in consequence of the notice by reason of the detention of any goods or anything done to goods detained; (c) to indemnify the Commissioners against any such liability or expense, whether security has been given or not: Trade Marks Act 1994 s 90(2); Olympic Symbol etc (Protection) Act s 12B(1) (as so added). The regulations may make different provision as respects different classes of case to which they apply and may include such incidental and supplementary provisions as the Commissioners consider expedient: Trade Marks Act 1994 s 90(3); Olympic Symbol etc (Protection) Act s 12B(1) (as so added). Such regulations must be made by statutory instrument subject to annulment in pursuance of a resolution of either House of Parliament: Trade Marks Act 1994 s 90(4); Olympic Symbol etc (Protection) Act s 12B(1) (as so added). As to the prescribed forms of the notices see the Goods Infringing the Olympics and Paralympics Association Rights (Customs) Regulations 2007, SI 2007/1508, which also require a person giving such a notice to indemnify the Commissioners.

3 As to infringing goods, material or articles see PARA 495 note 3 ante.

4 Olympic Symbol etc (Protection) Act 1995 s 12A(1)(a) (s 12A added by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 paras 1, 14). As to the European Economic Area see PARA 102 ante.

5 Olympic Symbol etc (Protection) Act 1995 s 12A(1)(b) (as added: see note 4 supra).

6 For the meaning of 'controlled representation' see PARA 493 ante.

7 Olympic Symbol etc (Protection) Act 1995 s 12A(1)(c) (as added: see note 4 supra). The provisions of the Customs and Excise Management Act 1979 s 139(1)-(4), (7) (see CUSTOMS AND EXCISE vol 12(2) (2007 Reissue) PARA 1155) apply in relation to goods liable to detention in accordance with the Olympic Symbol etc (Protection) Act 1995 s 12A (as added) as in relation to things liable to forfeiture with the substitution of a reference to the Olympic Symbol etc (Protection) Act 1995 for reference to the customs and excise Acts and with any other necessary modifications: Olympic Symbol etc (Protection) Act 1995 s 12B(3) (as added: see note 2 supra). The Customs and Excise Management Act 1979 s 144 applies in relation to the detention of goods in accordance with Olympic Symbol etc (Protection) Act 1995 s 12A (as added) with the substitution of a reference to proceedings under s 6 for the reference in the Customs and Excise Management Act 1979 s 144 to proceedings for condemnation and with any other necessary modifications: Olympic Symbol etc (Protection) Act 1995 s 12A(4) (as so added). See CUSTOMS AND EXCISE.

8 Ibid s 12A(2) (as added: see note 4 supra). The text refers to a notice under s 12A(1) (as added): see the text and notes 1-7 supra.

9 I.e. the Trade Marks Act 1994 s 89(3): see PARA 149 ante.

10 Olympic Symbol etc (Protection) Act 1995 s 12A(3) (as added: see note 4 supra).

11 I.e. a notice under ibid s 12A(1) (as added): see the text and notes 1-7 supra.

12 Ibid s 12A(4)(a) (as added: see note 4 supra).

13 Ie the person mentioned in ibid s 12A(4)(a) (as added): see the text to note 12 supra.

14 Ibid s 12A(4)(b) (as added: see note 4 supra). A person who is or was an officer or employee of the proprietor, or who acts or acted on the proprietor's behalf, commits an offence if he discloses information provided in accordance with s 12A(4)(b) (as added) or s 12A(8)(b) (as added) (see the text to note 27 infra) other than: (1) for the purpose of, or with a view to the institution of, proceedings under s 6 (see PARA 495 ante); (2) for the purpose of complying with an enactment; (3) in pursuance of an order of a court; (4) in a form which ensures that the identity of no person to whom the information relates is specified or can be deduced; (5) with the consent of each person to whom the information relates; or (6) with the consent of the Commissioners for Her Majesty's Revenue and Customs: s 12B(2) (as added: see note 2 supra). It is a defence for a person charged with an offence under s 12B(2) (as added) of disclosing information to prove that he reasonably believed that the disclosure was lawful, or that the information had already and lawfully been made available to the public: Commissioners for Revenue and Customs Act 2005 s 19(3); Olympic Symbol etc (Protection) Act 1995 s 12B(2) (as so added). A person guilty of an offence under s 12B(2) (as added) is liable on conviction on indictment to imprisonment for a term not exceeding two years or a fine or both, or on summary conviction to imprisonment for a term not exceeding 12 months or a fine not exceeding the statutory maximum or both: Commissioners for Revenue and Customs Act 2005 s 19(4); Olympic Symbol etc (Protection) Act 1995 s 12B(2) (as so added). Until the commencement of the Criminal Justice Act 2003 s 282 the reference in the Commissioners for Revenue and Customs Act 2005 s 19 to 12 months has effect as if it were a reference to 6 months: see s 55(1); Olympic Symbol etc (Protection) Act 1995 s 12B(2) (as so added). See CRIMINAL LAW, EVIDENCE AND PROCEDURE vol 11(3) (2006 Reissue) PARA 1121. See also CUSTOMS AND EXCISE.

15 Ie goods detained in pursuance of a notice under ibid s 12A(1) (as added): see the text and notes 1-7 supra.

16 The proceedings referred to in the text are proceedings under ibid s 6 (see PARA 495 ante).

17 'Working day' means a day that is not a Saturday, a Sunday or a bank holiday within the meaning of the Banking and Financial Dealings Act 1971 s 1 (see TIME vol 97 (2010) PARA 321); Olympic Symbol etc (Protection) Act 1995 s 12B(5) (as added: see note 2 supra).

18 The text refers to a notice under ibid s 12A(4)(b) (as added) (see the text to note 14 supra) that the goods had been detained.

19 Ibid s 12A(7)(a) (as added: see note 4 supra).

20 The text refers to proceedings under ibid s 6 (see PARA 495 ante).

21 The text refers to an order under ibid s 7 (see PARA 495 ante).

22 Ibid s 12A(7)(b) (as added: see note 4 supra).

23 Ibid s 12A(7)(c) (as added: see note 4 supra).

24 Ibid s 12A(8) (as added: see note 4 supra).

25 Ibid s 12A(8)(a) (as added: see note 4 supra).

26 Ie an invitation under ibid s 12A(8)(a) (as added): see the text to note 25 supra.

27 Ibid s 12A(8)(b) (as added: see note 4 supra). See note 14 supra.

28 Ie in accordance with ibid s 12A(8)(a) (as added): see the text to note 25 supra.

29 Ibid s 12A(8)(e) (as added: see note 4 supra). If a notice is given in accordance with s 12A(8)(a) (as added) (see the text to note 25 supra), the Commissioners must proceed as if it were a notice given under s 12A(1) (as added) (see the text and notes 1-7 supra) (and as if the goods were detained in pursuance of that notice), but s 12A(4)(b), (5), (6) (as added) do not have effect, and s 12A(7) (as added) has effect as if the reference to the notice under s 12A(4)(b) (as added) were a reference to information under s 12A(8)(b): s 12A(8)(f) (as so added).

30 Ibid s 12A(5), (8)(c) (as added: see note 4 supra).

31 Ibid s 12A(6), (8)(d) (as added: see note 4 supra). The text refers to goods detained under s 12A(1) (as added) (see the text and notes 1-7 supra) or s 12A(8) (as added).

32 Ibid s 12A(6), (8)(d) (as added: see note 4 supra).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(i) The Olympics Association Right/497. Remedy for groundless threats.

#### **497. Remedy for groundless threats.**

Where the proprietor<sup>1</sup> threatens another with proceedings for infringement of the Olympics association right<sup>2</sup> other than the application to goods or their packaging of a controlled representation<sup>3</sup>, the importation of goods to which, or to the packaging of which, such a representation has been applied, or the supply of services under a sign which consists of or contains such a representation, any person aggrieved may bring proceedings for relief<sup>4</sup>.

The relief which may be applied for is any of the following: (1) a declaration that the threats are unjustifiable; (2) an injunction against the continuance of the threats; and (3) damages in respect of any loss he has sustained by the threats<sup>5</sup>.

A claimant is entitled to the relief applied for unless the defendant shows that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the Olympics association right<sup>6</sup>.

1 As to the proprietor see PARA 492 ante. There is nothing to stop persons other than the proprietor from making groundless threats for infringement of the Olympics association right.

2 As to the Olympics association right see PARAS 492-493 ante.

3 As to the meaning of 'controlled representation' see PARA 493 ante.

4 Olympic Symbol etc (Protection) Act 1995 s 16(1). The mere notification of the rights conferred by the Olympic Symbol etc (Protection) Act 1995 does not constitute a threat of proceedings: s 16(4). See also PARA 123 note 1 ante.

5 Ibid s 16(2).

6 Ibid s 16(3).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(i) The Olympics Association Right/498. Offences.

#### **498. Offences.**

A person who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor:

- 622 (1) applies a controlled representation<sup>1</sup> to goods or their packaging<sup>2</sup>;
- 623 (2) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a representation<sup>3</sup>; or
- 624 (3) has in his possession, custody or control in the course of a business<sup>4</sup> any such goods with a view to the doing of anything, by himself or another, which would be an offence under head (2) above<sup>5</sup>,

is guilty of an offence<sup>6</sup>.

A person who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor:

- 625 (a) applies a controlled representation to material intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods<sup>7</sup>;
- 626 (b) uses in the course of a business material bearing such a representation for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods<sup>8</sup>; or
- 627 (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under head (b) above<sup>9</sup>,

is guilty of an offence<sup>10</sup>.

A person who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor:

- 628 (i) makes an article specifically designed or adapted for making copies of a controlled representation<sup>11</sup>; or
- 629 (ii) has such an article in his possession, custody or control in the course of a business<sup>12</sup>,

knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, is guilty of an offence<sup>13</sup>.

It is a defence for a person charged with an offence under any of the above provisions to show that he believed on reasonable grounds that the use of the representation in the manner in which it was used, or was to be used, was not an infringement of the Olympics association right<sup>14</sup>.

A person guilty of an offence under any of the above provisions is liable on conviction to a fine<sup>15</sup>.

The statutory provisions<sup>16</sup> under the Trade Marks Act 1994 relating to offences committed by partnerships and bodies corporate apply in relation to an offence under the Olympic Symbol etc (Protection) Act 1995 as they do to an offence under the Trade Marks Act 1994<sup>17</sup>.

The statutory provisions<sup>18</sup> providing for the forfeiture of certain goods, material or articles which come into the possession of any person in connection with the investigation or prosecution of an under the Trade Marks Act 1994 also have effect in relation to offences under the Olympic Symbol etc (Protection) Act 1995 with certain modifications<sup>19</sup>.

1 For the meaning of 'controlled representation' see PARA 493 ante.

2 Olympic Symbol etc (Protection) Act 1995 s 8(1)(a).

3 Ibid s 8(1)(b).

4 For the meaning of 'business' see PARA 494 note 22 ante.

5 Olympic Symbol etc (Protection) Act 1995 s 8(1)(c).

6 Ibid s 8(1). A local weights and measures authority may enforce within its area the provisions of s 8; and the Trade Descriptions Act 1968 s 27 (power to make test purchases), s 28 (power to enter premises and inspect and seize goods and documents), s 29 (obstruction of authorised officers) and s 33 (compensation for loss etc of goods seized) apply in relation to the enforcement of the Olympic Symbol etc (Protection) Act 1995 s 8 as in relation to the enforcement of the Trade Descriptions Act 1968: Olympic Symbol etc (Protection) Act 1995 s 8A(1), (2) (s 8A added by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 paras 1, 12). See SALE OF GOODS AND SUPPLY OF SERVICES vol 41 (2005 Reissue) PARAS 508-509, 511.

7 Olympic Symbol etc (Protection) Act 1995 s 8(2)(a).

8 Ibid s 8(2)(b).

9 Ibid s 8(2)(c).

10 Ibid s 8(2). See note 6 supra.

11 Ibid s 8(3)(a).

12 Ibid s 8(3)(b).

13 Ibid s 8(3). See note 6 supra.

14 Ibid s 8(4). As to the Olympics association right see PARAS 492-493 ante.

15 Ibid s 8(5). Such a person is liable on summary conviction to a fine not exceeding the statutory maximum (except during the period beginning on 1 May 2006 and ending on 31 December 2012, when he is liable on summary conviction to a fine not exceeding £20,000), and on conviction on indictment to a fine: see s 8(5); and the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 para 11. As to the statutory maximum see PARA 141 note 6 ante. As to offences committed by partnerships and bodies corporate see PARA 139 ante.

16 Ie the Trade Marks Act 1994 s 101: see PARA 139 ante.

17 Olympic Symbol etc (Protection) Act 1995 s 10.

18 Ie the Trade Marks Act 1994 s 97: see PARA 140 ante.

19 Olympic Symbol etc (Protection) Act 1995 s 11(1). As to the modifications (the main effect of which is to substitute references to 'controlled representation' for 'sign identical to or likely to be mistaken for a registered trade mark') see s 11(2)-(4).



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(ii) The Paralympics Association Right/499. The Paralympics association right.

## **(ii) The Paralympics Association Right**

### **499. The Paralympics association right.**

There is a right known as the Paralympics association right<sup>1</sup>. This right protects the Paralympic symbol<sup>2</sup>, the Paralympic motto<sup>3</sup> and the protected words in relation to the Paralympics association right<sup>4</sup> in the same way as the Olympic association right protects the Olympic symbol, the Olympic motto and the protected words in relation to the Olympics association right<sup>5</sup>.

<sup>1</sup> Olympic Symbol etc (Protection) Act 1995 s 5A(1) (added by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 para 6).

<sup>2</sup> ie the symbol of the International Paralympic Committee: Olympic Symbol etc (Protection) Act 1995 s 18(1) (amended by the London Olympic Games and Paralympic Games Act 2006 Sch 3 para 7).

<sup>3</sup> ie the motto of International Paralympic Committee 'spirit in motion': Olympic Symbol etc (Protection) Act 1995 s 18(1) (amended by the London Olympic Games and Paralympic Games Act 2006 Sch 3 para 7).

<sup>4</sup> The protected words in relation to the Paralympics association right are 'Paralympiad', 'Paralympiads', 'Paralympian', 'Paralympians', 'Paralympic' and 'Paralympics': Olympic Symbol etc (Protection) Act 1995 s 18(2) (b) (amended by the London Olympic Games and Paralympic Games Act 2006 Sch 3 para 8).

<sup>5</sup> The provisions of the Olympic Symbol etc (Protection) Act 1995 apply in relation to the Paralympics association right as they apply to the Olympics association right; and for this purpose references to the Olympic Games, Olympic motto, Olympic movement and Olympic symbol are to be treated as references to the Paralympic Games, Paralympic motto, Paralympic movement and Paralympic symbol respectively; and references to the commencement of the Olympic Symbol etc (Protection) Act 1995 are to be treated as references to the commencement of the London Olympic Games and Paralympic Games Act 2006: Olympic Symbol etc (Protection) Act 1995 s 5A(2) (added by the London Olympic Games and Paralympic Games Act 2006 s 32, Sch 3 para 6). The proprietors of the Paralympics association right are the British Paralympic Association and the London Organising Committee: Olympics and Paralympics Association Rights (Appointment of Proprietors) Order 2006, SI 2006/1119, art 8.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(iii) The London Olympics Association Right/500. Introduction.

### **(iii) The London Olympics Association Right**

#### **500. Introduction.**

There is a right known as the London Olympics association right<sup>1</sup>. This right protects the London Olympics<sup>2</sup>. It is similar in many respects to the Olympics association right<sup>3</sup>, but it has a broader scope<sup>4</sup>. The proprietor of the London Olympics association right is the London Organising Committee<sup>5</sup>.

1 London Olympic Games and Paralympic Games Act 2006 s 33, Sch 4 para 1(1).

2 The Games of the Thirtieth Olympiad that are to take place in 2012 and the Paralympic Games that are to take place in that year: London Olympic Games and Paralympic Games Act 2006 s 1(1).

3 For the meaning of the 'Olympics Association right' see PARA 493 note 1 ante.

4 See PARA 501 post.

5 See the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(2)(b). The London Organising Committee is the organising committee formed in accordance with s 2 of the Host City Contract as the company limited by guarantee registered as the London Organising Committee of the Olympic Games Ltd ('LOCOG'): s 1(3)(d). The Host City Contract is the contract for the Games of the Thirtieth Olympiad that are to take place in 2012, signed at Singapore on 6 July 2005 and entered into by the International Olympic Committee, the Mayor of London and the British Olympic Association: London Olympic Games and Paralympic Games Act 2006 s 1(3)(e).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(iii) The London Olympics Association Right/501. Scope of the London Olympics association right.

### **501. Scope of the London Olympics association right.**

The London Olympics association right<sup>1</sup> confers exclusive rights in relation to the use of any representation, of any kind, in a manner likely to suggest to the public that there is an association between the London Olympics<sup>2</sup> and goods or services or a person who provides goods or services<sup>3</sup>. For these purposes, the concept of an association between a person, goods or a service and the London Olympics includes, in particular, any kind of contractual relationship, any kind of commercial relationship, any kind of corporate or structural connection and the provision by a person of financial or other support for or in connection with the London Olympics<sup>4</sup>. However, a person does not suggest an association between a person, goods or a service and the London Olympics only by making a statement which accords with honest practices in industrial or commercial matters and which does not make promotional or other commercial use of a representation relating to the London Olympics by incorporating it in a context to which the London Olympics are substantively irrelevant<sup>5</sup>. The Secretary of State may by order made by statutory instrument specify what is to be or not to be treated for these purposes as an association between a person, goods or a service and the London Olympics<sup>6</sup>. The rights so conferred are infringed by any act done in the United Kingdom which constitutes infringement<sup>7</sup> and is done without the consent of the proprietor<sup>8</sup>. The proprietor may exploit the rights conferred for gain, but may not make any disposition of, or of any interest in or over, them<sup>9</sup>.

A person infringes the London Olympic association right if in the course of trade he uses in relation to goods or services any representation, of any kind, in a manner likely to suggest to the public that there is an association between the London Olympics and the goods or services or a person who provides the goods or services<sup>10</sup>. For the purpose of considering whether a person has infringed the London Olympics association right a court may, in particular, take account of his use of a specified combination of expressions<sup>11</sup>. The specified combinations are combinations of any of the expressions in a first group with any of the expressions in a second group or any other expression in the first group<sup>12</sup>. The first group consists of 'games', 'Two Thousand and Twelve', '2012' and 'twenty twelve'<sup>13</sup>. The second groups consists of 'gold', 'silver', 'bronze', 'London', 'medals', 'sponsor' and 'summer'<sup>14</sup>. It is immaterial for these purposes whether or not a word is written wholly or partly in capital letters<sup>15</sup>. The Secretary of State may by order made by statutory instrument add, remove or vary an entry in either group of expressions<sup>16</sup>, but an order which adds or varies an entry may be made only if the Secretary of State thinks it necessary in order to prevent commercial exploitation of the London Olympics<sup>17</sup>.

A person uses a visual or verbal representation likely to create in the public mind an association between the London Olympics and goods or services or a provider of goods or services (a 'controlled representation'<sup>18</sup>) if, in particular, he:

- 630 (1) affixes it to goods or the packaging thereof<sup>19</sup>;
- 631 (2) incorporates it in a flag or banner<sup>20</sup>;
- 632 (3) offers or exposes for sale, puts on the market or stocks for those purposes goods which bear it or whose packaging bears it<sup>21</sup>;
- 633 (4) imports or exports goods which bear it or whose packaging bears it<sup>22</sup>;
- 634 (5) offers or supplies services under a sign which consists of or contains it<sup>23</sup>; or
- 635 (6) uses it on business papers or in advertising<sup>24</sup>.

- 1 For the meaning of the 'London Olympic association right' see PARA 500 ante.
- 2 For the meaning of the 'London Olympics' see PARA 500 ante.
- 3 London Olympic Games and Paralympic Games Act 2006 s 33, Sch 4 para 1(1). The proprietor must comply with any directions given by the Secretary of State with respect to the exercise of the rights conferred by the Olympics association right under the Olympic Symbol etc (Protection) Act 1995 s 2(1) (see PARA 493 ante): s 15(1) (s 15 applied by the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(1) (g)). Such directions may be of a general or particular character, and may be varied or revoked by subsequent directions: Olympic Symbol etc (Protection) Act 1995 s 15(2) (as so applied). A transaction between any person and the proprietor in his capacity as such is not void by reason only that the transaction was carried out in contravention of a direction, and a person dealing with the proprietor is not concerned to see or inquire whether a direction has been given or complied with: s 15(3) (as so applied). As to the proprietor see PARA 500 ante. As to the Secretary of State see PARA 14 ante.
- 4 London Olympic Games and Paralympic Games Act 2006 Sch 4 para 1(2)(a).
- 5 Ibid Sch 4 para 1(2)(b).
- 6 Ibid Sch 4 para 1(3). Such an order may include incidental, consequential or transitional provisions: Sch 4 para 1(3)(a). Such an order may not be made unless a draft has been laid before and approved by resolution of each House of Parliament: Sch 4 para 1(3)(c). At the date at which this volume states the law no such order had been made.
- 7 Ie under ibid Sch 4 para 2(1): see note 10 infra. For the meaning of 'United Kingdom' see PARA 3 note 2 ante.
- 8 Olympic Symbol etc (Protection) Act 1995 s 2(2) (applied by the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(1)(a)).
- 9 Olympic Symbol etc (Protection) Act 1995 s 2(3) (applied by the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(1)(a)). This provision does not have effect to permit the doing of anything which would otherwise be liable to be prevented by virtue of a right subsisting immediately before 30 March 2006 or created by the registration of a design under the Registered Designs Act 1949 (see PATENTS AND REGISTERED DESIGNS) or by the registration of a trade mark under the Trade Marks Act 1994 (see PARA 352 et seq ante) on or after that day: Olympic Symbol etc (Protection) Act 1995 s 2(4) (as so applied). The date referred to above is the day on which the London Olympic Games and Paralympic Games Act 2006 Sch 4 came into force: see s 40(1)(d); and see Sch 4 para 10(2)(c).
- 10 Ibid Sch 4 para 2(1). This is subject to the provisions of Sch 4: Sch 4 para 2(2).
- 11 Ibid Sch 4 para 3(1).
- 12 Ibid Sch 4 para 3(2).
- 13 Ibid Sch 4 para 3(3).
- 14 Ibid Sch 4 para 3(4).
- 15 Ibid Sch 4 para 3(5).
- 16 Ibid Sch 4 para 3(6), (7)(a). An order may not be made unless a draft has been laid before and approved by resolution of each House of Parliament: Sch 4 para 3(7)(b). Before laying a draft order the Secretary of State must consult: (1) one or more persons who appear to him to have relevant responsibility for regulating the advertising industry including enforcing standards of professional conduct; (2) one or more persons who appears to him to represent the interests of the advertising industry; (3) the London Organising Committee; and (4) such other persons as he thinks appropriate: Sch 4 para 3(9).
- 17 Ibid Sch 4 para 3(8).
- 18 Ibid Sch 4 para 10(2)(a).
- 19 Olympic Symbol etc Protection Act 1995 s 3(2)(a) (s 3(2) applied by the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(1)(b)).
- 20 Olympic Symbol etc Protection Act 1995 s 3(2)(b) (as applied: see note 19 supra).

- 21 Ibid s 3(2)(c) (as applied: see note 19 supra).
- 22 Ibid s 3(2)(d) (as applied: see note 19 supra).
- 23 Ibid s 3(2)(e) (as applied: see note 19 supra).
- 24 Ibid s 3(2)(f) (as applied: see note 19 supra).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(iii) The London Olympics Association Right/502. Authorised use of representations.

## **502. Authorised use of representations.**

The London Olympics association right<sup>1</sup> is not infringed by use of a representation in accordance with an authorisation granted by the London Organising Committee<sup>2</sup>. The London Organising Committee must make arrangements for the grant of authorisations<sup>3</sup>. The London Organising Committee must also maintain a register of persons, and classes of persons, so authorised<sup>4</sup>. The register must specify in relation to each authorised person his name, his principal place of business, the goods or services to which the authorisation relates and the period in respect of which the authorisation has effect<sup>5</sup>. The register must specify in respect of each authorised class of person the nature of the class, the goods or services to which the authorisation relates (including the circumstances in which it does or does not apply), and the period in respect of which the authorisation has effect<sup>6</sup>. The London Organising Committee must ensure that a copy of the register is accessible to the public by use of the internet and must comply with a written request for a copy of the register or of an entry in the register<sup>7</sup>. The London Organising Committee may require such a request to be accompanied by a specified fee<sup>8</sup>. A request for a copy may require the copy to be certified on behalf of the Committee as an accurate copy<sup>9</sup>. If a copy of the register or of an entry in the register is certified on behalf of the Committee as an accurate copy, it is treated as accurate for all purposes unless the contrary is proved<sup>10</sup>.

1 As to the London Olympics association right see PARA 500-501 ante.

2 London Olympic Games and Paralympic Games Act 2006 s 33, Sch 4 para 4(1). As to the London Organising Committee see PARA 500 note 5 ante.

3 Ibid Sch 4 para 4(2). The arrangements may make provision about charges and enable the London Organising Committee to exercise unfettered discretion (subject to any direction under the Olympic Symbol etc (Protection) Act 1995 s 15 (as applied) (see PARA 501 ante): London Olympic Games and Paralympic Games Act 2006 Sch 4 para 4(2).

4 Ibid Sch 4 para 5(1).

5 Ibid Sch 4 para 5(2).

6 Ibid Sch 4 para 5(3).

7 Ibid Sch 4 para 5(4).

8 Ibid Sch 4 para 5(5). The London Organising Committee may specify different fees for different purposes, may charge no fee, or waive a fee, in such cases as it thinks appropriate and may not specify a fee which exceeds any maximum specified by order of the Secretary of State: Sch 4 para 5(5). Such an order must be made by statutory instrument, may make different provision for different purposes, may include transitional provision and is subject to annulment pursuant to a resolution of either House of Parliament: Sch 4 para 5(6). At the date at which this volume states the law no such order had been made.

9 Ibid Sch 4 para 5(8).

10 Ibid Sch 4 para 5(7).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(iii) The London Olympics Association Right/503. Other limits on the London Olympics association right.

### **503. Other limits on the London Olympics association right.**

The London Olympics association right<sup>1</sup> is not infringed by the use:

- 636 (1) of a trade mark registered under the Trade Marks Act 1994 in relation to goods or service for which it is registered<sup>2</sup>;
- 637 (2) by a person of his own name or address provided that the use is in accordance with honest practices in industrial matters<sup>3</sup>;
- 638 (3) of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services provided that the use is in accordance with honest practices in industrial matters<sup>4</sup>;
- 639 (4) of a representation which is necessary to indicate the intended purpose of a product or service provided that the use is in accordance with honest practices in industrial matters<sup>5</sup>;
- 640 (5) of a representation in publishing or broadcasting a report of a sporting or other event forming part of the London Olympics or information about the London Olympics<sup>6</sup>;
- 641 (6) of a representation in an advertisement for a publication or broadcast of such a kind<sup>7</sup>;
- 642 (7) of a representation as an incidental inclusion<sup>8</sup> in a literary work, dramatic work, artistic work, sound recording, film or broadcast<sup>9</sup>;
- 643 (8) of a representation in relation to goods if:
  - 2
  - 1. (a) the goods were put on the market in the European Economic Area in accordance with an authorisation granted by the London Organising Committee<sup>10</sup>;
  - 2. (b) the representation was used in relation to the goods when they were put upon the market<sup>11</sup>; and
  - 3. (c) the London Organising Committee does not oppose further dealings in the goods for legitimate reasons including, in particular, that the condition of the goods has been changed or impaired after they were put on the market<sup>12</sup>;
  - 3
- 644 (9) of a controlled representation where the use is for the purposes of an undertaking, and the way in which the representation is used for the purposes of the undertaking is a way in which it has been continuously used for those purposes since a date prior to 30 March 2006<sup>13</sup>;
- 645 (10) of a controlled representation as part of the name of a company, being a name which was the company's corporate name immediately before 30 March 2006, or the name under which a business is carried on, being a business which was carried on under that name immediately before 30 March 2006<sup>14</sup>;
- 646 (11) of a controlled representation where the use takes place under a right subsisting immediately before 30 March 2006, or is liable to be prevented by virtue of such a right<sup>15</sup>;
- 647 (12) of a controlled representation where the use takes place under a right created by the registration of a design<sup>16</sup> on or after 30 March 2006, or the

registration of a trade mark<sup>17</sup> on or after that day, or is liable to be prevented by virtue of such a right<sup>18</sup>.

The Secretary of State<sup>19</sup> may by order made by statutory instrument specify additional cases in which the London Olympics association right is not infringed<sup>20</sup>. The matters by reference to which a case may be specified include the description of controlled representation used, and the description of persons by whom a controlled representation is used<sup>21</sup>.

1 As to the London Olympics association right see PARAS 500-501 ante.

2 London Olympic Games and Paralympic Games Act 2006 s 33, Sch 4 para 6.

3 Ibid Sch 4 para 7(a). See also the Trade Marks Act 1994 s 11(2)(a); and PARA 93 ante.

4 London Olympic Games and Paralympic Games Act 2006 Sch 4 para 7(b). See also the Trade Marks Act 1994 s 11(2)(b); and PARA 94 ante.

5 London Olympic Games and Paralympic Games Act 2006 Sch 4 para 7(c). See also the Trade Marks Act 1994 s 11(2)(c); and PARA 95 ante.

6 London Olympic Games and Paralympic Games Act 2006 Sch 4 para 8(1)(a), (b). The exceptions in Sch 4 para 8(1)(a), (b) do not apply to advertising material which is published or broadcast at the same time as, or in connection with, a report or information: Sch 4 para 8(2). As to the London Olympics see PARA 500 ante.

7 Ibid Sch 4 para 8(1)(d).

8 Ie within the meaning of the Copyright, Designs and Patents Act 1988 s 31: see COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 342.

9 London Olympic Games and Paralympic Games Act 2006 Sch 4 para 8(1)(c). For the meanings of 'literary work' and 'dramatic work' see the Copyright, Designs and Patents Act 1988 s 3(1); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARAS 67, 73. For the meaning of 'artistic work' see s 4(1); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARA 75. For the meaning of 'sound recording' see ss 5A, 135A (both as added); and COPYRIGHT, DESIGN RIGHT AND RELATED RIGHTS vol 9(2) (2006 Reissue) PARAS 84, 195.

10 London Olympic Games and Paralympic Games Act 2006 Sch 4 para 9(a). Cf the Trade Marks Act 1994 s 12; and PARAS 102-105 ante. As to the European Economic Area see PARA 102 ante. As to the London Organising Committee see PARA 500 note 5 ante.

11 London Olympic Games and Paralympic Games Act 2006 Sch 4 para 9(b). See note 10 supra.

12 Ibid Sch 4 para 9(c). See note 10 supra.

13 Olympic Symbol etc (Protection) Act 1995 s 4(11) (applied by the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(1)(c)). The date referred to in head (9) in the text is the date on which the London Olympic Games and Paralympic Games Act 2006 Sch 4 came into force: see s 40(1)(d); and see Sch 4 para 10(2)(c).

14 Olympic Symbol etc (Protection) Act 1995 s 4(12) (as applied: see note 13 supra). As to the date referred to in the text see note 13 supra.

15 Ibid s 4(13) (as applied: see note 13 supra). As to the date referred to in the text see note 13 supra.

16 Ie under the Registered Designs Act 1949.

17 Ie under the Trade Marks Act 1994.

18 Olympic Symbol etc (Protection) Act 1995 s 4(14) (as applied: see note 13 supra). As to the date referred to in the text see note 13 supra.

19 As to the Secretary of State see PARA 14 ante.

20 Olympic Symbol etc (Protection) Act 1995 s 5(1) (applied by the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(1)(d)). Such an order may contain such supplementary and transitional



provision and savings as the Secretary of State thinks fit: Olympic Symbol etc (Protection) Act 1995 s 5(3) (as so applied). Such an order is subject to annulment pursuant to a resolution of either House of Parliament: s 5(4) (added by the London Olympic Games and Paralympic Games Act 2006 Sch 3 para 5; and so applied). At the date at which this volume states the law, no order had been made under the Olympic Symbol etc (Protection) Act 1995 s 5 (as amended and applied).

21 Ibid s 5(2) (as applied: see note 20 *supra*).

## **UPDATE**

### **503 Other limits on the London Olympics association right**

TEXT AND NOTES 19, 20--After 'Secretary of State' read 'or the Paymaster General' (in both places): 1995 Act s 5 (amended by the Transfer of Functions (Olympics and Paralympics) Order 2007, SI 2007/2129).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(iii) The London Olympics Association Right/504. Infringement of the London Olympics association right; proceedings and remedies.

#### **504. Infringement of the London Olympics association right; proceedings and remedies.**

An infringement of the London Olympics association right<sup>1</sup> is actionable by the proprietor<sup>2</sup>. In an action for infringement, all such relief by way of damages, injunctions, accounts or otherwise is available to the proprietor as is available in respect of the infringement of a property right<sup>3</sup>.

1 As to the London Olympics association right see PARAS 500-501 ante.

2 Olympic Symbol etc (Protection) Act 1995 s 6(1) (applied by the London Olympic Games and Paralympic Games Act 2006 Sch 4 para 10(1)(e)). As to the proprietor see PARA 500 ante.

3 Olympic Symbol etc (Protection) Act 1995 s 6(2) (as applied: see note 2 supra). The Secretary of State has the power to make, in relation to infringing goods, material and articles, provision corresponding to that made by the Trade Marks Act 1994 ss 15, 16, 18-20 (remedies for infringement: see PARAS 446, 461-463 ante) in relation to goods, material and articles which are infringing goods, material and articles for the purposes of the Trade Marks Act 1994: Olympic Symbol etc (Protection) Act 1995 s 7(1), (5) (as so applied). As to the regulations made under s 7(1), (5) see the Olympics Association Right (Infringement Proceedings) Regulations 1995, SI 1995/3325; and PARA 495 ante. As to the Secretary of State see PARA 14 ante. As to when material is 'infringing material' and articles are 'infringing articles' see the Olympic Symbol etc (Protection) Act 1995 s 7(3), (4) (as so applied); and PARA 495 note 3 ante.

#### **UPDATE**

#### **504 Infringement of the London Olympics association right; proceedings and remedies**

NOTE 3--After 'Secretary of State' read 'or the Paymaster General': 1995 Act s 7 (amended by the Transfer of Functions (Olympics and Paralympics) Order 2007, SI 2007/2129).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(6) THE OLYMPICS ASSOCIATION RIGHT, THE PARALYMPICS ASSOCIATION RIGHT AND THE LONDON OLYMPICS ASSOCIATION RIGHT/(iii) The London Olympics Association Right/505. Remedy for groundless threats.

### **505. Remedy for groundless threats.**

Where the proprietor<sup>1</sup> threatens another with proceedings for infringement of the London Olympics association right<sup>2</sup> other than: (1) the application to goods or their packaging of a controlled representation<sup>3</sup>; (2) the importation of goods to which, or to the packaging of which, such a representation has been applied; or (3) the supply of services under a sign which consists of or contains such a representation, any person aggrieved may bring proceedings for relief<sup>4</sup>.

The relief which may be applied for is any of the following: (a) a declaration that the threats are unjustifiable; (b) an injunction against the continuance of the threats; and (c) damages in respect of any loss he has sustained by the threats<sup>5</sup>.

A claimant is entitled to the relief applied for unless the defendant shows that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the London Olympics association right<sup>6</sup>.

1 As to the proprietor see PARA 500 ante. There is nothing to stop persons other than the proprietor from making groundless threats for infringement of the London Olympics association right.

2 As to the London Olympics association right see PARAS 500-501 ante.

3 As to the meaning of 'controlled representation' see PARA 501 ante.

4 Olympic Symbol etc (Protection) Act 1995 s 16(1) (applied by the London Olympic Games and Paralympic Games Act 2006 s 33, Sch 4 para 10(1)(h)). The mere notification of the rights conferred by the London Olympic Games and Paralympic Games Act 2006 does not constitute a threat of proceedings: Olympic Symbol etc (Protection) Act 1995 s 16(4) (as so applied). See also PARA 123 note 1 ante.

5 Ibid s 16(2) (as applied: see note 4 supra).

6 Ibid s 16(3) (as applied: see note 4 supra).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(7) USE OF RED CROSS AND MILITARY EMBLEMS/506. Restrictions on use of Red Cross and associated emblems.

## **(7) USE OF RED CROSS AND MILITARY EMBLEMS**

### **506. Restrictions on use of Red Cross and associated emblems.**

It is not lawful for any person, without the authority of the Secretary of State<sup>1</sup>, to use for any purpose whatsoever any of the following emblems or designations<sup>2</sup>:

- 648 (1) the emblem of a red cross with vertical and horizontal arms of the same length on, and completely surrounded by, a white ground, or the designation 'Red Cross' or 'Geneva Cross'<sup>3</sup>;
- 649 (2) the emblem of a red crescent moon on, and completely surrounded by, a white ground, or the designation 'Red Crescent'<sup>4</sup>;
- 650 (3) the following emblem in red on, and completely surrounded by, a white ground, that is to say, a lion passing from right to left of, and with its face turned towards, the observer, holding erect in its raised right forepaw a scimitar, with, appearing above the lion's back, the upper half of the sun shooting forth rays, or the designation 'Red Lion and Sun'<sup>5</sup>;
- 651 (4) the sign of an equilateral blue triangle on, and completely surrounded by, an orange ground, being the international distinctive sign of civil defence<sup>6</sup>;
- 652 (5) any of the distinctive symbols specified in Chapter III of Annex I to the first protocol to the Geneva Convention<sup>7</sup>, being the signals of identification for medical units and transports<sup>8</sup>.

Nor is it lawful for any person, without the authority of the Secretary of State, to use for any purpose whatsoever<sup>9</sup>:

- 653 (a) any design consisting of a white or silver cross with vertical and horizontal arms of the same length on, and completely surrounded by, a red ground, being the heraldic emblem of the Swiss Confederation, or any other design so nearly resembling that design as to be capable of being mistaken for that heraldic emblem<sup>10</sup>;
- 654 (b) any design or wording so nearly resembling any of the emblems or designations specified in heads (1) to (3) above as to be capable of being mistaken for, or, as the case may be, understood as referring to, one of those emblems<sup>11</sup>;
- 655 (c) any design so nearly resembling the sign specified in head (4) above as to be capable of being mistaken for that sign<sup>12</sup>;
- 656 (d) any signal so nearly resembling any of the signals referred to in head (5) above as to be capable of being mistaken for one of those signals<sup>13</sup>.

If any person contravenes the above provisions, he is guilty of an offence and liable on summary conviction to a fine<sup>14</sup> and to forfeit any goods or other article upon or in connection with which the emblem, designation, sign, signal, design or wording was used<sup>15</sup>.

In the case of a trade mark registered before 31 July 1957<sup>16</sup> the above provisions do not apply by reason only of its consisting of or containing a design or wording which reproduces or resembles an emblem or designation specified in head (2) or head (3) above, or a design reproducing or resembling the sign referred to in head (4) above<sup>17</sup>; and, where a person is

charged with using such a design or wording for any purpose and it is proved that he used it otherwise than as, or as part of, a trade mark so registered, it is a defence for him to prove<sup>18</sup>:

- 657 (i) that he lawfully used that design or wording for that purpose before 31 July 1957<sup>19</sup>; or
- 658 (ii) in a case where he is charged with using the design or wording upon goods, that the design or wording had been applied to the goods before he acquired them by some other person who had manufactured or dealt with the goods in the course of trade and who lawfully used the design or wording upon similar goods before that date<sup>20</sup>.

The above provisions extend to the use in or outside the United Kingdom<sup>21</sup> of any such emblem, designation, design, wording, sign or signal as is referred to in heads (1) to (5) above or heads (a) to (d) above on any British ship<sup>22</sup> or any British-controlled aircraft or hovercraft<sup>23</sup>.

Any of the above provisions may be extended by order to the Channel Islands, the Isle of Man or any colony<sup>24</sup>.

1    Ie the Secretary of State as successor to the Board of Trade. As to the Secretary of State see PARA 14 ante.

2    Geneva Conventions Act 1957 s 6(1) (amended by the Geneva Conventions (Amendment) Act 1995 ss 2(2)(a), 5(a)(i)). As to the distinctive emblems of the Red Cross see WAR AND ARMED CONFLICT vol 49(1) (2005 Reissue) PARA 432.

3    Geneva Conventions Act 1957 s 6(1)(a).

4    Ibid s 6(1)(b).

5    Ibid s 6(1)(c).

6    Ibid s 6(1)(d) (s 6(1)(d), (e) added by the Geneva Conventions (Amendment) Act 1995 s 2(2)(b)).

7    Ie the Protocol, additional to the Geneva Conventions of 12 August 1949, and relating to the Protection of Victims of International Armed Conflicts done on 10 June 1977 (Geneva, 12 December 1977; Cmnd 6927) (the 'Geneva Conventions 1949 Protocol I') Annex I Ch III arts 6-9. The Protocol is set out in the Geneva Conventions Act 1957 Sch 5 (added by the Geneva Conventions (Amendment) Act 1995 s 6, Schedule).

8    Geneva Conventions Act 1957 s 6(1)(e) (as added: see note 6 supra).

9    Ibid s 6(2) (amended by the Geneva Conventions (Amendment) Act 1995 s 2(3)(a)).

10   Geneva Conventions Act 1957 s 6(2)(a).

11   Ibid s 6(2)(b).

12   Ibid s 6(2)(c) (s 6(2)(c), (d) added by the Geneva Conventions (Amendment) Act 1995 s 2(3)(b)).

13   Geneva Conventions Act 1957 s 6(2)(d) (as added: see note 12 supra).

14   Ie a fine not exceeding level 5 on the standard scale: see ibid s 6(3) (amended by the Geneva Conventions (Amendment) Act 1995 s 2(4)(a)-(c); and by virtue of the Criminal Justice Act 1982 ss 37, 38, 46). As to the standard scale see PARA 32 note 13 ante.

15   Geneva Conventions Act 1957 s 6(3) (as amended: see note 14 supra). Proceedings under s 6 (as amended) may not be instituted in England except by or on behalf of the Director of Public Prosecutions: s 6(7) (amended by the Geneva Conventions (Amendment) Act 1995 s 2(7)). As to the Director of Public Prosecutions see CRIMINAL LAW, EVIDENCE AND PROCEDURE vol 11(3) (2006 Reissue) PARA 1066 et seq.

Where an offence under the Geneva Conventions Act 1957 s 6 committed by a body corporate is proved to have been committed with the consent or connivance of any director, manager, secretary or other officer of the body corporate, or any person purporting to act in any such capacity, he, as well as the body corporate, is deemed to be guilty of the offence and is liable to be proceeded against and punished accordingly; and, for these purposes, 'director', in relation to any body corporate established by or under any enactment for the

purpose of carrying on under national ownership any industry or part of an industry or undertaking, being a body corporate whose affairs are managed by members thereof, means a member of that body: s 6(5). As to bodies corporate see generally COMPANIES vol 14 (2009) PARA 1; CORPORATIONS.

16     Ie the date of the passing of the Geneva Conventions Act 1957. In relation to head (4) in the text, this date is to be read as 19 July 1995 (ie the date of the passing of the Geneva Conventions (Amendment) Act 1995).

17     See the Geneva Conventions Act 1957 s 6(4A) (added by the Geneva Conventions (Amendment) Act 1995 s 2(5)). In relation to head (4) in the text the reference to 31 July 1957 is to be read as a reference to 19 July 1995: Geneva Conventions Act 1957 s 6(4A) (as so added). See note 16 supra.

18     Ibid s 6(4).

19     Ibid s 6(4)(a). In relation to head (4) in the text, the reference to 31 July 1957 is to be read as a reference to 19 July 1995: see note 16 supra.

20     Ibid s 6(4)(b). In relation to head (4) in the text, the reference to 31 July 1957 is to be read as a reference to 19 July 1995: see note 16 supra.

21     For the meaning of 'United Kingdom' see PARA 3 note 2 ante.

22     Ie within the meaning of what is now the Merchant Shipping Act 1995: see SHIPPING AND MARITIME LAW vol 93 (2008) PARA 230.

23     Geneva Conventions Act 1957 s 6(6) (amended by the Geneva Conventions (Amendment) Act 1995 s 2(6)). As to British-controlled aircraft or hovercraft see the Civil Aviation Act 1982 s 92 (as amended), or s 92 (as amended) as applied to hovercraft by virtue of any provision made under the Hovercraft Act 1968; and AIR LAW vol 2 (2008) PARA 619.

24     See the Geneva Conventions Act 1957 s 8(2) (amended by the Geneva Conventions (Amendment) Act 1995 s 5(b)); and the Geneva Conventions (Amendment) Act 1995 s 7(4). As to orders extending those Acts see the Geneva Conventions Act (Colonial Territories) Order in Council 1959, SI 1959/1301; the Geneva Conventions Act (Guernsey) Order 1966, SI 1966/948; the Geneva Conventions Act (Jersey) Order 1966, SI 1966/949; the Geneva Conventions Act (Isle of Man) Order 1970, SI 1970/1677; the Geneva Conventions Act (Guernsey) Order 1999, SI 1999/1316; the Geneva Conventions Act (Jersey) Order 1999, SI 1999/1744; and the Geneva Conventions Act (Isle of Man) Order 1999, SI 1999/1743.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(7) USE OF RED CROSS AND MILITARY EMBLEMS/507. Restrictions on use of the word 'Anzac'.

# **507. Restrictions on use of the word 'Anzac'.**

It is unlawful to use in connection with any trade, business, calling or profession the word 'Anzac'<sup>1</sup>, or any word closely resembling that word, without the authority of a Secretary of State<sup>2</sup> given on the request of the government of Australia or New Zealand, notwithstanding that such word forms part of any trade mark, or of the name of any company or society or other body, which was registered before 15 December 1916<sup>3</sup>.

If any person acts in contravention of the above provisions, he is guilty of an offence and liable on summary conviction to a fine<sup>4</sup>.

1 'Anzac' is an abbreviation for 'Australian and New Zealand Army Corps'.

2 ie one of Her Majesty's principal Secretaries of State: see PARA 14 note 1 ante.

3 'Anzac' (Restriction on Trade Use of Word) Act 1916 s 1(1) (amended by the Statute Law Revision Act 1927).

4 'Anzac' (Restriction on Trade Use of Word) Act 1916 s 1(2) (amended by virtue of the Criminal Justice Act 1982 ss 35, 37, 38, 46). The fine must not exceed level 3 on the standard scale: see the 'Anzac' (Restriction on Trade Use of Word) Act 1916 s 1(2) (as so amended). As to the standard scale see PARA 32 note 13 ante.

When a company or society is guilty of any such contravention, without prejudice to the liability of the company or society, every director, manager, secretary or other officer of the company who is knowingly a party to the contravention is guilty of an offence and liable to the like penalty: s 1(2).

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(8) USE OF INDICIA OF CHARTERED ASSOCIATIONS/508. Restrictions on use of indicia of chartered associations.

## **(8) USE OF INDICIA OF CHARTERED ASSOCIATIONS**

### **508. Restrictions on use of indicia of chartered associations.**

The Chartered Associations (Protection of Names and Uniforms) Act 1926 restricts the use of the name, designation, uniform or badge of any association incorporated by Royal Charter (not being an association representative of any profession or business) protected by an order made under the Act<sup>1</sup>.

<sup>1</sup> See CORPORATIONS vol 9(2) (2006 Reissue) PARA 1121.



Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(9) CONTROLS OVER BUSINESS AND COMPANY NAMES/509. Business names.

## **(9) CONTROLS OVER BUSINESS AND COMPANY NAMES**

### **509. Business names.**

Until a day to be appointed the following provisions have effect<sup>1</sup>. The Business Names Act 1985 imposes controls on the use of certain descriptions and terms in business names<sup>2</sup>. The Act prohibits the use, without the approval of the Secretary of State, of: (1) a name which would be likely to give the impression that the business is connected with Her Majesty's government, with any part of the Scottish administration or with any local authority; or (2) a name including any word or expression specified in regulations made under the Act<sup>3</sup>. Specified details are required to appear on business letters, orders, invoices and receipts<sup>4</sup>. Breach of these requirements may give other parties a defence to a claim for breach of contract in certain circumstances<sup>5</sup>.

As from a day to be appointed<sup>6</sup>, the Companies Act 2006 imposes controls on the use of certain descriptions and terms in business names<sup>7</sup>. The Act prohibits the use, without the approval of the Secretary of State, of: (a) a name which would be likely to give the impression that the business is connected with Her Majesty's government, with any part of the Scottish administration, with any local authority or with any public authority specified in regulations made under the Act<sup>8</sup>; (b) a name including a word or expression specified in regulations made under the Act<sup>9</sup>; (c) a name including a word or expression or other indication that is associated with a particular type of company or form of organisation specified in regulations made under the Act<sup>10</sup>; or (d) a name that gives so misleading an indication of the nature of the activities of the business as to be likely to cause harm to the public<sup>11</sup>. In the case of individuals and partnerships, specified details are required to appear on business letters, orders, invoices, receipts and demands for payments of debts<sup>12</sup>. A notice must be displayed in any premises where the business is carried on and to which customers have access<sup>13</sup>. Failure to comply with these requirements is an offence<sup>14</sup>. Breach of these requirements may give other parties a defence to a claim for breach of contract in certain circumstances<sup>15</sup>.

1 The Business Names Act 1985 is repealed, and to a large extent replaced, by the Companies Act 2006 s 1295, Sch 16, as from a day to be appointed under s 1300(2). At the date at which this volume states the law no such day had been appointed, although 20 January 2007 has been appointed for the purpose of enabling the exercise of powers to make orders or regulations by statutory instrument under the Companies Act 2006: Companies Act 2006 (Commencement No 1, Transitional Provisions and Savings) Order 2006, SI 2006/3428, art 3(3).

2 See the Business Names Act 1985; and COMPANIES vol 14 (2009) PARA 223 et seq. The Act applies to the trading name of a partnership, individual trader, company or limited liability partnership, which does not consist of the names of all the partners, the individual concerned or the corporate name of the company or limited liability partnership: see s 1 (as amended); and COMPANIES vol 14 (2009) PARA 223 et seq.

3 See *ibid* ss 1-3 (as amended); the Company and Business Names (Chamber of Commerce, etc) Act 1999; the Company and Business Names Regulations 1981, SI 1981/1685 (as amended); and COMPANIES vol 14 (2009) PARAS 196, 224.

4 See the Business Names Act 1985 s 4 (as amended); and COMPANIES vol 14 (2009) PARA 223 et seq.

5 See *ibid* s 5. In certain circumstances the Business Names Act 1985 may be enforced under the Enterprise Act 2002 Pt 8 Enterprise Act 2002 Pt 8 (ss 210-236) (as amended) (see COMPETITION vol 18 (2009) PARA 339 et seq): see the Enterprise Act 2002 (Part 8 Domestic Infringements) Order 2003, SI 2003/1593; and the Enterprise

Act 2002 (Part 8 Notice to OFT of Intended Prosecution Specified Enactments, Revocation and Transition Provision) Order 2003, SI 2003/1376.

6 See note 1 *supra*.

7 See the Companies Act 2006 ss 1192-1199.

8 See *ibid* s 1193. In connection with an application for the approval of the Secretary of State under ss 1193, 1194 regulations may be made under those provisions requiring an applicant to seek the view of a specified government department or other body: see s 1195. Approval given for the purposes of ss 1193, 1194 may be withdrawn: see s 1196.

9 See *ibid* s 1194. See note 8 *supra*.

10 See *ibid* s 1197.

11 See *ibid* s 1198.

12 See *ibid* s 1202.

13 See *ibid* s 1204.

14 See *ibid* s 1205.

15 See *ibid* s 1206.

## **UPDATE**

### **509 Business names**

NOTES--Certain functions under provisions mentioned in this paragraph are 'relevant functions' for the purposes of the Regulatory Enforcement and Sanctions Act 2008 s 4, Sch 3, see LOCAL GOVERNMENT vol 69 (2009) PARA 733.

NOTE 3--SI 1981/1685 (as amended) replaced: Company, Limited Liability Partnership and Business Names (Sensitive Words and Expressions) Regulations 2009, SI 2009/2615.

NOTE 8--Companies Act 2006 s 1193 amended: SI 2009/2958. As to regulations made under the Companies Act 2006 ss 1193, 1195 see the Company, Limited Liability Partnership and Business Names (Public Authorities) Regulations 2009, SI 2009/2982.

Halsbury's Laws of England/TRADE MARKS AND TRADE NAMES (VOLUME 48 (2007 REISSUE))/6. HALLMARKS, ARMS, EMBLEMS AND BUSINESS NAMES/(9) CONTROLS OVER BUSINESS AND COMPANY NAMES/510. Controls over company names.

## **510. Controls over company names.**

Until a day to be appointed<sup>1</sup>, there are restrictions on the names by which companies may be registered under the Companies Act 1985<sup>2</sup> and on the names used by overseas companies for business purposes in the United Kingdom<sup>3</sup>.

As from a day to be appointed<sup>4</sup>, such restrictions are governed by the Companies Act 2006<sup>5</sup>.

1 The relevant provisions of the Companies Act 1985 are repealed and to a large extent replaced by the Companies Act 2006 s 1295, Sch 16, as from a day to be appointed under s 1300(2). At the date at which this volume states the law no such day had been appointed, although 20 January 2007 has been appointed for the purpose of enabling the exercise of powers to make orders or regulations by statutory instrument under the Companies Act 2006: Companies Act 2006 (Commencement No 1, Transitional Provisions and Savings) Order 2006, SI 2006/3428, art 3(3).

2 See the Companies Act 1985 s 26 (as amended) (prohibition on registration of certain names: see COMPANIES vol 14 (2009) PARA 196), s 27 (as amended) (alternatives of statutory designations: see COMPANIES vol 14 (2009) PARA 200), s 28 (deceptive names and change of name: see COMPANIES vol 14 (2009) PARAS 205, 217-219), s 29 (as amended) (regulations about names: see COMPANIES vol 14 (2009) PARA 196 et seq), s 30 (as amended) and s 31 (exemption from requirement of 'limited' as part of name: see COMPANIES vol 14 (2009) PARAS 201-202), s 32 (power to require company to abandon misleading name: see COMPANIES vol 14 (2009) PARA 216), s 33 (as amended) (prohibition on trading under misleading name: see COMPANIES vol 14 (2009) PARA 226), s 34 (penalty for improper use of 'limited' or 'cyfyngedig': see COMPANIES vol 14 (2009) PARAS 204, 225), s 682 (change of name on registration of company not formed under companies legislation: see COMPANIES vol 14 (2009) PARA 37), s 687 (name of company not formed under companies legislation registering: see COMPANIES vol 14 (2009) PARAS 35, 37) (modified in relation to statutory water companies by the Statutory Water Companies Act 1991 s 11: see WATER AND WATERWAYS vol 100 (2009) PARA 135).

3 See the Companies Act 1985 s 694 (as amended); and COMPANIES vol 15 (2009) PARA 1827.

4 See note 1 *supra*.

5 See the Companies Act 2006 Pt 5 (ss 53-85).

